

O/1108/23

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO. 3555180
IN THE NAME OF PW BRANDING, INC.
IN CLASSES 3, 5, 16, 18, 25, 27, 28, 32, 35, 41 & 43

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 425084
BY ZABOU GROUP LIMITED

AND

IN THE MATTER OF REGISTRATION NOS. 3424619, 3424638, 918117107 &
918117118
IN THE NAME OF PW BRANDING, INC.
IN CLASSES 25 & 35

AND APPLICATIONS FOR DECLARATIONS OF INVALIDITY
UNDER NOS. 504187, 504188, 504189 & 504190
BY ZABOU GROUP LIMITED

AND

IN THE MATTER OF REGISTRATION NO. 3059824
IN THE NAME OF ZABOU GROUP LIMITED
IN CLASSES 18 & 25

AND AN APPLICATION FOR REVOCATION
UNDER NO. 504005
BY PW BRANDING, INC.

Background and pleadings

1. On 12 November 2020, PW Branding, Inc. (“PWB”) applied to register the trade mark **HUMANRACE** in the UK, under number 3555180 (“PWB’s application”). Registration is sought for a wide range of goods and services, as set out in the annex to this decision. Details of the application were published for opposition purposes on 19 March 2021.

2. PWB is also the proprietor of the following trade marks:

HUMAN RACE

UK registration no. 3424619
Filing date: 29 August 2019
Priority date: 27 August 2019 (US)
Registration date: 27 December 2019
 (“PWB’s first registration”)

HUMAN RACE

UK registration no. 3424638
Filing date: 29 August 2019
Priority date: 27 August 2019 (US)
Registration date: 24 January 2020
 (“PWB’s second registration”)

HUMAN RACE

UK registration no. 918117107
Filing date: 29 August 2019
Priority date: 27 August 2019 (US)
Registration date: 29 February 2020
 (“PWB’s third registration”)

HUMAN RACE

UK registration no. 918117118
Filing date: 29 August 2019

Priority date: 27 August 2019 (US)

Registration date: 22 May 2020

("PWB's fourth registration")

3. PWB's first and third registrations stand registered for an identical list of goods in class 25,¹ whereas PWB's second and fourth registrations stand registered for services in class 35. These are set out in full in the annex to this decision.²

4. Zabou Group Limited ("Zabou") opposes PWB's application and seeks declarations of invalidity in respect of all of PWB's registrations under sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 ("the Act").³ The goods and services against which Zabou's claims are directed are those underlined in the annex to this decision. At this juncture, it is sufficient to record that they include PWB's goods in class 25,⁴ as well as some of its services in class 35.

5. Zabou relies upon its UK registration number 3059824, **HUMAN RACE** ("Zabou's mark"). Zabou's mark was filed on 13 June 2014 and became registered on 26 September 2014 in respect of goods in classes 18 and 25. These are outlined in the annex to this decision.

6. Zabou contends that the parties' goods are identical and that PWB's marks are identical to its mark. On this basis, it argues that registration of PWB's marks is/was contrary to section 5(1) of the Act.

7. In addition or in the alternative, Zabou argues that the parties' goods and services are similar. It says that this, combined with the identity between the competing marks,

¹ With the exception that the list of goods in PWB's third registration includes additional references to *clothing, namely [...]* throughout. However, this does not affect the protection afforded by the registration.

² I note that PWB's second and fourth registrations were subject to divisions during the proceedings. As a result, they now stand registered for only the services which are the subject of Zabou's applications for invalidity.

³ It should be noted that only the opposition is brought on all three grounds, whereas the applications for invalidity are based upon sections 5(1) and 5(2)(a) only.

⁴ Zabou had also originally opposed PWB's goods in class 18 of its application. However, this part of the opposition was withdrawn within Mr Tritton's skeleton argument. He also narrowed Zabou's opposition to the services in class 35 of PWB's application.

will give rise to a likelihood of confusion. On this basis, it submits that registration of PWB's marks is/was contrary to section 5(2)(a) of the Act.

8. Further in addition or in the alternative, Zabou claims that, if the parties' marks are not identical, they are highly similar. It argues that this, combined with the parties' goods and services being similar, will result in a likelihood of confusion. In the circumstances, Zabou submits that registration of PWB's application is contrary to section 5(2)(b) of the Act.

9. PWB filed counterstatements, denying the grounds of opposition/invalidity. Although it concedes that the competing marks are identical,⁵ it denies that its goods and services are identical or similar to those of Zabou's mark. It also indicated that it would require Zabou to provide proof of use of its mark.

10. Given the respective filing/priority dates, Zabou's mark qualifies as an "earlier trade mark" in accordance with section 6 of the Act. As it had completed its registration process more than five years before the filing date of PWB's application, it is subject to the proof of use requirements specified within section 6A of the Act. Moreover, as it had completed its registration process more than five years before the date on which its applications for invalidity were filed, it is subject to the proof of use requirements specified in section 47(2B) of the Act. Within its notices of opposition/invalidity, Zabou made varying statements of use for each of its actions.⁶

11. PWB seeks total revocation of Zabou's mark under sections 46(1)(a) and 46(1)(b) of the Act. Revocation is sought under section 46(1)(a) as a result of alleged non-use of Zabou's mark during the five-year period immediately following the date on which it was registered, i.e. 27 September 2014 to 26 September 2019. PWB requests an effective date of revocation of 27 September 2019. Revocation is also sought under section 46(1)(b) due to alleged non-use of the registration in the five-year period

⁵ PWB's counterstatements, §2

⁶ In its notice of opposition, Zabou made a statement of use in relation to all the goods of its mark, whereas, in its notices of invalidation, it made a statement of use in respect of some of its goods in class 25. The latter are consistent with the goods for which the revocation proceedings have been defended.

between 20 July 2016 and 19 July 2021. Under this ground, PWB requests an effective date of revocation of 20 July 2021.

12. Zabou filed a counterstatement in which it defended its registration for a limited list of goods in class 25, namely, *clothing; articles of clothing and headwear; articles of outerwear; articles made of denim; jeans; trousers; T-shirts; sweaters; sweatshirts; beach clothes; ready-made clothing*. Zabou also says that the Covid-19 pandemic caused a substantial slowdown in its face-to-face dealings, resulting in reduced sales in 2020 and 2021. These circumstances are relied upon as “proper reasons for non-use”.

13. On 14 January 2022, the proceedings were consolidated pursuant to rule 62(1)(g) of the Trade Marks Rules 2008 (“the Rules”).

14. Both parties filed evidence. A hearing was requested and held before me, by video conference, on 11 August 2023. Zabou was represented by Guy Tritton of counsel, instructed by Knights PLC. PWB was represented by Ian Bartlett of Beck Greener LLP.

Relevance of EU law

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

Procedural developments

16. Following the conclusion of the evidence rounds, Zabou requested a hearing. This was originally listed for 15 March 2023, which both parties confirmed they would be attending. However, on 1 February 2023, PWB made an application to cross-examine two of Zabou’s witnesses. After obtaining Zabou’s view on the same, a preliminary view was issued by the Registrar on 17 February 2023 to deny PWB’s request. A Case

Management Conference (“CMC”) was requested by PWB and scheduled for 6 March 2023.

17. Due to unforeseen and exceptional circumstances, the Registry informed the parties that both the CMC and the substantive hearing must be postponed. The CMC was rescheduled for 20 April 2023. Before the CMC, PWB filed without prejudice correspondence which it wished to rely upon to support its cross-examination request. I heard submissions from Messrs Bartlett and Tritton on the admissibility of the correspondence at the CMC. However, as it was only filed a very short time before the CMC, I gave interim directions that that the parties would have a period of 7 days thereafter in which to provide any further written submissions on whether the correspondence should be admitted into the proceedings, as well as copies of any other relevant correspondence between the parties. I also confirmed that a further CMC would be required to determine the cross-examination request.

18. Following receipt of further materials from Messrs Bartlett and Tritton, I refused PWB’s request to admit the without prejudice correspondence into the proceedings for the reasons I gave by letter on 4 May 2023. Another CMC was then scheduled for 23 May 2023 to determine PWB’s cross-examination request. After hearing submissions from Messrs Bartlett and Tritton in respect of the same, I refused PWB’s request for the reasons I gave by letter on 26 May 2023. Thereafter, the substantive hearing was relisted for 3 July 2023.

19. On 23 June 2023, PWB filed a notice of appeal and grounds of appeal in respect of my decision to refuse its cross-examination request. Mr Bartlett confirmed that no application was being made pursuant to rule 70(2) of the Rules. On 29 June 2023, the Registry wrote to the parties to acknowledge PWB’s notice of appeal. In light of Mr Bartlett’s comment to the effect that PWB was not seeking leave to appeal an interim decision, the Registry stated that the filing of the appeal was taken to be preserving PWB’s position pending the final determination of the proceedings.

20. On 30 June 2023 and 2 July 2023, respectively, Zabou and PWB both filed further evidence. On 3 July 2023, Zabou also conceded PWB’s appeal regarding cross-examination and acceded to the request. On 3 July 2023, I wrote to the parties to

confirm that the hearing would be adjourned, that both parties' requests to file further evidence were granted, and that both parties would have a short time in which they could file submissions or evidence in reply. I also outlined that, as PWB's appeal would not be processed until the final determination of the proceedings, there was nothing to concede at that time. Moreover, I confirmed that it was not within my authority to predetermine any such appeal and that, as I was *functus officio*, it would not be appropriate to revisit my decision to refuse the cross-examination request.

21. On 17 July 2023, Zabou filed two further witness statements in reply to PWB's additional evidence. PWB elected not to file anything further. A substantive hearing was then relisted for 11 August 2023. Messrs Bartlett and Tritton both filed skeleton arguments in advance of the same.⁷

Preliminary issue

22. I note that PWB has argued that the opposition proceedings should be struck out on the basis of them being abusive. According to Mr Bartlett, this is because Zabou made a statement of use in respect of all the goods for which its mark was registered; PWB did not consider this to be credible, since Zabou's mark covered a wide range of goods. As a result, Mr Bartlett argues that Zabou's notice of opposition contained an allegation that was manifestly untrue, in circumstances where Zabou and its representatives must have known the same.

23. Whilst these comments are noted, I do not consider this to be a basis to strike out Zabou's opposition. I acknowledge that Zabou did, in fact, state that it had used its mark in relation to "all goods and services".⁸ However, Zabou's mark is not registered for a particularly wide range of goods. Rather, it is limited to relatively short lists of goods in classes 18 and 25. Moreover, it would have become clearer which goods Zabou could substantiate its statement of use for relatively early in the proceedings, i.e. once its evidence was filed. Further, it is not uncommon for parties in proceedings before the Tribunal to claim use in relation to a wider range of goods and/or services

⁷ Mr Bartlett's skeleton argument dated 9 August 2023 supplemented those he filed on 29 June 2023.

⁸ Question 3a, Form TM7

than what the evidence later shows. Although I agree that it is preferable for parties to provide more precise statements of use as early as possible in proceedings, it is a party's prerogative to argue its case as it sees fit. In my view, that is not abusive, particularly if it is in the bounds of reasonableness.

Evidence

Zabou's evidence in chief

24. Zabou's evidence in chief is given in the witness statement of Zuber Moosa and two exhibits (ZM1-ZM2), the witness statement of Huzaifa Moosa and ten exhibits (HM1-HM10), the witness statement of Iqbal Moosa and ten exhibits (IM1-IM10) and the witness statement of Lookman Patel and five exhibits (LP1-LP5).

25. Zuber Moosa ("Zuber") is the operations director of Zabou. He says that the company was incorporated on 10 July 2015.⁹ He also says that he is a director of Zabou Clothing Company Ltd ("Z Clothing"), which was incorporated in 1994, and company secretary of Zabou Casualwear Ltd ("Z Casualwear"), which was incorporated in 2004.¹⁰

26. Zuber states that the "Zabou group of companies" manufactures and supplies menswear and accessories within the UK.¹¹ He says that Zabou has served "mainstream and elite" brands including Nike, Paul Smith and 883police over the past 30 years.¹² Photographs said to show Zabou's facilities in Preston have been provided;¹³ these are undated, though do show buildings adorned with the name 'zabou'. As well as office facilities, clothing samples marked "AW16" are also pictured.

27. Zuber says that the 'HUMAN RACE' brand was established in 2014 because of his experiences of travelling and interacting with people of diverse cultures.¹⁴ The

⁹ First witness statement of Zuber Moosa, §6

¹⁰ Zuber 1, §6

¹¹ Zuber, 1, §7

¹² Zuber 1, §9

¹³ Exhibit ZM1

¹⁴ Zuber 1, §§11-12

application for Zabou's mark was made on 13 June 2014 in the name of Z Casualwear and assigned to Zabou on 7 June 2016.¹⁵

28. Whilst Zuber understands from the proceedings that PWB is owned/controlled by Pharrell Williams, he says that he has no interest in music (due to his faith) and, therefore, had no awareness of Mr Williams when the 'HUMAN RACE' brand was conceived in 2014.¹⁶

29. Huzaifa Moosa ("Huzaifa") says he is the head of the "Zabou group of brands" and has day-to-day control of 'HUMAN RACE'.¹⁷ He states that, in 2017, he was tasked by Zabou's directors to develop it and appeal to younger customers.¹⁸ The approach, he says, was to introduce a small number of product lines under the brand and to expand over time.¹⁹

30. Huzaifa confirms that Zabou offers a range of clothing goods under 'HUMAN RACE', though is generally oriented towards denim clothing such as jeans.²⁰ In this connection, he provides an invoice, dated 7 April 2016,²¹ which shows the purchase by Z Casualwear of 1,899 pairs of 'HUMAN RACE' branded men's denim jeans (in styles 'Siege' and 'Esker') at a cost of £18,964.12. This is said to have been the first purchase of 'HUMAN RACE' branded denim jeans from manufacturers in Pakistan.²²

31. According to Huzaifa, when he took over in 2017, HUMAN RACE' product lines concentrated on denim garments and its marketing approach was based upon personal relationships and face-to-face dealings; he wanted to expand the product lines and adopt online/social media marketing methods.²³ He says he introduced new products for the brand, including sweatshirts, jogging bottoms/sweat pants, and t-

