

O/1186/23

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NOS.

UK00003733111 AND UK00003733149

BY BBCC LIVES AND ENTERTAINMENT LIMITED

TO REGISTER:

BAD BOY CHILLER CREW

AND



BAD BOY CHILLER CREW

AS TRADE MARKS IN CLASSES

9, 25 AND 41

IN THE MATTER OF OPPOSITIONS THERETO UNDER NOS.

OP000432600 AND OP000432601

BY PLATYPUS WEAR, INC.

Background and pleadings

1. On 15 December 2021, BBCC LIVES AND ENTERTAINMENT LIMITED (“the applicant”) applied to register the trade marks shown below – Nos. UK00003733111 and UK00003733149 – and the applications were published for opposition purposes on 14 January 2022.

BAD BOY CHILLER CREW



2. The applicant’s specification for both marks is as follows:

Class 9 Music recordings; music tapes; music cassettes; musical cassettes; musical recordings; sound recordings; musical sound recordings; video recordings; musical video recordings; optical discs featuring music; prerecorded music audio tapes; prerecorded music compact discs; prerecorded music videos; prerecorded non-musical videos; downloadable digital music; downloaded music files; downloadable musical sound recordings.

Class 25 Clothing; footwear; headwear; t-shirts; hoods [clothing]; clothes; boots; sweatshirts; trainers [footwear]; shoes; jerseys [clothing]; gloves [clothing]; wristbands [clothing]; short-sleeved t-shirts; flip-flops for use as footwear; printed t-shirts; jackets [clothing]; casual shirts; belts [clothing]; sneakers [footwear]; turtleneck shirts; casual footwear; casual clothing; footwear for men and women; children's clothing; shirts; knitted clothing; shorts

[clothing]; denims [clothing]; tops [clothing]; collared shirts; hooded sweat shirts; ties [clothing]; hats; bobble hats; socks; men's socks; ankle socks; footless socks; sports socks; small hats; baseball caps and hats; beanie hats; socks for infants and toddlers; tennis socks; fashion hats; sweatpants; trousers shorts; vests; trousers; men's and women's jackets, coats, trousers, vests; jogging shoes; corduroy trousers; jogging pants; vest tops; fleece vests; waterproof trousers; sports vests; jogging outfits; jogging bottoms [clothing]; underpants; boxer shorts; boxer briefs.

Class 41 Audio entertainment services; children's entertainment services; cinematographic entertainment services; club entertainment services; conducting of entertainment activities; corporate entertainment services; entertainment services; entertainment by IP-TV; entertainment by film; entertainment club services; entertainment information; entertainment information services; entertainment provided by telephone; hospitality services (entertainment); interactive entertainment; interactive entertainment services; internet radio entertainment services; live entertainment; live entertainment production services; live entertainment services; music entertainment services; musical entertainment; musical group entertainment services; online entertainment; online entertainment services; online interactive entertainment services; online interactive entertainment; production of live entertainment; providing entertainment information; providing facilities for entertainment; radio and television entertainment; radio entertainment production; showing of prerecorded entertainment; sports entertainment services; theatre entertainment; musical festival services.

3. Platypus Wear, Inc. (“the opponent”) opposes the trade marks on the basis of section 5(2)(b) and section 5(3) of the Trade Marks Act 1994 (“the Act”).
services:
4. The oppositions are based on the earlier marks detailed below.

UK00002572396 (“the first earlier mark”), filed 28 February 2005, registered 24 February 2012.

BAD BOY

The opponent relies on all of the goods registered under the first earlier mark as follows:

Class 25 Articles of clothing; footwear; headgear.

UK00002405885 (“the second earlier mark”), filed 07 November 2005, registered 09 May 2008.

BAD BOY

The opponent relies on the following services registered under the second earlier mark:

Class 35 The bringing together, for the benefit of others, of a variety of goods being spectacles and sunglasses and cases, swimming glasses, goggles, and masks, protective glasses, protective masks, diving masks and goggles, snorkelling equipment and diving equipment, including fins, skiing and snowboarding goggles, masks and goggles, sports glasses and masks, helmets and sporting helmets, mobile telephones and telephone

accessories, mousemats, pre-recorded video, audio apparatus, pre-recorded DVDs, photographic apparatus, computer software, jewellery and imitation jewellery, precious and semi-precious metal and stones, goods of precious and semi-precious metals and stones, badges, keyrings, tie clasps and tie pins, cuff links, horological and chronometric instruments, clocks, watches and watch straps, trophies, paper, cardboard and goods made from paper and cardboard, printed matter, stationery, stamps, calendars, posters and postcards, artists' materials, greeting cards, playing cards, books, manuals, albums, printed publications, magazines, periodicals, journals, atlases, instructional and teaching materials, bookbinding materials, leather and imitation leather, goods made of leather and imitation leather, leather bags and cases, wallets and purses, school bags, rucksacks, travelling bags, athletic and sporting bags, umbrellas, parts and fittings for all the aforesaid goods, articles of clothing, footwear, headgear, games and playthings; toys, gymnastic and sporting articles, surfing equipment, skiing equipment, surfboards, surfboard leashes, sail boards, sail board leashes, snow boards, wake boards, skate boards, in-line skates, roller skates, ice skates, snow skis, ski boots, snow boarding boots, poles, bindings, water skis, soccer balls, soccer nets, field hockey balls, hockey pucks, hockey sticks, hockey gloves, baseballs, softballs, bats, gloves, mitts, batting gloves, handballs, tennis balls, tennis rackets, golf balls, golf clubs, golf bags, golf gloves, golf tees, basketballs, footballs, ping pong balls, bowling balls, volleyballs and volleyballs equipment, tether balls, beach balls, elbow pads, knee pads, shin guards, wrist guards, arm guards, leg guards, mouth guards, motocross gloves, mountaineering equipment, straps, hooks, rings, carabiners, and pitons to enable customers to conveniently view and purchase those goods from a printed publication, web-site, or retail outlet or through mail order.

5. The opponent filed a Form TM7 and an accompanying statement of grounds against UK00003733111 and a Form TM7 and an accompanying statement of grounds against UK00003733149. Both these forms were dated 19 April 2022.
6. The applicant filed a Form TM8 and a counterstatement defending UK00003733111 and a Form TM8 and a counterstatement defending UK00003733149, putting the opponent to proof of use in respect of its earlier marks. Both these forms were dated 27 June 2022.
7. The proceedings were consolidated on 11 July 2022.
8. The oppositions are directed against all of the applicant's goods and services.
9. In respect of its section 5(2)(b) claims, the opponent argues that the applicant's marks are similar to its marks, and that the contested goods and services are similar.
10. In respect of its section 5(3) claims, the opponent contends that, in relation to its marks, the applied for marks are similar, and by virtue of the reputations of the two earlier marks, use of the applied for marks without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier marks. That would be the case whether the goods and services covered by the applications are identical, similar or dissimilar to the goods and services relied upon under the earlier marks.
11. Neither party filed written submissions in lieu of a hearing.
12. The opponent filed evidence in relation to the use and reputation of its marks.
13. The applicant filed evidence of the development of the band Bad Boy Chiller Crew and the use of the applicant's marks.

14. The opponent is represented by CSY London, and the applicant is represented by Adam Van Straten.

Evidence

15. The opponent filed a witness statement from Robin Offner, CEO of the applicant, signed and dated 5 December 2022.
16. Along with the opponent's witness statement, there are nineteen exhibits, Exhibit RO1 to Exhibit RO19.
17. The applicant filed a witness statement from Jonathan Kirk, the manager of Bad Boy Chiller Crew and a director of the applicant, signed and dated 14 February 2023.
18. Along with the applicant's witness statement, there are twelve exhibits, Exhibit 1 to Exhibit 12.

DECISION

19. Although the UK has left the EU, section 6(3)(a) of the European (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 Trade Marks Act relied on in these proceedings are derived from an EU Directive. That is why this decision continues to make reference to the trade mark case law of EU courts.
20. Section 5(2)(b) of the Act reads as follows:

“5(2) A trade mark shall not be registered if because –

(a)...

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

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

21. Given their filing dates, the trade marks upon which the opponent relies qualify as earlier trade marks for the purposes of section 6 of the Act.