¹⁵ Zuber 1, §13; Exhibit ZM2

¹⁶ Zuber 1, §15

¹⁷ First witness statement of Huzaifa Moosa, §1

¹⁸ Huzaifa 1, §7

¹⁹ Huzaifa 1, §8

²⁰ Huzaifa 1, §9

²¹ Exhibit HM1

²² Huzaifa 1, §9

²³ Huzaifa 1, §10

shirts.²⁴ In this regard, he provides invoices, dated 3 October and 24 October 2017,²⁵ which show the purchase by Z Casualwear of 1,468 men's cotton pants (in styles Rocco and Lawren), 1,000 men's hooded sweatshirts, 236 men's t-shirts, and 120 men's crew necks from manufacturers in India. They are all branded 'HUMAN RACE'. The purchases totalled \$23,138.05. Trim card documents (from the manufacturers in India and Pakistan) dated 8 January 2017, 21 January 2017 and 18 January 2019, show the following hang tags and labels:²⁶



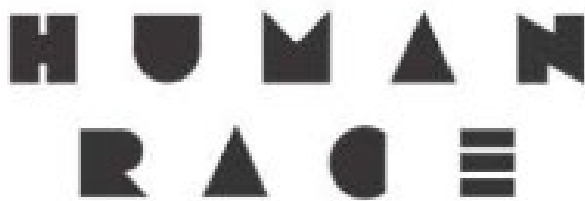
32. The “previous HUMAN RACE branding and logo” is said to have been as per the following examples:²⁷

²⁴ Huzaifa 1, §11

²⁵ Exhibit HM2

²⁶ Exhibit HM3

²⁷ Huzaifa 1, §12; Exhibit HM4



33. Huzaifa says that, in 2018 and 2019, Zabou continued to build its market presence and sell 'HUMAN RACE' branded denim jeans and sportswear/casualwear.²⁸ A lookbook/catalogue for the brand from 2018 has been provided.²⁹ Within the same, hooded sweatshirts, t-shirts, crew necks, joggers, and jeans can be seen. They are adorned with the words 'HUMAN RACE' in the style shown at paragraph 31 above. An e-commerce photoshoot was also held in 2019.³⁰ Photographs from the same have been provided,³¹ which feature 'HUMAN RACE' branded men's denim jeans. In 2020, the brand is said to have focused online sales towards sportswear/casualwear, whilst continuing to sell denim jeans to retailers.³²

34. As for marketing, Huzaifa says that, when he took over the brand, he considered what its direction would be if it was taken online; a report was prepared, but this was not pursued at the time.³³ In 2019, Zabou gave £1,500 in funding to develop a website

²⁸ Huzaifa 1, §13

²⁹ Exhibit HM5

³⁰ Huzaifa 1, §13

³¹ Exhibit HM6

³² Huzaifa 1, §14

³³ Huzaifa 1, §16

for the brand; the domain name established was humanraceclo.com.³⁴ In addition, 'HUMAN RACE' products were sold via fashion retailer MandM Direct.³⁵ Huzaifa states that the Covid-19 pandemic in 2020 caused Zabou to consider its marketing methods; previously, it had been based upon face-to-face dealings and wholesaling garments to independent standalone or small chain retailers, rather than directly to consumers (which accounted for 95% of Zabou's operating income between 2010-2018).³⁶ An investor pack was produced in 2019, a copy of which has been provided;³⁷ this suggests there was an intention to diversify in terms of the brand's reach. In part due to the Covid-19 pandemic, Zabou is said to have then increased its attention on electronic marketing; with physical retail stores closed, Zabou updated its website, created a direct-to-consumer e-commerce site with Shopify, and sold garments on eBay.³⁸ According to Huzaifa, the updated website went live in February 2021.³⁹ Screenshots of the website humanraceclo.com as of 15 November 2021 have been evidenced;⁴⁰ these show the plain word 'HUMANRACE' at the top of the website, as well as on t-shirts and hooded sweat shirts. Other products, such as sweat shirts and joggers, only feature the letters 'Hr' but are sold under the 'HUMANRACE' brand.

35. Iqbal Moosa ("Iqbal") is the Finance Director at Zabou. He confirms that the first purchase the company made of denims under the 'HUMAN RACE' brand was in 2016, from manufacturers in Pakistan; he also confirms that two orders were placed with manufacturers in India in 2017 for t-shirts, sweats, and joggers.⁴¹ Iqbal says that, in 2018, Zabou continued placing orders of t-shirts for the brand; in 2019, fresh orders for denim jeans (Siege and Esker), with the updated branding, were placed.⁴² In 2020, Iqbal says that a minimal order of denims was made due to the impact of Covid-19.⁴³ A table of information has been provided, which appears to show the brand's UK turnover (including VAT) as follows:⁴⁴

³⁴ Huzaifa 1, §17

³⁵ Huzaifa 1, §18

³⁶ Huzaifa 1, §19

³⁷ Huzaifa 1, §21; Exhibit HM9

³⁸ Huzaifa 1, §22

³⁹ Huzaifa 1, §23

⁴⁰ Exhibit HM10

⁴¹ First witness statement of Iqbal Moosa, §§6-7

⁴² Iqbal 1, §§8-9

⁴³ Iqbal 1, §10

⁴⁴ Exhibit IM1

Year	Turnover (£)
2016	8,016.00
2017	10,704.00
2018	20,536.80
2019	19,158.60
2020	132.07
2021	853.39
Total	59,400.86

36. Another table has been evidenced,⁴⁵ which shows the branded products ordered in 2021. From this, I note that 257 t-shirts, 356 sweaters/hoodies, and 83 joggers were ordered. Of these, 2 t-shirts, 204 sweaters/hoodies, and 2 joggers are labelled as invoiced, accruing £40, £611.16, and £60 in revenue, respectively.

37. Invoices from manufacturers in India and Pakistan, have been provided.⁴⁶ I note that some are duplicates of those provided by Huzaifa. However, there is also an invoice dated 11 February 2019, which shows the purchase of 3,075 branded men's jeans; an invoice dated 5 June 2018, which shows the purchase of 1,254 branded men's t-shirts; an invoice dated 20 August 2018, which shows the purchase of 535 branded men's t-shirts; an invoice dated 19 April 2019, which shows the purchase of 1,644 branded men's t-shirts and 213 branded men's sweatshirts; an invoice dated 14 May 2019, which shows the purchase of 969 branded men's t-shirts, 426 branded men's hooded sweatshirts, and 700 branded men's jogger pants; an invoice dated 31 May 2019, which shows the purchase of 2,452 branded men's t-shirts and 222 branded men's sweatshirts; an invoice dated 28 December 2020, which shows the purchase of 682 branded men's denim jeans; and an invoice dated 31 March 2021, which shows the purchase of 942 branded men's t-shirts, 139 branded men's hooded sweatshirts, 83 branded men's jogger pants, and 56 branded men's sweatshirts. The purchaser listed on all the invoices is Z Casualwear.

⁴⁵ Exhibit IM1

⁴⁶ Exhibit IM2

38. Iqbal says that these goods were wholesaled to retailers in the UK.⁴⁷ He provides invoices and statements of sales to retailers and direct consumers between 2016 and 2021.⁴⁸ These demonstrate the sale of the following ‘HUMAN RACE’ branded goods in the UK:⁴⁹

Year	Product	Quantity	Turnover (£)
2016	Jeans	397	7,761
	Total	397	7,761
2017	Jeans	1,388	8,060
	T-shirts	8	80
	Sweatshirts	170	3,276
	Joggers	35	560
	Total	1,601	11,976
2018	Jeans	150	3,000
	T-shirts	417	4,170
	Sweatshirts	221	4,367
	Joggers	75	1,130
	Total	863	12,667
2019	Jeans	2,420	16,223.50
	Total	2,420	16,223.50
2020	T-shirts ⁵⁰	33	111.27
	Total	33	111.27
2021	T-shirts	1	19.99
	Sweatshirts	202	521.16
	Hoodies	3	89.97
	Joggers	1	29.99
	Total	207	661.11

⁴⁷ Iqbal, §12

⁴⁸ Exhibit IM3-IM10

⁴⁹ Excluding the invoices which relate to other territories, such as, for example, Germany and India.

⁵⁰ These products are contained in invoices from Z Casualwear. The words “Human Race” can clearly be seen in the item descriptions, albeit that the invoices are headed with an ‘888POLICE’ logo. Although there is no indication as to what goods these invoices relate to, I have been able to cross-reference the item descriptions “Obsta”, “Surplus”, “Reality” and “Goanna” with Iqbal’s other evidence to conclude that all four products are t-shirts.

39. The invoices for 2016 to 2019 relate to the sale of goods to retailers (“B2B”) located in, *inter alia*, Preston, West Bromwich, Blackpool, Chesterfield, Ilford, London and Ebbw Vale. The figures for 2019 include sales to MandM Direct. These invoices are supported by statements; insofar as the statements relate to ‘HUMAN RACE’, they show the retailers being debited for jeans, joggers, sweatshirts and t-shirts.⁵¹ The invoices for 2020 appear to have been direct-to-consumer (“B2C”) via eBay. The orders were placed by individuals based in, *inter alia*, Manchester, Liverpool, Wrexham, Brighton, Derby, Leeds, Norfolk, London and Cornwall, in May and June of that year. In 2021, orders were made by what appears to be a retailer based in Watford, as well as individuals based in London, Dagenham, Oxford via Zabou’s online store.

40. Iqbal says that Zabou’s expenditure attributable to the ‘HUMAN RACE’ brand was as follows:⁵²

Year	Approximate expenditure (£)
2016	6,000
2017	10,000
2018	13,000
2019	18,500
2020	7,000
2021	16,000
Total	70,500

41. Iqbal says that the above figures include overheads, salaries, commissions, photoshoot costs, website development costs, editing costs, sampling costs, as well as marketing costs.⁵³ He adds that costs decreased in 2020 due to the Covid-19 pandemic.⁵⁴

⁵¹ Under item descriptions “Esker”, “Siege”, “Lawren”, “Savoy”, “Rocco” and “Langdo”, which I have cross-referenced with the invoices provided by Iqbal to confirm that they lines of the ‘HUMAN RACE’ brand.

⁵² Iqbal 1, §15

⁵³ Iqbal 1, §14

⁵⁴ Iqbal 1, §15

42. Lookman Patel (“Lookman”) is the IT and Online Manager of Zabou; he handles online marketing and Zabou’s website. He says that, before 2020, Zabou paid little or no attention to social media as a means of engagement; it had no dedicated social media team until the start of 2021.⁵⁵ Despite this, he says that consideration was given to developing a website for ‘HUMAN RACE’.⁵⁶ In this connection, an invoice dated 19 August 2014 for the purchase of a domain, humanrace.eu, and an email dated 8 January 2017 from Zuber in which he references creating an online marketplace for the ‘HUMAN RACE’ brand at that address have been provided.⁵⁷

43. This was not pursued, but Lookman says that the online presence of ‘HUMAN RACE’ came into greater focus when Huzaifa took control in 2017.⁵⁸ He states that, in 2019, he was asked to source and oversee the project of creating a new website; this was established under the domain name humanraceclo.com.⁵⁹ Initially it served as an online brochure of products for Zabou’s retailers.⁶⁰ That year, he confirms that ‘HUMAN RACE’ products also made it onto the MandM Direct website.⁶¹ Printouts from the website are exhibited, though they are not dated.⁶²

44. Lookman says that wholesale channels were closed in 2020 and there was a lack of available stock due to the Covid-19 pandemic.⁶³ This prompted Zabou to pay more attention to digital marketing and it was decided in mid-2020 that the website would be developed into a functioning e-commerce website; according to Lookman, this was completed in early 2021.⁶⁴ In 2020, Lookman says that Zabou started using eBay to sell ‘HUMAN RACE’ branded clothing and ran some “pay per click” promotions.⁶⁵ A report confirming six such promotions has been provided;⁶⁶ these ran between October 2020 and October 2023, in March and June 2021, and from March 2021 to

⁵⁵ First witness statement of Lookman Patel, §9

⁵⁶ Lookman 1, §10

⁵⁷ Exhibit LP1 and LP2

⁵⁸ Lookman 1, §§10-11

⁵⁹ Lookman 1, §11

⁶⁰ Lookman 1, §11

⁶¹ Lookman 1, §12

⁶² Exhibit LP1

⁶³ Lookman 1, §13

⁶⁴ Lookman 1, §13

⁶⁵ Lookman 1, §15

⁶⁶ Exhibit LP4

the present, prompting the sale of 30 'HUMAN RACE' branded men's hooded sweatshirts.

PWB's evidence

45. PWB's evidence is given in a witness statement from Mr Bartlett, together with nine exhibits (IB1-IB9). As noted above, Mr Bartlett is PWB's professional representative. He says that PWB is owned and controlled by the famous American singer/songwriter Pharrell Williams. He states that Mr Williams has received numerous awards, such as 13 Grammy awards and three Producer of the Year awards, whilst his music has often featured in the UK charts.⁶⁷

46. According to Mr Bartlett, Mr Williams collaborated with Adidas to produce a footwear range, which was launched in July 2016.⁶⁸ Printouts from Adidas' website have been provided in support of this.⁶⁹ I note that the word 'Humanrace' appears next to an Adidas logo, above the words "Shop All Pharrell"; the printouts also say "The adidas Originals x Pharrell Williams collaboration...". However, the printouts are undated and appear to be from Adidas' global website. A printout from the online blog *Hot New Hip Hop* is also in evidence.⁷⁰ It features an article dated 19 July 2016, which discusses Mr Williams' "Human Race" collaboration with Adidas. There is no indication as to how many views the article had (aside from a very small number of likes and comments), or whether it is a UK-facing website. Mr Bartlett considers it likely that Zabou was aware of the launch, not least because, in August 2019, Zabou would have been notified by the IPO of the publication of PWB's applications.⁷¹

47. Mr Bartlett states that Mr Williams launched a skincare line under 'HUMANRACE' from his website at humanrace.com.⁷² Printouts of the global website (one obtained via *Wayback Machine*) are in evidence.⁷³ I note that, as of 25 November 2020 and 22 August 2022, the website featured the word 'Humanrace' in plain font, as well as the

⁶⁷ Witness statement of Ian Bartlett, §4

⁶⁸ Bartlett, §5

⁶⁹ Exhibit IB2

⁷⁰ Exhibit IB3

⁷¹ Bartlett, §§6-7

⁷² Bartlett, §8

⁷³ Exhibits IB4 and IB5

colour green. Mr Bartlett takes issue with Lookman's evidence regarding the revamping of Zabou's website insofar as Lookman does not say what it looked like between the acquisition of the domain in February 2019 and when it was relaunched.⁷⁴ He provides printouts of Zabou's website (obtained via *WayBack Machine*) dated 19 January 2022,⁷⁵ which also feature the conjoined word 'HUMANRACE' and the colour green. Due to this, Mr Bartlett states that "it is not credible in my view, that Zabou did not consciously copy key features of [PWB's] website when it launched what [Lookman] says was its revamped website".⁷⁶ He also says that 'HUMAN RACE'/'HUMAN RACE' had not featured on Zabou's main corporate website at zabou.co.uk until very recently.⁷⁷ Printouts from the website (one obtained via *WayBack Machine*) dated 2 March 2021 and 22 August 2022 and have been provided;⁷⁸ there is no mention of the 'HUMAN RACE' brand.