Proof of use

22. The opponent’s marks had been registered for more than five years at the filing date of the applications and therefore the proof of use provisions apply.
23. The proof of use provisions are set out in section 6A of the Act, the relevant parts of which state:

“(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if-

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes-

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

[(5) Repealed]

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

...”

24. 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.”

25. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the opponent’s marks is the five-year period ending with applicant’s filing date i.e. 16 December 2016 to 15 December 2021.

26. 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 Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

Evidence of use

27. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.¹

¹ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

28. Mr Offner says in his witness statement that the opponent's trade mark² was first used in the early 1980s. The opponent acquired the trade mark in 1991.
29. "BAD BOY BRANDS" (the name under which the opponent does business) routinely sells its products through licensees, the first UK licence having been granted "no later than January 2006". Exhibits RO1 and RO2 show the licensing agreements for the opponent's current and previous UK licensees respectively. Use with the consent of a licensor is admissible when determining whether genuine use of a mark has occurred.
30. In terms of revenue, Mr Offner states that, "The worldwide sales revenue from all our BAD BOY licensed products is in the hundreds of millions of U.S. Dollars annually."³ However, this figure is not broken down to any extent in the evidence, nor is any UK-specific revenue data provided.
31. In respect of marketing expenditure, the information supplied is similarly broad brush: "Bad Boy Brands and its licensees have expended many millions of dollars on marketing and promotional efforts. While our licensees carry out their own country specific promotional activities, Bad Boy Brands undertakes promotional activities which are coordinated for worldwide exposure. For example, my Company has coordinated and funded photo and video shoots of its sponsored athletes wearing apparel and demonstrating sports equipment which visibly bears the Trade Mark."⁴
32. Website photographs of "BAD BOY" clothing products are shown in Exhibit RO3. The photographs are of a hoody, close-fitting long-sleeved tops, sweatshirts, a jacket, T-shirts, a jiu jitsu uniform, and leggings. Mr Offner states that the photographs are from the opponent's 2022 range, but he confirms that "the manner in which the BAD BOY trade mark is shown as

² I refer to the mark in the singular in my proof of use analysis and later in my analysis of the question of reputation because the opposition is based on two identical "BAD BOY" marks, albeit they are reliant upon different goods and services for the purposes of section 5(2)(b).

³ Para 14 of Mr Offner's witness statement.

⁴ Para 15 of Mr Offner's witness statement.

being used on and in relation to our clothing products in these images is also representative of, and consistent with, how the Trade Mark was used on our corresponding products during the Relevant Period.”

33. Exhibit R04 features a mock up design of a swing tag used on the opponent’s “pro series” range of goods which is designed for professional mixed martial artists. Again, this exhibit does not date from the relevant period, the swing tag having been created in 2014, but Mr Offner states that, “The way in which the BAD BOY trade mark is used on this swing tag is representative of the way in which it has been used on other swing tags, across our product ranges, during the Relevant Period.”
34. Exhibit RO5 consists of photographic excerpts from Exhibits RO6 and RO7 seeking to highlight the use of the opponent’s mark on swing tags and on the neck and waist of clothing.
35. Exhibit RO6 consists of photographs of the opponent’s Gateshead shop which was open from 2013 “until about 2015” – prior to the relevant period. The photographs show the opponent’s mark and variants thereof on signage, leisure clothing, sports clothing, water bottles, and holdalls. Mr Offner says that the manner in which the opponent’s mark is used in these photographs, and the product range shown, is consistent with the manner of use and the product range offered during the relevant period.
36. Exhibit RO7 is the opponent’s “Fall/Winter Collection 2019” catalogue and so falls within the relevant period. However, no information is supplied as to the extent of distribution of this catalogue or whether UK consumers were exposed to it.
37. Exhibit RO8 consists of extracts from the opponent’s “BAD BOY Collection”. The collection features leggings, close-fitting long-sleeved tops, shorts, hoodies, tracksuit tops, tracksuit bottoms, T-shirts, water bottles, and towels. Mr Offner states that the collection dates from 2019 and the products shown were sold in the UK during 2019 and 2020 – within the relevant period.