48. Finally, Mr Bartlett opines that any use after 2016, at least, was for the ulterior purpose of trying to maintain the enforceability of Zabou's registration and "it is assumed" trying to leverage a sale of Zabou's mark to PWB; he argues that such use is not genuine and should be discounted.⁷⁹

Zabou's evidence in reply

49. Zabou filed evidence in reply in the form of second witness statements from Zuber and Lookman. The former is accompanied by eight exhibits and the latter by two exhibits.⁸⁰

50. Lookman seeks to respond to Mr Bartlett's criticisms of his first statement regarding Zabou's website. He states that he is unable to access the website prior to the revamp but he recalls that the website was very similar to the mock-up.⁸¹ He

⁷⁴ Bartlett, §9

⁷⁵ Exhibit IB6

⁷⁶ Bartlett, §10

⁷⁷ Bartlett, §11

⁷⁸ Exhibits IB7 and IB8

⁷⁹ Bartlett, §13

⁸⁰ As these have the same naming regime as Zuber and Lookman's first statements, I shall hereafter refer to them as ZM(2)1-ZM(2)8 and LP(2)1-LP(2)2

⁸¹ Second witness statement of Lookman Patel, §3

provides a copy of the mock-up.⁸² It features the word ‘HUMANRACE’ in a standard, italicised font. The copyright notice is given as 2019.

51. Whilst Lookman says that he was aware of Mr Williams’ website, he denies that he copied any of its features.⁸³ He provides an alternate rationale for why the colour green was chosen: Zabou felt it perfectly represented the identity of the ‘HUMAN RACE’ brand and the planet, as well as it being forecasted to be an in-trend colour in 2020.⁸⁴ Lookman also states that the colour was chosen prior to Mr Williams’ website going live and that the design of the website is a standard theme provided by the e-commerce company Shopify.⁸⁵ He provides a document which is said to show Zabou’s thought process in choosing the colour green.⁸⁶ The document, entitled “Humanrace website revamp 21”, features different colour scheme options (green being the first).

52. Zuber reiterates that, as a devout Muslim of an older generation, he has no interest in music or singers, and had no awareness of Mr Williams.⁸⁷ He also says that he was unaware of the launch of the collaboration between Mr Williams and Adidas in July 2016; when he became aware in 2017, he did not perceive them to be using ‘HUMAN RACE’ as a brand but, rather, as a one-off public relations exercise.⁸⁸ In this regard, he argues that the “real brand” of Mr Williams was ‘Hu NMD’.⁸⁹ Zuber provides a Twitter post from Adidas, dated 18 July 2016, an article from *Hypebeast*, dated 23 September 2016, and an article from *Dropdate*, dated 29 September 2016.⁹⁰ I note these materials refer to ‘Hu NMD’, rather than ‘HUMAN RACE’. Printouts from various other websites showing the trainers have been evidenced.⁹¹ They show both ‘Hu NMD’ and ‘Human Race’ being used in connection with the collaborative exercise, though none of the printouts is dated.

⁸² Exhibit LP(2)2

⁸³ Lookman 2, §5

⁸⁴ Lookman 2, §§5-6

⁸⁵ Lookman 2, §§5-7

⁸⁶ Exhibit LP(2)1

⁸⁷ Second witness statement of Zuber Moosa, §3

⁸⁸ Zuber 2, §5

⁸⁹ Zuber 2, §6

⁹⁰ Exhibit ZM(2)1

⁹¹ Exhibit ZM(2)2

53. As for the parties' websites, Zuber says that Mr Bartlett overemphasises that the predominant colour of Mr Williams' website is green; he says, at best, the word 'Humanrace' and the skincare containers shown are green.⁹² He also denies that the colour was copied by Zabou; he says it was chosen because it is the natural colour for the message/brand ethos that Zabou desired, i.e. belonging and living on planet Earth, which we share and must protect.⁹³

54. Zuber claims that PWB initially chose the colour blue for the brand and, before 9 November 2020, there was nothing on the website at all.⁹⁴ In this connection, he provides printouts (obtained via *WayBack Machine*) of humanrace.com, dated between 2016 and 2020.⁹⁵ I note that, as of 1 February 2016 and 23 April 2017, the website featured only what appears to be a contact form and the words 'Human' and 'Race.com', separated by a depiction of the globe. The colours used are black and white, aside from the oceans/seas being blue. As of 22 July 2017, 19 March 2018, 23 December 2019 and 22 February 2020, the website only featured a password field and a login button for what is described as a protected site. There is no reference to 'HUMAN RACE'. Not until 9 November 2020 is Mr Williams mentioned on the website. At that time, there was use of the word 'Humanrace', whereas the colour theme was blue and white. This was replaced as of 12 November 2020 with green and white, which continued thereafter.

55. Zuber reiterates much of what Lookman says regarding Zabou's website prior to the revamp and provides copies of the documents discussed above.⁹⁶ He also states that zabou.co.uk is a holding website which only recently featured the brand 'HUMAN RACE'; the company deals with trade and retail customers directly and, if it were to refer customers to websites, these would generally be to the individual brand website.⁹⁷ He says that there was no brand website for 'HUMAN RACE' because humanrace.com was not available, the domain having previously been owned by a

⁹² Zuber 2, §11

⁹³ Zuber 2, §12

⁹⁴ Zuber 2, §13

⁹⁵ Exhibit ZM(2)3

⁹⁶ Zuber 2, §§15-16; Exhibits ZM(2)4-ZM(2)5, being the website mock-up and the document showing colour options also provided by Lookman.

⁹⁷ Zuber 2, §18

third party (until PWB's launch of its website in November 2020) and registered in 1997.⁹⁸ This is confirmed by information from *WHOIS*.

56. Zuber denies Mr Bartlett's accusation that Zabou was attempting to leverage a sale of its mark to PWB.⁹⁹ He says that Zabou has never offered to sell its trade mark to PWB or anyone else; according to Zuber, there has been without prejudice correspondence between the parties, initiated by PWB, but Zabou has not responded.¹⁰⁰

Zabou's additional evidence

57. Zabou's additional evidence came in the form of Huzaifa's second witness statement and one exhibit (HM11). He seeks to respond to Mr Bartlett's skeleton argument, specifically, his accusation that products ordered from the manufacturer in Pakistan on 7 April 2016 were not labelled and did not bear the 'HUMAN RACE' mark.¹⁰¹

58. Huzaifa says that he has already given evidence as to 'HUMAN RACE' branding before 2017 (Exhibit HM4); nevertheless, he says that he conducted a search of Zabou's archives for evidence of the labelling.¹⁰² Huzaifa says that the design and quality control teams did not have any such evidence due to the time that has elapsed and samples being kept for no more than one or two seasons; moreover, no stock remains of the older style.¹⁰³ However, he was able to locate two photographs from the head of the quality control team, and says that they show a pair of 'HUMAN RACE' branded jeans photographed on 29 May 2015; Huzaifa says that the photographs show a pre-production sample of the products ordered from the manufacturers on 7 April 2016.¹⁰⁴ Copies of the photographs have been provided.¹⁰⁵ They show a pair of

⁹⁸ Zuber 2, §19

⁹⁹ Zuber 2, §§9 and 23

¹⁰⁰ Zuber 2, §23.3

¹⁰¹ Second witness statement of Huzaifa Moosa, §3

¹⁰² Huzaifa 2, §4

¹⁰³ Huzaifa 2, §§5-6

¹⁰⁴ Huzaifa 2, §§7-13

¹⁰⁵ Exhibit HM11

“Siege” jeans. Although the images are not extremely clear, the branding on the labels and tags appears to be consistent with those shown above at paragraph 32.

PWB’s additional evidence

59. PWB filed additional evidence in the form of a witness statement from Susan Davey and seven exhibits (SCD1-SCD7). Ms Davey is a solicitor in the employ of PWB’s professional representatives.

60. Ms Davey provides a company statement of Z Casualwear from Companies House.¹⁰⁶ She also provides the relevant pages of Z Casualwear’s statutory accounts filed with Companies House from 2018 to 2022.¹⁰⁷ All this is provided to say that Z Casualwear’s financial value appears to have increased since 2019, on the basis of the “total equity” information.¹⁰⁸ The evidence suggests that company’s net assets and total equity figures were as shown below. On the face of it, they appear to show a drop between 2018 and 2019, then an increase from 2019 onwards.

Year	Total equity (£)
2018	3,315,229
2019	3,127,618
2020	3,135,398
2021	3,392,945
2022	4,366,651

61. Ms Davey says that t-shirts, sweatshirts, hoodies and sweatpants are examples of loungewear, whilst the Collins Dictionary defines ‘loungewear’ as casual and comfortable clothes suitable for lounging.¹⁰⁹ Articles regarding the rise in demand for loungewear in the UK during the Covid-19 pandemic have been provided.¹¹⁰ They are from *Drapers Record* and *Fashion Focus*, and are dated 3 April 2020, 14 May 2020 and 24 February 2022. The articles suggest that these clothing items became more

¹⁰⁶ Exhibit SCD1

¹⁰⁷ Exhibits SCD2-SCD5

¹⁰⁸ Witness statement of Susan Davey, §§3-4

¹⁰⁹ Davey, §5

¹¹⁰ Exhibit SCD7

popular during the pandemic because people were spending more time at home. Some comments also suggest that the sales of these goods continued during the pandemic, despite declines elsewhere in the retail sector.

Zabou's additional evidence in reply

62. Zabou's additional evidence in reply came in the form of a second witness statement from Iqbal, with two exhibits (IM11-IM12), and a third witness statement from Huzaifa, with six exhibits (HM12-HM16).

63. Iqbal responds to the evidence provided by Ms Davey. He says that Zabou does not maintain separate accounts for each brand it sells.¹¹¹ However, he gives evidence that Zabou has a number of brands and, at various times, some of them have been profitable, some have broken even, whilst others have been loss making.¹¹² Further, that one brand's loss can be sustained by another brand's profitability, and in one good trading year a formerly loss-making brand can make up for several prior years of losses.¹¹³

64. Iqbal states that 'HUMAN RACE' is some way behind the development of one of its other brands, '883 POLICE'; he feels the evidence demonstrates that by 2016 the latter was already a well-established and profitable brand, contributing over £5m in revenue at that time.¹¹⁴

65. To the extent they are available, Iqbal provides profit/loss accounts, detailed trading and profit/loss accounts, and a schedule of administrative expenses for each financial year between 31 January 2016/17 and 31 January 2021/22 for Z Casualwear.¹¹⁵ This evidence shows the following financial information for the company:

¹¹¹ Second witness statement of Iqbal Moosa, §8

¹¹² Iqbal 2, §9

¹¹³ Iqbal 2, §10

¹¹⁴ Iqbal 2, §12

¹¹⁵ Exhibit IM11

Year	Turnover (£)	Cost of sales (£)	Administrative expenses (£)	Profit (£)
2016	4,941,942	2,858,804	1,976,079	29,586
2017	4,331,962	3,067,808	714,279	566,067
2018	5,367,741	3,348,346	1,631,883	341,126
2019	5,690,667	4,080,533	1,453,030	-37,611
2020	6,572,422	4,776,841	1,561,539	180,220
2021	7,189,106	5,327,512	1,564,712	493,683
2022	8,459,846	5,658,902	1,697,674	1,265,894

66. In addition, Iqbal provides a breakdown of Zabou's financial data by reference to B2B and B2C sales.¹¹⁶ I note there is no information for 2016/17 or 2017/18. However, B2C sales accounted for £212,924 of turnover in 2019, £296,445 of turnover in 2020, £350,395 of turnover in 2021 and £362,026 of turnover in 2022.

67. Iqbal says that, unlike its '883 POLICE' products, 'HUMAN RACE' products were only sold B2B before 2020 and, except for MandM Direct, their retail customers were smaller independent outlets without significant e-commerce platforms, selling products mostly or exclusively in-store.¹¹⁷ In 2020, it is said that all 'HUMAN RACE' sales were B2C via eBay, whilst in 2021 they were online through its e-commerce website.¹¹⁸

68. According to Iqbal, during 2020 and 2021, Zabou saw a significant drop in sales to retailers due to the Covid-19 pandemic.¹¹⁹ This is said to have impacted 'HUMAN RACE' much more than '883 POLICE' because the former was only really sold B2B; these consumers would purchase stock after face-to-face meetings or showcases, which could not take place.¹²⁰ On the other hand, '883 POLICE' managed to achieve healthy sales B2C online and B2B to retailers who had significant e-commerce

¹¹⁶ Exhibit IM12

¹¹⁷ Iqbal 2, §§13.1-13.3

¹¹⁸ Iqbal 2, §13.4

¹¹⁹ Iqbal 2, §13.5

¹²⁰ Iqbal 2, §13.5

platforms.¹²¹ He says that, whilst ‘HUMAN RACE’ sales “plummeted” in 2020 and picked up in 2021, sales of ‘883 POLICE’ products in that period were healthy.¹²²

69. During these years, Iqbal says that Zabou supplemented its turnover by significant sales of personal protective equipment.¹²³ I note from the breakdown of financial data that £1,563,155 of turnover in 2021 and £241,355 of turnover in 2022 are attributed to such goods.

70. Huzaifa seeks to address two issues arising from Ms Davey’s statement: the loungewear sector during the Covid-19 pandemic and the financial performance of Z Casualwear.

71. Huzaifa argues that the articles provided by Ms Davey referring to sales of loungewear must relate to sales through e-commerce websites because physical shops were closed.¹²⁴ He acknowledges that some retailers may have reported steady sales of loungewear and that consumers may have continued to order these goods via e-commerce websites.¹²⁵ However, he states that total sales of clothing fell by £9.6billion despite online sales of clothing increased by £2.7billion over the course of the pandemic.¹²⁶ These figures are taken from an October 2021 report from *Retail Economics* and *Eversheds Sutherland*.¹²⁷ According to Huzaifa, it follows that the drop in total sales is attributable to a huge drop in the sale of clothing from physical outlets.¹²⁸

72. He reiterates that ‘HUMAN RACE’ did not have a functioning e-commerce website until early 2021; therefore, whilst some sales were made to retailers with their own platforms (such as MandM Direct), the majority of sales were made to physical shops, which Huzaifa says were closed between March 2020 and April 2021.¹²⁹ Huzaifa states that Zabou had no e-commerce platform for ‘HUMAN RACE’ for a large part of

¹²¹ Iqbal 2, §13.5

¹²² Iqbal 2, §15

¹²³ Iqbal 2, §14

¹²⁴ Third witness statement of Huzaifa Moosa, §6

¹²⁵ Huzaifa 3, §6

¹²⁶ Huzaifa 3, §7

¹²⁷ Exhibit HM12

¹²⁸ Huzaifa 3, §7

¹²⁹ Huzaifa 3, §8

the pandemic and that Zabou's main website was not such a platform; it could not be used to sell 'HUMAN RACE' goods.¹³⁰ Although an attempt was made to sell online via eBay, Huzaifa concedes it was not very successful.¹³¹

73. Huzaifa says that, although the e-commerce website for 'HUMAN RACE' went live in February 2021, Zabou was having to create an entirely new B2C market for the brand.¹³² He says that it takes a substantial amount of time for consumers to become aware of an e-commerce platform and that Zabou was in a wholly different position to established retailers who had e-commerce platforms online for many years before the pandemic.¹³³

74. He states that Zabou has a number of brands which differ in their products and styles, maturity, whether they are B2B or B2C, their methods of sales and marketing; he says that Covid-19 had a more significant and detrimental impact on its sales of 'HUMAN RACE' products than on its '883 POLICE' products.¹³⁴ Huzaifa states that '883 POLICE' is Zabou's most successful brand; it was released in 1995 and had a dedicated e-commerce platform dating back to 2013.¹³⁵ Printouts of the website 883Police.com dated between 25 December 2013 and 4 October 2022 (obtained via *WayBack Machine*) have been provided, as has a printout of the website as of 14 July 2023.¹³⁶ Google Search results in evidence also suggest that '883 POLICE' clothing is available from third-party retailers.¹³⁷ The brand's Instagram page has over 22,000 followers.¹³⁸ It also appears to have dedicated retail stores in Manchester, Birmingham and London.¹³⁹ All this, Huzaifa says, shows that '883 POLICE' was in a much better position (in terms of finances, development, public recognition and its e-commerce capabilities) before the pandemic began.¹⁴⁰

¹³⁰ Huzaifa 3, §9

¹³¹ Huzaifa 3, §9

¹³² Huzaifa 3, §§10-11

¹³³ Huzaifa 3, §§11-12

¹³⁴ Huzaifa 3, §15

¹³⁵ Huzaifa 3, §§16-17

¹³⁶ Exhibit HM13

¹³⁷ Exhibit HM14

¹³⁸ Exhibit HM15

¹³⁹ Exhibit HM16

¹⁴⁰ Huzaifa 3, §22

75. By contrast, Huzaifa says that ‘HUMAN RACE’ was a much younger brand, did not have an e-commerce website and was so heavily reliant on face-to-face meetings and sales to physical retailers that Covid-19 was disastrous for the brand way beyond the effect on ‘883 POLICE’; the latter helped keep the former “alive” during this period.¹⁴¹

76. Finally, Huzaifa states that Zabou was able to produce personal protective equipment during the pandemic, which it sold to the private sector; these sales improved the financial health of Zabou but did nothing for the sales figures relevant to ‘HUMAN RACE’.¹⁴²

PWB’s application to revoke Zabou’s mark

The law

77. Section 46 of the Act states:

“46. - (1) The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not 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, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c) [...]

¹⁴¹ Huzaifa 3, §§24-25

¹⁴² Huzaifa 3, §26

(d) [...]

(2) For the purpose of subsection (1) 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 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.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) [...]

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from-

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date”.

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

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

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

“114. [...] The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kameradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

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].”

80. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services protected by the mark” is not, therefore, genuine use.¹⁴³

81. The relevant period for assessing whether there has been genuine use of Zabou’s mark under section 46(1)(a) is 27 September 2014 to 26 September 2019 (“the first relevant period”), while that under section 46(1)(b) is 20 July 2016 to 19 July 2021 (“the second relevant period”). I will focus upon the second relevant period, given that

¹⁴³ *Intermar Simanto Nahmias v Nike Innovate C.V.*, BL O/222/16

genuine use during the same will be sufficient to avoid revocation under section 46(1)(b) and, by virtue of the provisions of section 46(3), section 46(1)(a).

Sufficient use

82. The evidence suggests that Zabou's 'HUMAN RACE' brand was established in 2014 by Zuber. The first purchase of 'HUMAN RACE' branded goods from overseas manufacturers was made on 7 April 2016. Invoices from the manufacturers indicate that these were 'HUMAN RACE' branded men's denim jeans. Invoices have also been provided which demonstrate the sale of such goods to retailers in the UK. However, Zabou's witnesses have indicated that the branding at that time included the words 'HUMAN RACE' in a heavily stylised font (as shown at paragraph 32). In my view, this is not acceptable variant use of Zabou's mark. The distinctive character of Zabou's mark lies in the words themselves. In the previous branding, the words are presented in a heavily stylised font, where the letters are either incomplete or filled in where gaps ordinarily appear. Whilst the words may still be identified, consumers would be required to add missing parts, or remove additional parts, of the letters. To my mind, this constitutes an alteration of the distinctive character of the word-only mark.¹⁴⁴ As a consequence, the sales from 2016 must be disregarded.

83. In 2017, new products were introduced, the brand having previously focused on denim garments. Orders were made in October 2017, as well as in 2018, 2019, 2020 and 2021, for jeans, t-shirts, sweatshirts, hoodies and joggers. The trim card documents suggest that these goods featured black hang tags and labels adorned with the word 'HUMANRACE' in a standardised white font (as shown at paragraph 31). A lookbook/catalogue from 2018 also features hoodies, t-shirts, sweatshirts, joggers and jeans featuring this branding. Photographs have been provided from a 2019 photoshoot, in which 'HUMAN RACE' branded men's jeans are clearly visible. I consider these evidenced marks to be acceptable variant use of Zabou's mark, since presenting the words in a standardised white font on a black background is an

¹⁴⁴ *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22

expression of the mark in normal and fair use;¹⁴⁵ it does not alter the distinctive character of the mark as registered.

84. The evidence suggests that Zabou's UK turnover connected with the sale of 'HUMAN RACE' goods totalled around £50,000 between 2017 and 2021. This is supported by invoices to eleven different retailers, most of whom were repeat customers. The invoices show that the retailers were also relatively widespread geographically. Additional documentary support for the turnover figures can be found in the invoices to B2C consumers, which demonstrate the sale of 'HUMAN RACE' goods via eBay and Zabou's website to individuals across the UK. Whilst the figures are small, particularly in the context of what I understand to be an extremely large market, they are not economically insignificant.

85. Zabou maintains that it spent approximately £70,000 on the 'HUMAN RACE' brand during the second relevant period. Although that figure includes expenses that are ordinary in the running of a business and cannot be said to be directly relevant to commercial use of a trade mark (such as, for example, overheads and salaries) it also includes marketing costs. As such, whilst there is no documentary evidence of conventional marketing activities having been conducted (such as media advertising, for instance), it is at least indicative of an economic commitment in this regard. Moreover, there is evidence that Zabou commissioned six "pay per click" promotions on eBay, which ran towards the end of the second relevant period. A website for the brand was also created in 2019, which initially served as an online brochure of products but later became a functioning e-commerce website which supported B2C sales of 'HUMAN RACE' clothing.

86. The evidence is not without its limitations and, clearly, the scale of use of Zabou's mark is small. I acknowledge that, as the case law makes clear, not every proven commercial use of a mark may automatically be deemed to constitute genuine use. However, the also case law stipulates that use does not need to be quantitatively significant for it to be deemed genuine.

¹⁴⁵ *Dreamersclub Ltd v KTS Group Ltd*, BL O/091/19

87. I also remind myself of *Memory Opticians Ltd's Application*, BL O/528/15, in which Professor Ruth Annand, as the Appointed Person, upheld a decision to revoke a mark on the grounds that it had not been put to genuine use within the requisite five-year period. In that case, there had been sales of goods bearing the mark, but these were very low in volume (around 40 pairs of spectacles per year) and all the sales were local (from three branches of an optician). There was no advertising of goods under the mark, and they were only displayed in-store on occasion. The mark was said to have been applied to the goods via a sticker applied to the arms of a dummy lens. This level of use was held to be insufficient to create or maintain market under the mark. Consequently, it was not genuine use. However, I do not consider the circumstances of this case to be on all fours with that considered by Professor Annand. The evidence shows that 1,601 products were sold in 2017, 863 in 2018, 2,420 in 2019, 33 in 2020 and 2 in 2021 (before the end of the second relevant period). Overall, this equates to around 5,000 products. These products were sold to multiple retailers in various locations across the UK, as well as a number of individuals on a B2C basis. Zabou's mark (or acceptable variants thereof) appears on the invoices, on tags and labels, and on some of the products themselves. Products bearing the mark also featured in a lookbook/catalogue and on a website. Zabou has also spent on marketing and promoted 'HUMAN RACE' products via eBay's "pay per click" function.

88. Furthermore, I acknowledge that Zabou's business was impacted by the Covid-19 pandemic and subsequent lockdowns/restrictions. It is clear from the evidence that turnover accrued from the sale of 'HUMAN RACE' goods was far lower in 2020 and 2021 than it had been in the preceding years. Prior to the pandemic, Zabou had a long-standing approach of conducting business by developing personal relationships, showcasing products in person and other face-to-face dealings. Moreover, prior to 2020, 'HUMAN RACE' goods were exclusively sold to retailers, rather than directly to consumers. Zabou's evidence is that, aside from MandMDirect, their customers were smaller independent outlets without significant e-commerce operations. Whilst I do not accept that it would have been impossible to do any business at all in 2020 and 2021, there were two national lockdowns during which non-essential retail stores were

closed,¹⁴⁶ as well as other public health restrictions during these years which varied in severity and by region. Whilst no direct evidence of it has been filed, it seems reasonable to infer that most of the retailers that had been purchasing ‘HUMAN RACE’ clothing would not have been open or purchasing new stock. The evidence suggests that efforts were made to repurpose the ‘HUMAN RACE’ website to facilitate B2C sales; however, at the beginning of the pandemic, Zabou did not have an existing e-commerce platform through which to achieve sales. Whilst entering lockdowns or being subject to public health restrictions may not have negatively impacted all businesses, given Zabou’s prior business approach and customer base, I can certainly appreciate how sales of ‘HUMAN RACE’ goods would have suffered. I take the above considerations into account, not as “proper reasons for non-use” *per se* but, rather, as a factor in characterising the market in which Zabou was operating and explaining why there was a significant drop-off in sales towards the end of the second relevant period.

89. A large focus of the parties in these proceedings has been Zabou’s intentions in using its mark and whether that use was ‘token’. PWB’s case on this, as put forward by Mr Bartlett at various points in these proceedings, is that Zabou must have been aware of Mr Williams’ interest in the ‘HUMAN RACE’/‘HUMANRACE’ brand, his collaborative launch with Adidas and his website, such that any use of Zabou’s mark was for the purposes of trying to maintain the registration so that a sale to PWB could be leveraged.

90. Firstly, there is a distinct lack of evidence which demonstrates that Zabou attempted to leverage a sale of its mark to PWB. This was accepted by Mr Bartlett at the hearing. Further, I am not satisfied that the evidence in these proceedings suggests that this was the case, or that Zabou had an ulterior motive in using its mark.

91. As outlined above, the issue was first raised by Zuber, who gave evidence that he had no awareness of Mr Williams when the brand was first conceived. The crux of Mr Bartlett’s challenge to that appears to be that Mr Williams is a renowned artist who collaborated with Adidas in July 2016 to produce footwear under the ‘Humanrace’

¹⁴⁶ According to the Office for National Statistics, those being from 23 March to mid-May 2020 and from 4 January 2021 onwards, with restrictions gradually lessening.

brand, such that Zabou must have been aware of him. Zuber responded to this by maintaining that he had no awareness of Mr Williams, given his faith, or the launch of the collaboration.

92. Although Mr Williams is an award-winning artist, I do not consider his fame to be on such a scale that it should be assumed that all individuals are aware of him. In addition, individuals have different interests and I accept that faith may influence who you are aware of. In any event, even if those at Zabou were aware of Mr Williams, that does not prove that they would have been aware of his interest in the brand.

93. As for the collaboration with Adidas, whilst on the balance of the evidence I accept that this occurred, the evidence provided is limited to a small number of printouts from global websites (some of which are undated). There is insufficient evidence of use by Mr Williams/Adidas to demonstrate that Zabou (or, indeed, any significant proportion of consumers) would have been exposed to, and subsequently became aware of, their use of the mark.

94. I am also not convinced that perceived similarities between the parties' websites must mean that Zabou copied elements of Mr Williams' website or that this ought to be considered indicative of a deeper ulterior motive. Printouts of Mr Williams' website dated 25 November 2020 (at the earliest) have been provided. A mock-up of Zabou's website with a copyright notice of 2019 in evidence and its witnesses have explained the rationale for the appearance of the revamped website. I have no reason to disbelieve the copyright notice in the mock-up document. Furthermore, standard themes and in-trend colours are credible reasons for using them on a website. Whilst Lookman says he was aware of Mr Williams' website, I do not consider that to be compelling evidence that Zabou copied it as a means to "goad" him into wanting to purchase its mark.

95. Mr Bartlett also makes much of the fact that Zabou allegedly suffered great losses under its 'HUMAN RACE' brand. He says that this defies normal commercial logic and, therefore, must be indicative of token use. I do not agree. Although the evidence in these proceedings may suggest that Zabou suffered overall losses in respect of the brand, it is not uncommon for businesses to be loss making, particularly when

attempting to establish a new brand. I do not consider use of a mark in the context of commercial losses to be indicative *per se* of any ulterior motive.

96. It is also worth mentioning that there is no bad faith pleading in these proceedings. Whilst PWB argues that Zabou's intentions are relevant to the question of whether its use of its mark was 'token', this has been characterised in the case law as being use which is "solely to preserve the rights conferred by the registration of the mark". Even if Zabou was aware of Mr Williams and his alleged entrance into the market under the contested marks, there has been real commercial use of Zabou's mark; as such, that would not be solely to preserve the registration. The evidence discussed above, albeit showing use on a small scale, points to use for commercial purposes, i.e. it is not indicative of token use. This is particularly the case, given the use commenced and continued before the proceedings were initiated. I should also add that PWB has not provided any authorities where use of a trade mark was found to be token due to knowledge of a competitor or their interest in a given mark. To my mind, there are no objective indicia in this case which suggest that Zabou's use of its mark was to solely to preserve the registration, or for any ulterior purposes.