38. Exhibit R09 consists of extracts from the “BADBOY Core Brochure” which has a copyright date of 2020. Mr Offner says the brochure was distributed online and in hard copy to UK retailers in 2020 and 2021. The brochure features a punching “tower”, a sweat suit, boxing shorts, martial arts shorts, T-shirts, sweatshirts, hoodies, underpants, socks, boxing gloves, martial arts gloves, a beanie hat, a face mask, and protective wear (such as head guards and shin guards).
39. Exhibit RO10 is of the “BAD BOY Brand Book”, dating from 2020, and produced by “the new European licensee”. It does not specifically refer to the UK market. It features boxing gloves, boxing shorts, protective wear, T-shirts, martial arts gloves, shorts, close-fitting long-sleeved tops, martial arts shorts, jiu jitsu uniforms, and hoodies. Described as an “advertising tool”, Mr Offner says that “we and/or our licensees have produced similar brand books during the Relevant Period.”
40. Exhibits RO11 to RO13 and a quote from Exhibit RO9 show that the opponent has won seven World MMA [mixed martial arts] Awards for “Best Gear and Technical Apparel Brand”, including in 2018 and 2019 (within the relevant period). These awards are sponsored by “Fighters Only” magazine, the website for which describes it as “the world’s biggest mixed martial arts magazine” and states that since its first issue in 2005, it has “established itself as the bible of MMA and provides monthly coverage in the form of US and UK issues.” No data is provided as to the readership of the UK issues.
41. Mr Offner states that the opponent has sponsored a wide variety of sportspeople as part of its promotional activities. This includes sponsorship of a number of Ultimate Fighting Championship (“UFC”) champions “in the past” (this sponsorship not being said to have taken place during the relevant period). UFC is described by Mr Offner as the largest MMA promotion company and the largest pay-per-view event provider in the world, “broadcasting in over 149 countries and territories (including the UK) to nearly one billion homes worldwide and in 30 different languages.”

42. Exhibit RO14 features two English MMA fighters that have been sponsored by the opponent, Luke Barnatt and Michael Page. Both fighters are described as “well-known” and I take there to be an implication that they would appeal to MMA fans in the UK.
43. Mr Barnatt’s sponsorship pre-dates the relevant period, but two posts on his Instagram account date from 2017 (liked by 351 people) and 2019 (liked by 231 people), within the relevant period. These posts include photos which show “BAD BOY” branding.
44. Mr Page’s sponsorship began in 2015 and ended “in our about 2019”, so the bulk of it took place during the relevant period. There are two undated photographs of Mr Page, one with him wearing a “BAD BOY” T-shirt and the other with him wearing a “BAD BOY” tracksuit.
45. Mr Offner also states that while licensees carry out country-specific promotional activities, they also benefit from being able to make use of the opponent’s worldwide promotional activities such as photo and video shoots of athletes wearing “BAD BOY” clothing and using “BAD BOY” sports equipment.
46. Exhibit RO15 is a 2017 video made by AVA Sports, UK distributor of MMA clothing at the time, advertising “BAD BOY” branded goods – a tracksuit top, a close-fitting long-sleeved shirt, and martial arts gloves. There is no viewership information supplied with this video.
47. Exhibit RO16 consists of a number of invoices described as being “issued by Bad Boy brands, our distributors, and/or licensees during the relevant period in the UK” to wholesale customers for onward retail sale or to individuals.
48. There are 59 invoices in total. The invoices for 2017 to 2020 are denominated in euros, totalling 13,100.81. The invoices for 2021 are denominated in pounds, totalling 12,746.04. Two of the invoices do not show a monetary value, with the remaining 57 ranging in value from 25.98 euros to

3,506.40 euros. While the majority of the invoices are denominated in euros, all of them are for delivery to UK addresses. It is not made clear which invoices are wholesale and which are retail, so I have had to use the working hypothesis that invoices that contain a single order per product are retail invoices and those which contain multiple orders per product are wholesale invoices. As such, while those that are assumed to be wholesale invoices do not constitute evidence of direct sales, they are indicative of products having been stocked with a view to their being sold in the UK.