97. In light of all the above, whilst the evidence suggests small-scale use, I do not consider it to be trivial or token. It is my view that Zabou has attempted to create a market for its goods under the 'HUMAN RACE' mark. Taking the evidential picture as a whole into account, I am satisfied that Zabou has demonstrated genuine use of its mark in the second relevant period.

Fair specification

98. I will now consider the extent to which the evidence shows use of Zabou's mark in relation to the goods. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs QC as the Appointed Person summed up the law as being:

"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.”

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

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

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

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

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

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed

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

100. I remind myself that Zabou defended its registration in respect of *clothing; articles of clothing and headwear; articles of outerwear; articles made of denim; jeans; trousers; t-shirts; sweaters; sweatshirts; beach clothes; ready-made clothing* in class 25.

101. Within his skeleton argument, Mr Tritton conceded on behalf of Zabou that there has been no genuine use of its mark in respect of *headwear* and *beach clothes*. These terms will be removed from the specification.

102. The evidence shows use on denim jeans, t-shirts, sweatshirts, hoodies and joggers. On the basis this, I am satisfied that there has been use in relation to *jeans, t-shirts* and *sweatshirts*. However, the evidence suggests that these goods were only for men. Therefore, these terms will be amended to *men’s jeans, men’s t-shirts* and *men’s sweatshirts*.

103. *Articles made of denim* is a broad term which would include all items of clothing made from denim. Zabou’s evidence suggests that it has only offered men’s denim jeans. *Men’s denim jeans* are an identifiable sub-category of the broader term. Moreover, it is my view that this is how the average consumer would fairly describe these goods. This term in Zabou’s specification will be amended accordingly.

104. *Clothing, articles of clothing* and *ready-made clothing* are very broad terms which would include many other goods of which there is no evidence of Zabou providing. In my view, the goods which Zabou has provided are all examples of men’s casualwear. Whilst this remains a relatively broad term, it is an identifiable sub-category of the

broader terms. Further, the goods for which use has been shown collectively exemplify this sub-category and I am mindful that protection should not be restricted in the narrowest possible terms. To my mind, the range of goods Zabou has offered is sufficient to maintain the registration for the same. Accordingly, these terms in Zabou's specification will be amended to *men's casualwear*.

105. *Trousers* is a relatively broad term which would include all items of clothing which cover the lower body from waist to ankle. The evidence suggests that Zabou has only provided men's joggers. Whilst I accept that joggers are incorporated by this term, and I am mindful not to unduly restrict the scope of protection, it is my view that the term should be amended to *men's casual trousers*. This is an identifiable sub-category to which the goods shown in evidence belong.

106. Although Zabou has shown use of sweatshirts, I am of the view that *sweaters* are materially different, i.e. the former describes items of clothing for the upper body made from thick cotton, or cotton-mix, material, whereas the latter are items of knitwear. To my mind, there has been no use of Zabou's mark on *sweaters* and, as such, it will be removed from the specification.

107. There is no evidence that Zabou has offered *articles of outerwear*. As such, this term terms will be removed from the specification.

Conclusion

108. PWB's application to revoke Zabou's mark is partially successful. As a consequence, its class 25 specification will be amended to read:

Class 25: Men's jeans; men's t-shirts; men's sweatshirts; men's denim jeans; men's casualwear; men's casual trousers.

109. Zabou's mark will be revoked for all the other goods in classes 18 and 25 from the earliest date requested, i.e. 27 September 2019.

Zabou's opposition and invalidations

My approach

110. Whilst the effective date of revocation is before the relevant date in the opposition, being 12 November 2020, it is after the priority date claimed by all PWB's registrations, i.e. 27 August 2019. In theory, Zabou would have been entitled to rely upon its specification as it stood on that date, because a trade mark proprietor can still rely on the rights arising from the trade mark registration in relation to infringing acts committed prior to the effective date of revocation.¹⁴⁷ However, Zabou has been put to proof of use in the invalidation proceedings. Although the relevant periods in the opposition/invalidation proceedings are not the same as that considered under PWB's section 46(1)(b) claim, they significantly overlap.¹⁴⁸ I do not consider the differences in relevant periods to materially affect the overall picture. The evidence for the relevant periods under sections 6A and 47(2B) of the Act show use of Zabou's mark in connection with the same goods for which I have already found genuine use. As such, I adopt my previous findings for genuine use and fair specification.

111. Furthermore, as noted above, PWB has conceded that its marks are identical to Zabou's mark. As such, I will focus on Zabou's claims under sections 5(1) and 5(2)(a), a prerequisite of which is that the competing marks are identical. If any of the parties' goods and services are identical, Zabou will succeed under section 5(1). If the parties' goods and services are similar, the success of Zabou's claim under section 5(2)(a) will be dependent upon a global assessment as to whether there is a likelihood of confusion.

¹⁴⁷ *Cooper International Spirits LLC*, Case C-622/18

¹⁴⁸ The relevant period in the revocation proceedings was 20 July 2016 to 19 July 2021, whereas the periods which would need to be considered in the opposition and invalidation proceedings would be 13 November 2015 to 12 November 2020 and 23 September 2016 to 24 September 2021, respectively.

The law

112. The relevant parts of section 5 of the Act are as follows:

“5(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

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

(a) it is identical with an earlier trade mark and is to be registered for goods or services 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.”

113. Section 5A of the Act states:

“5A 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.”

114. Section 5 has application in invalidation proceedings because of the provisions of section 47 of the Act, the relevant parts of which read as follows.

“47(1) [...]

(2) The registration of a trade mark may be declared invalid on the ground –

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, [...]

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

[...]

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

115. The following principles relevant to an assessment under section 5(2)(a) of the Act are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other

components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

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

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

116. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, [...] 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”.

117. The relevant factors identified by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 for assessing similarity were:

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

118. 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 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”.

119. In *Oakley, Inc v OHIM*, Case T-116/06, the GC held (at paragraphs 46 to 57) that, although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

120. In *Tony Van Gulck v Wasabi Frog Ltd*, BL O/391/14, Mr Geoffrey Hobbs QC as the Appointed Person reviewed the law concerning retail services and goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of BOO! for handbags in Class 18 and shoes for women in Class 25 and use of MissBoo for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘*similar*’ to goods are not clear cut.”

121. However, on the basis of the judgments in *Sanco SA v OHIM*, Case C-411/13P and *Assembled Investments (Proprietary) Ltd v OHIM*, Case T-105/05, at paragraphs

30 to 35 of the judgment, upheld on appeal in *Waterford Wedgwood Plc v Assembled Investments (Proprietary) Ltd* Case C-398/07P, Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered 'for goods X';

iv) The GC's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

122. In *Gérard Meric v OHIM*, Case T- 133/05, the GC stated that:

"29. [...] goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark."

123. For the purposes of the comparison, PWB's goods and services can be found underlined in the annex to this decision, whereas Zabou's goods are outlined at paragraph 108 above.

PWB's application

Class 25

124. Although PWB's specification in this class begins with *clothing*, it is followed by *namely* and a list of specific goods. The word 'namely' in this context acts as an exhaustive limitation of the preceding term. As such, it is considered that PWB does not seek registration for *clothing* at large. Rather, it seeks registration for the specific goods listed thereafter in the specification.

125. *T-shirts, trousers, jeans, denim jeans, jumpers, sweat shirts* incorporate Zabou's *men's t-shirts, men's casual trousers, men's jeans, men's denim jeans, men's sweatshirts*. The goods are to be regarded as identical in accordance with *Meric*.

126. *Shirts, polo shirts, cardigans, jerseys, pants, cargo pants, stretch pants, jump suits, shorts, tops, stretch tops, tank tops, hooded sweat shirts, sweat shorts, sweat pants, warm-up suits, jogging suits, track suits, vests, fleece vests, pullovers, jackets, reversible jackets, wind-resistant jackets, shell jackets, jean jackets, turtlenecks, sweaters, rugby shirts* are all considered to be examples of casualwear. They are encompassed by Zabou's broader term *men's casualwear*. The goods are identical under the principle in *Meric*.

127. I am not convinced that *under shirts, night shirts, dress shirts, slacks, overalls, coveralls, boxer shorts, snow suits, parkas, capes, anoraks, ponchos, cloaks, sports jackets, golf and ski jackets, coats, heavy coats, over coats, blazers, suits, cloth ski bibs, swimwear, beachwear, tennis wear, surf wear, ski wear, underwear, thermal underwear, long underwear, briefs, swim and bathing trunks, socks, loungewear, robes, underclothes, pajamas, sleepwear, night gowns, leg warmers, rain slickers, rainwear* can fairly be described as casualwear. It is possible that some, such as *parkas* and *loungewear*, could be, which would lead the goods to be identical in accordance with *Meric*. However, even if none is identical to Zabou's goods, they all overlap in nature, method of use and intended purpose insofar as they are items of clothing that are worn on the body for protection against the elements. The respective

goods reach the market through the same retailers and will be located within the same section of those outlets, i.e. with other items of menswear. Consumers would also expect the respective goods to be produced by the same undertakings. There is no competition between them. Moreover, they are not complementary since they are neither important nor indispensable to the use of each other. Overall, I find that the respective goods are similar to between a medium and high degree.

128. *Smocks, culottes, tube tops, crop tops, tankinis, halter tops, play suits, blouses, skirts, dresses, shrugs, layettes, infantwear, infants sleepers, booties, baby bibs not of paper, suspenders, bras, thongs, G-strings, singlets, nighties, lingerie, hosiery, pantyhose, body stockings, knee highs, leggings, tights* overlap in nature, method of use and intended purpose with Zabou's goods insofar as they are all items of clothing. However, this overlap is less pronounced than those considered above, given that the goods now under consideration are typically for women and infants/babies, i.e. they are not menswear. The respective goods may reach the market through shared trade channels, such as larger clothing stores, though are likely to be found in discrete sections of those outlets. Nonetheless, consumers may expect the respective goods to be produced by the same undertakings. The goods are not in direct competition. Moreover, they are not complementary as the parties' goods are not important to the use of each other. Taking all of this into account, I find that the respective goods are similar to a medium degree.

129. *Caps being headwear, berets, beanies, hats, visors being headwear, headbands, wrist bands, sweat bands, headwear, ear muffs, scarves, bandanas, belts, neckwear, ties, neckerchiefs, pocket squares, ascots, gloves, mittens, footwear, shoes, sneakers, boots, sandals, flip-flops, and slippers* are all items of headwear, footwear or clothing accessories. They differ in nature with Zabou's goods, which are items of clothing. However, there is a degree of overlap in method of use to the extent that the respective goods adorn the body. Moreover, the respective goods are all worn for their decorative/aesthetic properties and, therefore, there is a degree of overlap in purpose. The respective goods share users and may reach the market through shared trade channels. They may also be located within the same sections of those outlets, and may be sold alongside items of men's casualwear. Consumers may also expect the respective goods to be produced by the same undertakings. The goods are not in

competition. Furthermore, I do not consider them to be complementary in the sense outlined in caselaw. Whilst, for example, clothing and accessories can have a sufficiently close connection to give rise to complementarity, that is typically where they are both used to create a co-ordinated look. I do not consider that to be the case here. In light of all this, I find that the respective goods are similar to a medium degree.

130. *Uniforms, scrubs not for medical purposes, aprons* overlap in nature, intended purpose and method of use with Zabou's goods as both are items of clothing that are worn to cover the body. However, I consider it unlikely that the respective goods will reach the market through shared trade channels or be produced by the same undertakings. This is because uniforms, scrubs and aprons are relatively specific pieces of clothing which are not typically offered alongside items of casualwear. The respective goods are neither competitive nor complementary. Overall, I find that there is between a low and medium degree of similarity between them.

131. I understand *galoshes* to be waterproof shoes, usually made from rubber, which are worn over ordinary shoes for protection in the rain or snow. *Swim caps* are caps of material worn whilst swimming to keep hair out of the swimmer's face, prevent chlorine damage and reduce drag. These goods share a general nature, purpose and method of use with Zabou's goods, since they are all worn on the body for the purpose of keeping you warm, dry or covered. They may also share users. However, PWB's goods have very specific purposes not shared by Zabou's goods. For this reason, and in the absence of any evidence to the contrary, I consider it unlikely that the respective goods will reach the market through shared trade channels or be produced by the same undertakings. They are not competitive or complementary. In my view, the respective goods are similar, but only to a low degree.

Class 35

132. *Retail store services, wholesale store services, mail order services, on-line ordering services and on-line retail store services, and retail store services available through computer communications and interactive television, all of the aforesaid featuring leather clothing, clothing* differ in nature, method of use and intended purpose when compared with Zabou's goods. However, PWB's services feature goods

which are identical to Zabou's goods. The goods and the retail services therefore reach the market through the same channels of trade. Moreover, there is a complementary relationship between them; this is because the goods are important to the operation of the services in such a way that consumers are likely to assume that responsibility for them lies with the same undertaking. Overall, I find that there is a medium degree of similarity between the respective goods.

133. Zabou's goods are not important or indispensable to the operation of PWB's *retail store services, wholesale store services, mail order services, on-line ordering services and on-line retail store services, and retail store services available through computer communications and interactive television, all of the aforesaid featuring accessories, clothing accessories, footwear, headwear*. This is because these services do not feature goods which are identical to Zabou's goods and can operate entirely independently. As such, the respective goods and services are not complementary. However, users of the respective goods and services overlap. Furthermore, the sale of clothing is often alongside the retail of bags and the like and the respective goods and services are commonly provided by the same undertakings. Overall, I find that the respective goods and services are similar to a low degree.

134. *Promoting the goods and services of others by providing a web site at which users can link to fashion; promoting the goods and services of others by means of operating an on-line shopping mall with links to the retail web sites of others; promoting the goods and services of others through on-line ordering and cataloging of those goods and services* clearly have a different nature, intended purpose and method of use when compared with Zabou's goods. Moreover, they are unlikely to share trade channels. Even though the goods promoted or catalogued under PWB's services could be clothing of the kind in Zabou's specification, when confined to their ordinary and natural (or core) meanings,¹⁴⁹ the goods and services are likely to be provided by different entities and have different users; PWB's services will be provided by undertakings which promote third-party products and websites of others, whereas clothing will be provided by retailers and purchased by end consumers. The goods

¹⁴⁹ See the comments of Floyd J (as he then was) and Arnold LJ, respectively, in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) and *Sky v Skykick* [2020] EWHC 990 (Ch).

and services are not in competition. Moreover, even though clothing could be considered important to the promotion of clothing, as consumers would not believe the responsibility for the goods and services lies with the same undertakings, they are not complementary. Taking all this into account, I find that the respective goods and services are dissimilar.