49. The invoices feature T-shirts, boxing gloves, boxing shorts, protective wear, martial arts gloves, close-fitting long-sleeved shirts, shorts, leggings, hoodies, tracksuit bottoms, a sweatband, a lanyard, a bag, martial arts shorts, a training jacket, a tracksuit top, jiu-jitsu uniforms, “grappling” socks for martial arts, a water bottle, beanie hats, a cap, and sweatshirts.
50. Exhibit RO17 is a printout of the opponent’s Amazon.co.uk home page. This dates from 2022, with Mr Offner stating that, “To the best of my knowledge, this page is representative of the way in which the Trade Mark was used on the BAD BOY UK Amazon Sellers' home page during the Relevant Period.”
51. Exhibits RO18 and RO19 document some wholesale transactions in 2018, and therefore within the relevant period, between the opponent’s companies and its licensees responsible for selling products into the UK via Amazon. While they are not proof of sales, the transactions are evidence of products being stocked with a view to them being sold into the UK. The products listed are shorts, T-shirts, tank tops, tracksuit bottoms, hoodies, jiu jitsu uniforms, close-fitting T-shirts, close-fitting long-sleeved T-shirts, leggings, training jackets, martial arts shorts, boxing shorts, martial arts gloves, boxing gloves, protective wear, a back pack, a duffel bag, and a cap.
52. The opponent has not supplied any data as to market share.

Use of the mark at issue

53. A typical invoice offered in evidence as part of Exhibit RO16 is copied below.



Ship to:



United Kingdom



Qty	Item name	SKU	Item net	Total net
1	Bad Boy Gel Hand Wraps-Black-L/XL <i>Colour: Black Size: L/XL</i>	BADWRAPGEL1	€16.5200	€16.52
1	Bad Boy Legacy Evolve MMA Shorts-Black/Red-XL <i>Colour: Black/Red Size: X-Large</i>	BB00086BLRXL	€45.4400	€45.44
1	BAD BOY Performance Walkout 2.0 - Black/Blue - Large <i>Colour: Black/Blue Size: L</i>	BB00005BLUL	€16.5200	€16.52
1	Bad Boy Full Guard Compression Shorts & Cup-Black-L <i>Colour: Black Size: Large</i>	BB00104BLKL	€37.1800	€37.18
1	Bad Boy Groin Guard - Blue <i>Colour: Blue Size: One-Size</i>	BADGRNGDBLE	€0.0000	€0.00
1	Bad Boy Groin Guard - Red <i>Colour: Red Size: One-Size</i>	BADGRNGDRD	€0.0000	€0.00
1.0000	Shipping: Free Shipping - Free Standard Shipping		€0.0000	€0.00
			Subtotal	€115.66
			Netherlands 21% VAT @ 21%	€24.29
			Total	€139.95

54. The opponent's mark is used as the first part of the product description, either exactly as registered in block capitals, or capitalised which constitutes normal and fair use of a word mark.

55. This normal and fair use of the mark extends to when "BAD BOY" is used on articles of clothing, with the two words conjoined and the text stylised as in the example below from Exhibit RO8.

TEAM

TRACK PANTS

NEW

COLOR



Sizes

XS; S; M; L; XL; XXL

56. While there are some variants of the mark which use other text and devices alongside the words “BAD BOY”, by far the most common variant use evidenced is that of the stylised text “BAD BOY” with a “staring eyes” device. An example from Exhibit RO9 is copied below.



BEANIE HAT

BBA00003

BLACK

ONE SIZE

- Perfect fit on head keeps you warm
- Ideal for winter
- Logo embroidered cuff

57. I am conscious of *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12 where it was held that “the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark” (paragraph 32) and

that “a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1)” (paragraph 35).

58. It is my determination that the independent distinctive character of the word element “BAD BOY” in the above example is not altered by the presence of the device and that it will continue to be perceived as indicative of the origin of the products at issue. Consequently, I consider such use of the mark to be acceptable variant use.
59. To sum up, I am satisfied that the opponent’s mark is shown in use in the evidence exactly as registered, in a different casing or stylised text which still constitutes normal and fair use of a word mark, or in an acceptable variant form.

Sufficient use

60. While the opponent’s stated worldwide revenue is considerable, this is not broken down to a UK level in the evidence. However, a consistent level of UK sales and wholesale transactions are documented during the relevant period for the opponent’s sports clothing and leisure clothing. While the volume of sales and wholesale transactions could not be said to be considerable, they are of a sufficiently high level to show that a market for the opponent’s product range had been established and was maintained during the relevant period.
61. I have been told that the evidence that pre- and post-dates the relevant period is of a piece with the use of the mark and the product range exhibited during the relevant period. Having reviewed this outside-the-relevant-period evidence, I find the opponent’s claim of consistency in terms of the use of the mark and the product range to be credible.