135. *Providing an on-line showroom for the goods of others in the fields of fashion; promoting and conducting trade shows for commercial purposes in the fields of fashion; conducting an on-line trade show exhibitions for commercial purposes, in the fields of fashion* and Zabou's goods plainly have a different nature, intended purpose and method of use. They are not complementary, nor are they in competition. It is considered unlikely that they reach the market through shared trade channels. Although there is a natural connection between promoting/conducting fashion related trade shows and providing fashion showrooms on one hand and clothing on the other, the goods and services are likely to have different users, i.e. the users of the trade shows and showrooms are likely to third party providers of clothing, rather than the clothing providers' customers. Moreover, I am of the view that undertakings that provide clothing are not typically those that provide showrooms or promote/conduct trade shows, even in the fashion industry. I can see no overlaps leading to any meaningful similarity between them. On this basis, I conclude that the respective goods are dissimilar.

PWB's first and third registrations

136. Given that these marks are registered for the same list of class 25 goods as PWB's application, my findings at paragraphs 124 to 131 are equally applicable here.

PWB's second registration

137. *Retail store services, wholesale store services, mail order services, on-line ordering services and on-line retail store services, and retail store services available through computer communications and interactive television, all of the aforesaid featuring clothing* and Zabou's goods differ in nature, method of use and intended purpose. However, PWB's services feature all forms of clothing, including Zabou's

goods. As such, Zabou's goods are integral to PWB's services and the connection between them is such that consumers would assume that responsibility for them lies with the same undertaking. Accordingly, the respective goods and services are complementary. Moreover, the respective goods and services are distributed through the same channels of trade; clothing and the retailing of clothing are commonly offered together by the same undertaking. In light of this, I am of the view that the respective goods and services are similar to a medium degree.

138. I have already found that *promoting and conducting trade shows for commercial purposes in the fields of fashion* is dissimilar to Zabou's goods. This finding is equally applicable for this registration.

PWB's fourth registration

139. *Retail store services, wholesale store services, mail order services, on-line ordering services and on-line retail store services, and retail store services available through computer communications and interactive television, all of the aforesaid in relation to clothing, denim jeans, hooded sweatshirts, jeans, jogging suits, sweat pants, sweat shirts, sweaters, tops, tracksuits, t-shirts, warm-up suits* differ in nature, method of use and intended purposes. Nonetheless, PWB's services feature goods which are identical to Zabou's goods. The latter are important or indispensable to the operation of the former in such a way that consumers are likely to assume that responsibility for them lies with the same undertaking. They are, therefore, complementary. In addition, the goods and services reach the market through the same channels of trade. Taking all this into account, I find that there is a medium degree of similarity between them.

140. Again, *retail store services, wholesale store services, mail order services, on-line ordering services and on-line retail store services, and retail store services available through computer communications and interactive television, all of the aforesaid in relation to beachwear* differ in nature, method of use and intended purpose with Zabou's goods. Moreover, I do not consider Zabou's goods to be identical to those which feature in PWB's services and, as such, the respective goods and services are not important to one another or, as a result, complementary. However, the respective

goods and services may reach the market through shared trade channels; for example, it is not uncommon for retail outlets which offer beachwear to also offer men's casualwear. On this basis, I find that there is between a low and medium degree of similarity between them.

141. I have already found that *promoting and conducting trade shows for commercial purposes in the fields of fashion* is dissimilar to Zabou's goods. This finding is equally applicable for this registration.

142. As a result of my findings above, Zabou's opposition/applications under section 5(1) of the Act succeeds against the goods that I have found to be identical, namely:

PWB's application

Class 25: Clothing, namely, t-shirts, trousers, jeans, denim jeans, jumpers, sweat shirts, sweaters, shirts, polo shirts, cardigans, jerseys, pants, cargo pants, stretch pants, jump suits, shorts, tops, stretch tops, tank tops, hooded sweat shirts, sweat shorts, sweat pants, warm-up suits, jogging suits, track suits, vests, fleece vests, pullovers, jackets, reversible jackets, wind-resistant jackets, shell jackets, jean jackets, turtlenecks, rugby shirts.

PWB's first and third registrations

Class 25: Clothing, namely, t-shirts, trousers, jeans, denim jeans, jumpers, sweat shirts, sweaters, shirts, polo shirts, cardigans, jerseys, pants, cargo pants, stretch pants, jump suits, shorts, tops, stretch tops, tank tops, hooded sweat shirts, sweat shorts, sweat pants, warm-up suits, jogging suits, track suits, vests, fleece vests, pullovers, jackets, reversible jackets, wind-resistant jackets, shell jackets, jean jackets, turtlenecks, rugby shirts.

143. For goods and services which I have found to be only similar, Zabou's opposition/applications cannot succeed under section 5(1). However, they may proceed for those goods and services under section 5(2)(a).

144. For those goods and services that I have found to be dissimilar, Zabou's opposition/applications plainly cannot succeed under 5(1). Moreover, there is no likelihood of confusion to be considered under section 5(2)(a); some degree of similarity between goods and/or services is necessary to engage the test for likelihood of confusion.¹⁵⁰ My findings above mean that Zabou's opposition/applications must fail against the services that I have found to be dissimilar, namely:

PWB's application

Class 35: Promoting the goods and services of others by providing a web site at which users can link to fashion; promoting the goods and services of others by means of operating an on-line shopping mall with links to the retail web sites of others; promoting the goods and services of others through on-line ordering and cataloging of those goods and services; providing an on-line showroom for the goods of others in the fields of fashion; promoting and conducting trade shows for commercial purposes in the fields of fashion; conducting an on-line trade show exhibitions for commercial purposes, in the fields of fashion.

PWB's second registration

Class 35: Promoting and conducting trade shows for commercial purposes in the fields of fashion.

PWB's fourth registration

Class 35: Promoting and conducting trade shows for commercial purposes in the fields of fashion.

The average consumer and the nature of the purchasing act

145. The average consumer is deemed to be reasonably well informed, observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne

¹⁵⁰ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, paragraph 49

in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question.¹⁵¹

146. 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 described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

147. In *New Look Limited v OHIM*,¹⁵² the GC stated that:

“50. [...] 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.”

148. In line with my approach to the comparison of the parties' goods and services, my assessment below will focus on the average consumer of those for which I have found at least some similarity.

¹⁵¹ *Lloyd Schuhfabrik Meyer*, Case C-342/97

¹⁵² Joined cases T-117/03 to T-119/03 and T-171/03

149. The majority of the goods and services at issue in these proceedings will be purchased by the general public. However, some of the services, such as *wholesale store services* are likely to be purchased by businesses.

150. The general public will purchase the goods relatively frequently for the purposes of, for example, clothing one's self or as a form of self-expression. The cost of the goods may vary, with cheaper items at one end of the spectrum and more expensive fashion pieces at the other. However, the purchasing act will not require an overly considered thought process as, overall, they are relatively inexpensive purchases. The general public will, nevertheless, consider factors such as the style, quality, size and compatibility with other items. Taking the above factors into account, I find that the level of attention of the general public in respect of the goods would be medium. The goods are typically sold in physical retail establishments and their online equivalents, where the goods are likely to be self-selected from rails and shelves or after viewing information on the internet. In these circumstances, visual considerations will dominate. However, I do not discount aural considerations in the form of word-of-mouth recommendations or receiving advice from a sales assistant.

151. The general public will also purchase the services relatively frequently and their cost will vary. Again, the purchasing act will not require an overly considered thought process. However, the general public will consider factors such as the quality of service and the range of goods offered. As such, the average consumer is likely to exhibit a medium level of attentiveness. The services will be purchased from retail outlets and their online equivalents. The purchasing process for the services is likely to be dominated by visual considerations, as the general public will select the services following an inspection of the premises' frontage on the high street, after viewing information on websites, or viewing advertisements (such as flyers, posters, media campaigns or online adverts). Nevertheless, given that word-of-mouth recommendations may also play a part, I do not discount that there will be an aural component to the selection of the services.

152. Businesses are likely to purchase *wholesale store services* frequently for the purposes of, for example, stocking their own clothing stores. The cost of the services may vary, and orders may be placed in bulk. The selection process will not be merely

casual, with consideration given to stock levels, potential customer reach and service levels. These consumers will also be alive to the potentially negative consequences for their business of selecting the wrong wholesaler. For these reasons, I find that these consumers will demonstrate between a medium and high level of attention during the purchasing process. Business users are likely to select the services following an inspection of the marks on premises or in written materials, whether in print or online. Whilst I accept that there may be an aural component to the process (such as, for example, word-of-mouth recommendations or discussions with the service provider), it is my view that the purchasing process will be predominantly visual in nature.

Distinctive character of Zabou's mark

153. In *Lloyd Schuhfabrik Meyer*, 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 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

154. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods or services, to those with high inherent distinctive character, such as invented words. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion.

155. Zabou's mark is in word-only format and consists of the words 'HUMAN RACE' with no other elements. The words combine to form a well-known dictionary defined term meaning all the people in the world.¹⁵³ Although the mark has no descriptive or allusive qualities in relation to the goods for which it is registered, it is not a particularly unusual expression. Overall, I find that Zabou's mark possesses a medium level of inherent distinctive character.

156. Although the distinctiveness of a mark may be enhanced as a result of it having been used in the market, I will proceed on the basis that Zabou's mark did not have an enhanced distinctive character at the relevant date, returning to consider the matter if it becomes necessary to do so.

Likelihood of confusion

157. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. One such factor is the interdependency principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services, and vice versa. As mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be mindful that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

¹⁵³ <https://dictionary.cambridge.org/dictionary/english/human-race>

158. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related.

159. Earlier in this decision, having noted PWB's concession that its marks are identical to Zabou's mark, I concluded that:

- Similarity between PWB's goods and services and Zabou's goods ranges from a low degree to between a medium and high degree;
- Relevant consumers of the goods and services at issue are likely to include the general public and business users;
- The general public will demonstrate a medium level of attention during the purchasing process, whereas business users will demonstrate between a medium and high level of attention;
- The purchasing process will be predominantly visual in nature, though aural considerations have not been discounted;
- Zabou's mark possesses a medium level of inherent distinctive character.

160. In consideration of all the above factors, I find that there is a likelihood of direct confusion. Given that the competing marks are identical and Zabou's mark has a medium level of distinctiveness, I am satisfied that consumers will mistake one mark for the other. I should add that this finding extends to consumers that exhibit a higher level of attentiveness and to goods and services that are only similar to a low degree. Taking into account the interdependency principle, it is my view that the identity between the competing marks and the distinctiveness of Zabou's mark are sufficient to counteract these factors.

Conclusion

161. Zabou's claims under sections 5(1) and 5(2)(a) are partially successful.

Overall outcomes

162. PWB's application against Zabou's mark under sections 46(1)(a) and 46(1)(b) has been successful in part. As a consequence, the application will be amended to read:

Class 25: Men's jeans; men's t-shirts; men's sweatshirts; men's denim jeans; men's casualwear; men's casual trousers.

163. The remaining goods in classes 18 and 25 will be revoked from the earliest date requested, that being 27 September 2019.

164. Zabou's opposition/applications under sections 5(1) and 5(2)(a) have been partially successful. Subject to any appeal against my decision, PWB's application and registrations will be refused and declared invalid, respectively, in relation to the following goods and services:

PWB's application

Class 25: Clothing, namely, shirts, T-shirts, under shirts, night shirts, rugby shirts, polo shirts, cardigans, jerseys, uniforms, scrubs not for medical purposes, smocks, dress shirts, pants, trousers, slacks, jeans, culottes, cargo pants, stretch pants, denim jeans, overalls, coveralls, jumpers, jump suits, shorts, boxer shorts, tops, stretch tops, tube tops, crop tops, tank tops, tankinis, halter tops, sweat shirts, hooded sweat shirts, sweat shorts, sweat pants, wraps, warm-up suits, jogging suits, track suits, play suits, blouses, skirts, dresses, sweaters, vests, fleece vests, pullovers, snow suits, parkas, capes, anoraks, ponchos, cloaks, shrugs, jackets, reversible jackets, wind-resistant jackets, shell jackets, sports jackets, golf and ski jackets, jean jackets, coats,

heavy coats, over coats, blazers, suits, turtlenecks, cloth ski bibs, swimwear, beachwear, tennis wear, surf wear, ski wear, layettes, infantwear, infants sleepers, booties, baby bibs not of paper, caps being headwear, swim caps, berets, beanies, hats, visors being headwear, headbands, wrist bands, sweat bands, headwear, ear muffs, aprons, scarves, bandanas, belts, suspenders, neckwear, ties, neckerchiefs, pocket squares, ascots, underwear, thermal underwear, long underwear, briefs, swim and bathing trunks, bras, thongs, G-strings, singlets, socks, loungewear, robes, underclothes, pajamas, sleepwear, night gowns, nighties, lingerie, leg warmers, hosiery, pantyhose, body stockings, knee highs, leggings, tights, gloves, mittens, rain slickers, rainwear, footwear, shoes, sneakers, boots, galoshes, sandals, flip-flops, and slippers.

Class 35: Retail store services, wholesale store services, mail order services, on-line ordering services and on-line retail store services, and retail store services available through computer communications and interactive television, all of the aforesaid featuring leather clothing, accessories, clothing and accessories therefor, footwear, headwear.

PWB's first and third registrations

Class 25: Clothing, namely, shirts, T-shirts, under shirts, night shirts, rugby shirts, polo shirts, cardigans, jerseys, uniforms, scrubs not for medical purposes, smocks, dress shirts, pants, trousers, slacks, jeans, culottes, cargo pants, stretch pants, denim jeans, overalls, coveralls, jumpers, jump suits, shorts, boxer shorts, tops, stretch tops, tube tops, crop tops, tank tops, tankinis, halter tops, sweat shirts, hooded sweat shirts, sweat shorts, sweat pants, wraps, warm-up suits, jogging suits, track suits, play suits, blouses, skirts, dresses, sweaters, vests, fleece vests, pullovers, snow suits, parkas, capes, anoraks, ponchos, cloaks, shrugs, jackets, reversible jackets, wind-resistant jackets, shell jackets, sports jackets, golf and ski jackets, jean jackets, coats, heavy coats, over coats, blazers, suits, turtlenecks, cloth ski bibs, swimwear, beachwear, tennis wear, surf wear, ski wear, layettes, infantwear, infants sleepers, booties, baby bibs not of paper, caps being headwear, swim caps, berets, beanies, hats, visors being headwear, headbands, wrist bands, sweat

bands, headwear, ear muffs, aprons, scarves, bandanas, belts, suspenders, neckwear, ties, neckerchiefs, pocket squares, ascots, underwear, thermal underwear, long underwear, briefs, swim and bathing trunks, bras, thongs, G-strings, singlets, socks, loungewear, robes, underclothes, pajamas, sleepwear, night gowns, nighties, lingerie, leg warmers, hosiery, pantyhose, body stockings, knee highs, leggings, tights, gloves, mittens, rain slickers, rainwear, footwear, shoes, sneakers, boots, galoshes, sandals, flip-flops, and slippers.