62. In terms of marketing, the opponent has quoted a very large expenditure figure, but again this is not broken down to UK level. While I am not told how much money had been spent in promoting the opponent's brand in the UK during the relevant period, there is a modest amount of evidence of such promotion having taken place. This takes the form of catalogues, the winning of awards sponsored by a magazine that has a UK edition, a promotional video, and the sponsorship of two English MMA fighters. However, no figures were provided as to the distribution of the catalogues, the readership of the magazine and the viewership of the video. For the MMA fighter who had made two Instagram posts during the relevant period, these only attracted "likes" in the low hundreds.
63. I have looked at the evidence in the round, including that of wholesale transactions during the relevant period with a view to sale in the UK. While such transactions are not evidence of direct sales having been achieved, they are evidence of products being prepared for sale.
64. Having taken all the relevant factors into account, including the modest amount of evidence offered in relation to marketing activity, I nevertheless find that there has been real commercial exploitation of the opponent's mark on the market in accordance with its commercial *raison d'être* in relation to a range of sports clothing, leisure clothing, headgear, boxing gloves, martial arts gloves, protective wear, bags, and water bottles. I therefore consider there to be proof of genuine use of the mark for these goods in the relevant period. What I must now do is consider what constitutes a fair specification in the context of the opponent's registered terms and the evidence of genuine use supplied.

Fair specification

65. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs K.C. 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.”

66. 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."

67. In relation to the opponent's first earlier mark, the evidence does not justify the retention of "articles of clothing" at large.
68. While some of the opponent's clothing is intended for boxing or martial arts, such as boxing shorts and jiu-jitsu uniforms, there is also close-fitting sports clothing that could equally be used for running or yoga, and generic sports clothing, such as tracksuits and training jackets. As such, I consider "sports clothing" to be a fair term.
69. There is also generic leisure clothing in evidence in the form of T-shirts, sweatshirts, and hoodies. There is only one instance of socks at large and of underwear being offered for sale and no evidence of direct sales or wholesale transactions for such goods.
70. There is evidence of caps and beanie hats being offered for sale and sold or wholesaled.
71. While there is evidence of genuine use of boxing gloves, martial arts gloves, and protective wear (such as headguards and shin guards), I note that the

current edition of the Nice Classification states that such goods do not belong in Class 25:

“This Class does not include, in particular:

...

- certain clothing, footwear and headwear for special use, for example, protective helmets, including for sports (Cl. 9), ... as well as clothing and footwear that are essential for the practice of certain sports, for example, baseball gloves, boxing gloves, ice skates (Cl. 28)”.

72. Bags (Class 18) and water bottles (Class 21) are also not proper to Class 25.

73. I consider a fair specification for the opponent’s first earlier mark to be:

Class 25 Sports clothing; T-shirts, sweatshirts; hoodies; headgear.

74. The opponent’s second earlier mark relies upon Class 35 services: “The bringing together, for the benefit of others, of a variety of goods ... to enable customers to conveniently view and purchase those goods from a printed publication, web-site, or retail outlet or through mail order.”

75. While there are goods listed within the opponent’s Class 35 specification for which genuine use has been shown, there is no evidence of any means of customer purchase in respect of printed publications and the only retail outlet that the opponent has offered in evidence closed before the start of the relevant period. The only reference to a web domain in the evidence is at paragraph 19 of Mr Offner’s witness statement and in Exhibit RO3.

76. Mr Offner refers to eu.badboy.com as “one of our websites operated by our licensee” and there are some photographs dating from 2022 of “BAD BOY” clothing copied from the website. While I note that Mr Offner says that this evidence is consistent with the mark’s use on products during the relevant period, there are no screenshots provided of the website. This means that

there is no evidence that the website has a UK-targeted segment, or anything to show that consumer purchases can be effected via this website. Nor is any evidence supplied as to the website achieving any page views or purchases from UK consumers.