PWB's second registration

Class 35: Retail store services, wholesale store services, mail order services, on-line ordering services and on-line retail store services, and retail store services available through computer communications and interactive television, all of the aforesaid featuring clothing.

PWB's fourth registration

Class 35: Retail store services, wholesale store services, mail order services, on-line ordering services and on-line retail store services, and retail store services available through computer communications and interactive television, all of the aforesaid in relation to beachwear, clothing, denim jeans, hooded sweatshirts, jeans, jogging suits, sweat pants, sweat shirts, sweaters, tops, tracksuits, T-shirts, warm-up suits.

165. As a result of the above, PWB's first and third registrations are deemed to have never been made, in accordance with section 47(6) of the Act.

166. PWB's application and registrations will proceed to registration and remain registered, respectively, for the following goods and services, which were not subject to Zabou's claims or against which the claims have failed:

PWB's application

Class 3: Eye creams, facial cleansers, toners, facial exfoliants and scrubs, facial creams, facial moisturizers, and facial lotions; non-medicated facial treatments, namely, non-medicated facial emulsions, non-medicated facial masks, non-medicated acne treatment preparations, and non-medicated ointments for the prevention and treatment of sunburn; beauty milks, skin moisturizers and skin moisturizer masks, skin conditioners, hand creams, body and hand lotions; body exfoliants, body masks, body mask creams and lotions, shaving preparations, after shave lotions, shaving balm, shaving cream, shaving gel, skin abrasive preparations, non-medicated skin creams and skin lotions for relieving razor burns, non-medicated lip care preparations, lip cream, sunscreen preparations, non-medicated topical skin creams, gels, toners, lotions, sprays and powders, all for cosmetic use; makeup removers, massage oils, essential oils for personal use, body fragrances, fragrances for personal use, body gels, namely, shower gels, sun tan gels, bath gels, beauty gels and shower gels. body oils, body powders, perfume, perfume oils, cologne, eau de toilette, eau de perfume, eau de cologne and toilette water; hair care products, namely, shampoos, conditioners, mousse, gels, incense; room fragrances; fragrance emitting wicks for room fragrances; scented linen sprays and scented room sprays; scented oils used to produce aromas when heated.

Class 5: Vitamins; vitamin supplements; nutritional supplement in the nature of a protein-based, nutrient-dense snack bars; food supplements for medical purposes, namely, mineral and vitamin supplements; dietary and nutritional supplements; vitamins; nutritional supplement energy bars; nutritional supplement meal replacement bars for boosting energy.

Class 16: Magazines, journals, newsletters, booklets, all of the aforesaid featuring sports, fitness, physical education, meditation, health, nutrition and lifestyles; posters; calendars; stickers; non-magnetically encoded gift cards; paper gift cards; occasion and note cards; postcards; stationery; paper; note pads; note books; passport cases, covers and holders; desk top and personal organizers; organizers for stationery use; pen and pencil holders, namely, pen

and pencil cups; pens; pencils; photographic and art mounts; photographs; picture books.

Class 18: All-purpose sports and athletic bags; carry-on, duffel, gym, leather shopping, shoulder, tote and travel bags; fanny packs and waist packs; backpacks; knapsacks; purses; garment bags for travel; satchels; cosmetic cases and bags sold empty; toiletry and vanity cases sold empty; calling and credit card cases; key cases; leather key chains; wallets; accessories for all the abovementioned goods.

Class 27: Personal exercise mats.

Class 28: Sporting equipment, namely, soccer balls, basket balls, handballs, volleyballs, tennis balls, tennis racquets, footballs, baseballs, baseball bats, baseball gloves, skateboards, sports balls, exercise equipment and related accessories, in the nature of treadmills, stationary cycles, stair stepping machines, resistance machines, rowing machines, manually-operated exercise equipment, pulleys, weight cuffs, weights, wrist weights, weight lifting and work-out gloves, barbell pads, medicine balls, gymnastic apparatus, punching bags, punching balls and jump ropes; bags specially adapted for carrying sports equipment and sports balls.

Class 32: Energy drinks; sports drinks; isotonic drinks in the nature of hypertonic and hypotonic drinks for use by athletes; drinking water, bottled water, mineral water, spring water, sparkling water, carbonated water, seltzer water, soda water, tonic water, and flavored waters; fruit beverages and fruit juices; sweet cider; vegetable juices; herbal juices; non-alcoholic aperitifs and non-alcoholic beer; non-alcoholic cocktail mixes; non-alcoholic cocktails; preparations for making beverages, namely, fruit drinks, non-alcoholic beverages with tea flavor; non-alcoholic fruit extracts used in the preparation of beverages; non-alcoholic malt beverages.

Class 35: Retail store services, wholesale store services, mail order services, on-line ordering services and on-line retail store services, and retail store

services available through computer communications and interactive television, all of the aforesaid featuring eye creams, facial cleansers, toners, facial exfoliants and scrubs, facial creams, facial moisturizers, and facial lotions, non-medicated facial treatments, namely, non-medicated facial emulsions, non-medicated facial masks, non-medicated acne treatment preparations, and non-medicated ointments for the prevention and treatment of sunburn, beauty milks, skin moisturizers and skin moisturizer masks, skin conditioners, hand creams, body and hand lotions, body exfoliants, body masks, body mask creams and lotions, shaving preparations, after shave lotions, shaving balm, shaving cream, shaving gel, skin abrasive preparations, non-medicated skin creams and skin lotions for relieving razor burns, non-medicated lip care preparations, lip cream, sunscreen preparations, non-medicated topical skin creams, gels, toners, lotions, sprays and powders, all for cosmetic use, makeup removers, massage oils, essential oils for personal use, body fragrances, fragrances for personal use, body gels, namely, shower gels, sun tan gels, bath gels, beauty gels and shower gels, body oils, body powders, perfume, perfume oils, cologne, eau de toilette, eau de perfume, eau de cologne and toilette water, leather key chains, leather cases, bags, personal exercise mats, sporting goods and equipment and accessories therefor in the nature of treadmills, stationary cycles, stair stepping machines, resistance machines, rowing machines, manually-operated exercise equipment, pulleys, weight cuffs, weights, wrist weights, weight lifting and work-out gloves, barbell pads, medicine balls, gymnastic apparatus, punching bags, punching balls and jump ropes; promoting the goods and services of others through issuance of product and/or service endorsements, and through appearances for product and/or service advertising; providing a web site which features advertisements for the goods and services of others on a global computer network; providing space at a web site for the advertisement of the goods and services of others; promoting the goods and services of others by providing hypertext links to the web sites of others; promoting the goods and services of others by providing a web site at which users can link to sports, music, entertainment, television, film, fashion, beauty, lifestyles, and the arts; providing pricing information about the goods and services of others via the global computer network; promoting the goods and services of others by means of operating an on-line shopping mall with links to the retail web sites of others;

promoting the goods and services of others through on-line ordering and cataloging of those goods and services; providing an on-line showroom for the goods of others in the fields of sports, music, entertainment, television, film, fashion, beauty, lifestyles, home furnishings, games, and the arts; promoting the goods and services of others by preparing and placing advertisements in an electronic magazine accessed through a global computer network; promoting and conducting trade shows for commercial purposes in the fields of sports, music, entertainment, television, film, fashion, beauty, lifestyles, home furnishings, games, and the arts; conducting an on-line trade show exhibitions for commercial purposes, in the fields of sports, music, entertainment, television, film, fashion, beauty, lifestyles, home furnishings, games, and the arts.

Class 41: Educational services, namely, providing classes, seminars or workshops in the fields of sports, fitness, physical education, meditation, health, nutrition, lifestyles, self-esteem issues; educational services namely, the provision of information about entertainment and sports provided via a website; entertainment in the nature of on-going television, cable television and radio programs featuring sports, fitness, physical education, meditation, health, nutrition and lifestyles; charitable services in the nature of providing educational classes, workshops, tutoring and mentoring for students in the fields of sports, fitness, physical education, meditation, health, nutrition, self esteem issues, discipline and conflict resolution and distributing course materials in connection therewith; charitable services in the nature of providing tutorial sessions for students in the fields of sports, fitness, physical education, meditation, health, nutrition, self esteem issues, discipline and conflict resolution and distributing course materials in connection therewith; educational and entertainment services, namely, providing motivational and educational speakers for students; educational information in the field of sports, fitness, physical education, and sports meditation all provided via a website; online sports and meditation training and training and meditation advice and the recording of training and workouts all provided via a website; on-going television and cable television programs featuring sports, fitness, physical education, meditation, health, nutrition and lifestyles; entertainment, namely, a continuing sports, fitness,

physical education, meditation, health, nutrition and lifestyles related show broadcast over television, satellite, the internet, audio and video media; charitable services, namely, providing sporting goods to needy and underprivileged children and students; rental of indoor recreational facilities for playing sports, sports training, and group recreation events.

Class 43: Hotel services; hotel services for preferred customers; hotels; resort hotel services; providing information via website in the fields of hotels and temporary accommodations for travelers and news and commentary relating to the hospitality industry.

PWB's second registration

Class 35: Promoting and conducting trade shows for commercial purposes in the fields of fashion.

PWB's fourth registration

Class 35: Promoting and conducting trade shows for commercial purposes in the fields of fashion.

Costs

167. Both parties have succeeded in part. However, Zabou successfully defended its registration, albeit that its mark has remained registered for a significantly reduced list of goods in class 25. Moreover, Zabou has been successful in at least partially opposing/invalidating five of PWB's applications/registrations. In light of this, I consider that Zabou has enjoyed a greater measure of success overall.

168. In such circumstances, Mr Bartlett argued at the hearing that there should be no costs order. In his view, this was because a) PWB's interim applications were "far from unarguable" and were "fulsomely contested", b) Zabou conceded PWB's request for cross-examination after I refused it, c) Zabou maintained its defence of *headgear* and *beach clothes* until a late stage in the proceedings, d) Zabou maintained its opposition

to PWB's class 18 goods until withdrawing it at a late stage in the proceedings, and e) Zabou filed additional evidence shortly before the main hearing. However, I do not consider them, either individually or in combination, to form a reasonable basis to award no costs at all.

169. Firstly, notwithstanding Mr Bartlett's views regarding PWB's interim applications, Zabou was still required to attend the resulting CMCs and PWB was, ultimately, unsuccessful on those matters. Zabou would have certainly incurred costs associated with the same. Whether Zabou wished to concede PWB's cross-examination request after I had issued my decision on the matter does not change that.

170. Secondly, whilst the timing of Zabou withdrawing its opposition to certain goods and conceding non-use in respect of others was perhaps not desirable, I do not consider it to be demonstrative of an abuse of process or otherwise unreasonable behaviour. In this connection, it is also relevant that these matters are unlikely to have produced a significant amount of additional work for PWB or its representatives prior to the point at which they were withdrawn/conceded.

171. Finally, I acknowledge that Zabou filed additional evidence shortly before the main hearing was due to take place on 3 July 2023. However, PWB did the same. Therefore, whilst this was far from ideal, neither party was disadvantaged, and both generated a roughly equal amount of additional work. It is also relevant that PWB filed a request to cross-examine Zabou's witnesses a relatively short time before the hearing was originally due to take place. It also filed without prejudice correspondence the evening before the CMC to determine that issue, resulting in delays and an additional CMC being required thereafter. In this regard, whilst these proceedings did become somewhat drawn-out and unnecessarily complex, it would not be fair or proportionate to hold Zabou solely accountable.

172. In my view, Zabou is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016, though I will make an appropriate reduction to reflect PWB's degree of success. In the circumstances I award Zabou the following:

Preparing statements (x5) and a counterstatement; considering PWB's statement and counterstatements (x5)	£1,800
Preparing evidence and considering PWB's evidence	£1,800
Preparing for and attending CMCs (x2) and a hearing	£1,000
Subtotal	£4,600
<i>Reduction of 30%</i>	<i>-£1,380</i>
Official fees ¹⁵⁴	£900
Total	£4,120

173. I order PW Branding, Inc. to pay Zabou Group Limited the sum of **£4,120**. 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 the proceedings if any appeal against this decision is unsuccessful.

Dated this 22nd day of November 2023

James Hopkins
For the Registrar

¹⁵⁴ The official fees paid in connection with filing a Form TM7 and four Form TM26(I)s are not subject to a reduction.

Annex

Goods and services of application no. 3555180 (PWB's application)

Class 3: Eye creams, facial cleansers, toners, facial exfoliants and scrubs, facial creams, facial moisturizers, and facial lotions; non-medicated facial treatments, namely, non-medicated facial emulsions, non-medicated facial masks, non-medicated acne treatment preparations, and non-medicated ointments for the prevention and treatment of sunburn; beauty milks, skin moisturizers and skin moisturizer masks, skin conditioners, hand creams, body and hand lotions; body exfoliants, body masks, body mask creams and lotions, shaving preparations, after shave lotions, shaving balm, shaving cream, shaving gel, skin abrasive preparations, non-medicated skin creams and skin lotions for relieving razor burns, non-medicated lip care preparations, lip cream, sunscreen preparations, non-medicated topical skin creams, gels, toners, lotions, sprays and powders, all for cosmetic use; makeup removers, massage oils, essential oils for personal use, body fragrances, fragrances for personal use, body gels, namely, shower gels, sun tan gels, bath gels, beauty gels and shower gels. body oils, body powders, perfume, perfume oils, cologne, eau de toilette, eau de perfume, eau de cologne and toilette water; hair care products, namely, shampoos, conditioners, mousse, gels, incense; room fragrances; fragrance emitting wicks for room fragrances; scented linen sprays and scented room sprays; scented oils used to produce aromas when heated.

Class 5: Vitamins; vitamin supplements; nutritional supplement in the nature of a protein-based, nutrient-dense snack bars; food supplements for medical purposes, namely, mineral and vitamin supplements; dietary and nutritional supplements; vitamins; nutritional supplement energy bars; nutritional supplement meal replacement bars for boosting energy.

Class 16 Magazines, journals, newsletters, booklets, all of the aforesaid featuring sports, fitness, physical education, meditation, health, nutrition and lifestyles; posters; calendars; stickers; non-magnetically encoded gift cards; paper gift cards; occasion and note cards; postcards; stationery; paper; note pads; note books; passport cases, covers and holders; desk top and personal organizers; organizers for stationery use;

pen and pencil holders, namely, pen and pencil cups; pens; pencils; photographic and art mounts; photographs; picture books.

Class 18: All-purpose sports and athletic bags; carry-on, duffel, gym, leather shopping, shoulder, tote and travel bags; fanny packs and waist packs; backpacks; knapsacks; purses; garment bags for travel; satchels; cosmetic cases and bags sold empty; toiletry and vanity cases sold empty; calling and credit card cases; key cases; leather key chains; wallets; accessories for all the abovementioned goods.

Class 25: Clothing, namely, shirts, T-shirts, under shirts, night shirts, rugby shirts, polo shirts, cardigans, jerseys, uniforms, scrubs not for medical purposes, smocks, dress shirts, pants, trousers, slacks, jeans, culottes, cargo pants, stretch pants, denim jeans, overalls, coveralls, jumpers, jump suits, shorts, boxer shorts, tops, stretch tops, tube tops, crop tops, tank tops, tankinis, halter tops, sweat shirts, hooded sweat shirts, sweat shorts, sweat pants, wraps, warm-up suits, jogging suits, track suits, play suits, blouses, skirts, dresses, sweaters, vests, fleece vests, pullovers, snow suits, parkas, capes, anoraks, ponchos, cloaks, shrugs, jackets, reversible jackets, wind-resistant jackets, shell jackets, sports jackets, golf and ski jackets, jean jackets, coats, heavy coats, over coats, blazers, suits, turtlenecks, cloth ski bibs, swimwear, beachwear, tennis wear, surf wear, ski wear, layettes, infantwear, infants sleepers, booties, baby bibs not of paper, caps being headwear, swim caps, berets, beanies, hats, visors being headwear, headbands, wrist bands, sweat bands, headwear, ear muffs, aprons, scarves, bandanas, belts, suspenders, neckwear, ties, neckerchiefs, pocket squares, ascots, underwear, thermal underwear, long underwear, briefs, swim and bathing trunks, bras, thongs, G-strings, singlets, socks, loungewear, robes, underclothes, pajamas, sleepwear, night gowns, nighties, lingerie, leg warmers, hosiery, pantyhose, body stockings, knee highs, leggings, tights, gloves, mittens, rain slickers, rainwear, footwear, shoes, sneakers, boots, galoshes, sandals, flip-flops, and slippers.

Class 27: Personal exercise mats.

Class 28: Sporting equipment, namely, soccer balls, basket balls, handballs, volleyballs, tennis balls, tennis racquets, footballs, baseballs, baseball bats, baseball gloves, skateboards, sports balls, exercise equipment and related accessories, in the

nature of treadmills, stationary cycles, stair stepping machines, resistance machines, rowing machines, manually-operated exercise equipment, pulleys, weight cuffs, weights, wrist weights, weight lifting and work-out gloves, barbell pads, medicine balls, gymnastic apparatus, punching bags, punching balls and jump ropes; bags specially adapted for carrying sports equipment and sports balls.

Class 32: Energy drinks; sports drinks; isotonic drinks in the nature of hypertonic and hypotonic drinks for use by athletes; drinking water, bottled water, mineral water, spring water, sparkling water, carbonated water, seltzer water, soda water, tonic water, and flavored waters; fruit beverages and fruit juices; sweet cider; vegetable juices; herbal juices; non-alcoholic aperitifs and non-alcoholic beer; non-alcoholic cocktail mixes; non-alcoholic cocktails; preparations for making beverages, namely, fruit drinks, non-alcoholic beverages with tea flavor; non-alcoholic fruit extracts used in the preparation of beverages; non-alcoholic malt beverages.

Class 35: Retail store services, wholesale store services, mail order services, on-line ordering services and on-line retail store services, and retail store services available through computer communications and interactive television, all of the aforesaid featuring eye creams, facial cleansers, toners, facial exfoliants and scrubs, facial creams, facial moisturizers, and facial lotions, non-medicated facial treatments, namely, non-medicated facial emulsions, non-medicated facial masks, non-medicated acne treatment preparations, and non-medicated ointments for the prevention and treatment of sunburn, beauty milks, skin moisturizers and skin moisturizer masks, skin conditioners, hand creams, body and hand lotions, body exfoliants, body masks, body mask creams and lotions, shaving preparations, after shave lotions, shaving balm, shaving cream, shaving gel, skin abrasive preparations, non-medicated skin creams and skin lotions for relieving razor burns, non-medicated lip care preparations, lip cream, sunscreen preparations, non-medicated topical skin creams, gels, toners, lotions, sprays and powders, all for cosmetic use, makeup removers, massage oils, essential oils for personal use, body fragrances, fragrances for personal use, body gels, namely, shower gels, sun tan gels, bath gels, beauty gels and shower gels, body oils, body powders, perfume, perfume oils, cologne, eau de toilette, eau de perfume, eau de cologne and toilette water, leather key chains, leather cases, leather clothing, bags and accessories, clothing and accessories therefor, footwear, headwear,

personal exercise mats, sporting goods and equipment and accessories therefor in the nature of treadmills, stationary cycles, stair stepping machines, resistance machines, rowing machines, manually-operated exercise equipment, pulleys, weight cuffs, weights, wrist weights, weight lifting and work-out gloves, barbell pads, medicine balls, gymnastic apparatus, punching bags, punching balls and jump ropes; promoting the goods and services of others through issuance of product and/or service endorsements, and through appearances for product and/or service advertising; providing a web site which features advertisements for the goods and services of others on a global computer network; providing space at a web site for the advertisement of the goods and services of others; promoting the goods and services of others by providing hypertext links to the web sites of others; promoting the goods and services of others by providing a web site at which users can link to sports, music, entertainment, television, film, fashion, beauty, lifestyles, and the arts; providing pricing information about the goods and services of others via the global computer network; promoting the goods and services of others by means of operating an on-line shopping mall with links to the retail web sites of others; promoting the goods and services of others through on-line ordering and cataloging of those goods and services; providing an on-line showroom for the goods of others in the fields of sports, music, entertainment, television, film, fashion, beauty, lifestyles, home furnishings, games, and the arts; promoting the goods and services of others by preparing and placing advertisements in an electronic magazine accessed through a global computer network; promoting and conducting trade shows for commercial purposes in the fields of sports, music, entertainment, television, film, fashion, beauty, lifestyles, home furnishings, games, and the arts; conducting an on-line trade show exhibitions for commercial purposes, in the fields of sports, music, entertainment, television, film, fashion, beauty, lifestyles, home furnishings, games, and the arts.

Class 41: Educational services, namely, providing classes, seminars or workshops in the fields of sports, fitness, physical education, meditation, health, nutrition, lifestyles, self-esteem issues; educational services namely, the provision of information about entertainment and sports provided via a website; entertainment in the nature of on-going television, cable television and radio programs featuring sports, fitness, physical education, meditation, health, nutrition and lifestyles; charitable services in the nature of providing educational classes, workshops, tutoring and mentoring for students in

the fields of sports, fitness, physical education, meditation, health, nutrition, self esteem issues, discipline and conflict resolution and distributing course materials in connection therewith; charitable services in the nature of providing tutorial sessions for students in the fields of sports, fitness, physical education, meditation, health, nutrition, self esteem issues, discipline and conflict resolution and distributing course materials in connection therewith; educational and entertainment services, namely, providing motivational and educational speakers for students; educational information in the field of sports, fitness, physical education, and sports meditation all provided via a website; online sports and meditation training and training and meditation advice and the recording of training and workouts all provided via a website; on-going television and cable television programs featuring sports, fitness, physical education, meditation, health, nutrition and lifestyles; entertainment, namely, a continuing sports, fitness, physical education, meditation, health, nutrition and lifestyles related show broadcast over television, satellite, the internet, audio and video media; charitable services, namely, providing sporting goods to needy and underprivileged children and students; rental of indoor recreational facilities for playing sports, sports training, and group recreation events.

Class 43: Hotel services; hotel services for preferred customers; hotels; resort hotel services; providing information via website in the fields of hotels and temporary accommodations for travelers and news and commentary relating to the hospitality industry.

Goods of registration no. 3424619 (PWB's first registration)

Class 25: Clothing, namely, shirts, T-shirts, under shirts, night shirts, rugby shirts, polo shirts, cardigans, jerseys, uniforms, scrubs not for medical purposes, smocks, dress shirts, pants, trousers, slacks, jeans, culottes, cargo pants, stretch pants, denim jeans, overalls, coveralls, jumpers, jump suits, shorts, boxer shorts, tops, stretch tops, tube tops, crop tops, tank tops, tankinis, halter tops, sweat shirts, hooded sweat shirts, sweat shorts, sweat pants, wraps, warm-up suits, jogging suits, track suits, play suits, blouses, skirts, dresses, sweaters, vests, fleece vests, pullovers, snow suits, parkas, capes, anoraks, ponchos, cloaks, shrugs, jackets, reversible jackets, wind-resistant jackets, shell jackets, sports jackets, golf and ski jackets, jean jackets, coats, heavy

coats, over coats, blazers, suits, turtlenecks, cloth ski bibs, swimwear, beachwear, tennis wear, surf wear, ski wear, layettes, infantwear, infants sleepers, booties, baby bibs not of paper, caps being headwear, swim caps, berets, beanies, hats, visors being headwear, headbands, wrist bands, sweat bands, headwear, ear muffs, aprons, scarves, bandanas, belts, suspenders, neckwear, ties, neckerchiefs, pocket squares, ascots, underwear, thermal underwear, long underwear, briefs, swim and bathing trunks, bras, thongs, G-strings, singlets, socks, loungewear, robes, underclothes, pajamas, sleepwear, night gowns, nighties, lingerie, leg warmers, hosiery, pantyhose, body stockings, knee highs, leggings, tights, gloves, mittens, rain slickers, rainwear, footwear, shoes, sneakers, boots, galoshes, sandals, flip-flops, and slippers.

Services of registration no. 3424638 (PWB's second registration)

Class 35: Retail store services, wholesale store services, mail order services, on-line ordering services and on-line retail store services, and retail store services available through computer communications and interactive television, all of the aforesaid featuring clothing; promoting and conducting trade shows for commercial purposes in the fields of fashion.

Goods of registration no. 918117107 (PWB's third registration)

Class 25: Clothing, namely, shirts, T-shirts, under shirts, night shirts, rugby shirts, polo shirts, cardigans, jerseys, uniforms, scrubs not for medical purposes, smocks, dress shirts, pants, trousers, slacks, jeans, culottes, cargo pants, stretch pants, denim jeans, overalls, coveralls, jumpers, jump suits, shorts, boxer shorts, tops, stretch tops, tube tops, crop tops, tank tops, tankinis, halter tops, sweat shirts, hooded sweat shirts, sweat shorts, sweat pants, wraps, warm-up suits, jogging suits, track suits; clothing, namely, play suits, blouses, skirts, dresses, sweaters, vests, fleece vests, pullovers, snow suits, parkas, capes, anoraks, ponchos, cloaks, shrugs, jackets, reversible jackets, wind-resistant jackets, shell jackets, sports jackets, golf and ski jackets, jean jackets, coats, heavy coats, over coats, blazers, suits, turtlenecks, cloth ski bibs, swimwear, beachwear, tennis wear, surf wear, ski wear, layettes, infantwear, infants sleepers, booties, baby bibs not of paper; clothing, namely, caps being headwear, swim caps, berets, beanies, hats, visors being headwear, headbands, wrist bands,

sweat bands, headwear, ear muffs, aprons, scarves, bandanas, belts, suspenders, neckwear, ties, neckerchiefs, pocket squares, ascots, underwear, thermal underwear, long underwear; clothing, namely, briefs, swim and bathing trunks, bras, thongs, G-strings, singlets, socks, loungewear, robes, underclothes, pajamas, sleepwear, night gowns, nighties, lingerie, leg warmers, hosiery, pantyhose, body stockings, knee highs, leggings, tights, gloves, mittens, rain slickers, rainwear, footwear, shoes, sneakers, boots, galoshes, sandals, flip-flops, and slippers.

Services of registration no. 918117118 (PWB's fourth registration)

Class 35: Retail store services, wholesale store services, mail order services, on-line ordering services and on-line retail store services, and retail store services available through computer communications and interactive television, all of the aforesaid in relation to beachwear, clothing, denim jeans, hooded sweatshirts, jeans, jogging suits, sweat pants, sweat shirts, sweaters, tops, tracksuits, T-shirts, warm-up suits; promoting and conducting trade shows for commercial purposes in the fields of fashion.

Goods of registration no. 3059824 (Zabou's mark)

Class 18: Leather and imitations of leather; trunks and travelling bags; bags; umbrellas; parasols; boot bags; holdalls; wallets; purses; credit card holders; dog leads and chokers; shooting sticks and walking sticks; pouches, backpacks, satchels; briefcases; rucksacks; suitcases; school bags; hand bags; travelling bags; leather straps; leather shoulder belts; key cases; travelling sets (leatherware); jewellery rolls; attaché cases; bum bags, sports bags, leather envelopes and pouches, valises, boxes of leather and leather board, vanity cases, credit card cases of leather, animal skins; hides; leather shoulder belts; cases, namely, leather cases, make up cases, overnight cases, travelling cases, beauty cases, attaché cases and portfolio cases; garment bags for travel; handbag frames; leather handles for bags; hat boxes; shoulder belts, straps and thongs made from leather or from imitations of leather; leather leads and leashes; luggage; non fitted cosmetic bags and cases; non fitted wash bags, purses of precious metal.

Class 25: Clothing; footwear; headgear; articles of clothing and headwear; belts (clothing); articles of outerwear; underwear; lingerie; coats; clothing of leather and of imitations of leather; articles made of denim; jeans; jackets; trousers; skirts; shirts; smocks; dresses; suits; articles of knitwear; T-shirts; sweaters; sweatshirts; beach clothes; bathing suits and bathing trunks; dressing gowns and bath robes; clothes for babies; costumes; earmuffs; stoles; gloves; headbands; hosiery; leggings; ties; pyjamas; ready-made clothing; saris; scarves and shawls; shirts; stockings; sun visors; swimsuits; tights; togas; uniforms; waistcoats; waterproof clothing; wristbands.