77. Mindful of section 100 of the Act and the onus being on the proprietor to show use, I consider the evidence too scant to be able to say that the opponent has proved genuine use of the mark in respect of bringing together any goods to enable customers to conveniently view and purchase them from a website.
78. The opponent cannot retain its Class 35 services in relation to its second earlier mark.
79. The opponent's second earlier mark has therefore fallen away in respect of the opponent's section 5(2)(b) claims.

Comparison of the trade marks

80. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

Opponent's mark	Applicant's marks
BAD BOY	BAD BOY CHILLER CREW
	

83. The opponent's mark consists of the words "BAD BOY", these words being the only things that contribute to the overall impression made by the mark.
84. The applicant's word mark consists of the words "BAD BOY CHILLER CREW", these words being the only things that contribute to the overall impression made by the mark.
85. In respect of the applicant's figurative mark, it is common ground between the parties that the device element represents the letters "BBCC". The letters are highly stylised. The word element of the mark is "BAD BOY CHILLER CREW" in slightly stylised block capitals. While the device element is larger than the words, the eye is naturally drawn to the words given that they can be read and so the two elements make a roughly equal contribution to the overall impression made by the mark.

86. Visually, the opponent's word mark consists of the words "BAD BOY", while the applicant's word mark has two additional words "CHILLER CREW". I find the respective marks to be of medium visual similarity.
87. The applicant's figurative mark has the additional words "CHILLER CREW" and a device which is not present in the opponent's mark consisting of the highly stylised letters "BBCC". I find the respective marks to be of low visual similarity.
88. Aurally (and phonetically), the opponent's mark and the applicant's word mark are pronounced and heard as "BAD BOY" and "BAD BOY CHILL-ER CROO" respectively. The first two words of the respective marks are aurally identical, but then there are two words that are pronounced that are absent from the opponent's mark. I find the respective marks to be of medium aural similarity.
89. In respect of the opponent's mark and the applicant's figurative mark, the initial letters in the device element would not be voiced by a significant proportion of average consumers, and so these marks would also be of medium aural similarity.
90. Conceptually, all the marks at issue convey the idea of a "bad boy". The applicant's marks also contain the words "chiller crew" with neither party having commented on their meaning. I consider that the average consumer would see "chiller" as a slang term, but they would not know its precise meaning. Consequently, the words "chiller crew" would impart the concept of a group of people brought together to do something unspecified. The letters "BBCC" in the applicant's figurative mark simply serve to reinforce the initial letters of the four words "BAD BOY CHILLER CREW". I find the respective marks to be of medium conceptual similarity.

Distinctive character of the earlier mark

91. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

92. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

93. The words “BAD BOY” are not invented words, nor are they suggestive of the goods upon which the opponent relies. The earlier mark is of a medium level of inherent distinctiveness.

94. I will also consider whether the opponent's mark has acquired an enhanced degree of distinctive character beyond its inherent distinctive character.
95. The mark is in use in the UK (there being documented sales and wholesale transactions in relation to the UK). While the volume of these sales and transactions could not be said to be considerable, I have found them to be of a sufficiently high level to show that a market for the opponent's product range had been established and was maintained during the relevant period. However, no UK data has been provided for the opponent's revenue or market share during the relevant period. Furthermore, the amount of evidence of the mark having been promoted in the UK during the relevant period is modest.
96. The evidence does not strike me as indicative of a level of activity that would lead to the capacity of the mark, measured from the perspective of the average consumer, to more greatly identify the goods for which they have been registered as coming from a particular undertaking, beyond its inherent capability to do so. As such, I do not find that the evidence shows use of the mark such that the level of distinctiveness can be raised above the finding that I have made for the mark's inherent distinctive character, that of a medium degree.

Comparison of the goods and services

97. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon*, Case C-39/97, the Court of Justice of the European Union ("CJEU") stated that:

"23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia,

their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

98. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

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

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

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the

way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

100. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term ‘computer software’. In the course of his judgment, he set out the following summary of the correct approach to interpreting broad and/or vague terms:

“...the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”

101. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-133/05, the General Court (“GC”) stated that:

“29. In addition, the 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 für 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.”

102. 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 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 the responsibility for those goods lies with the same undertaking.”

103. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted, as the Appointed Person, in *Sandra Amalia Mary Elliot v LRC Holdings Limited*, BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes.”

While on the other hand:

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

104. The goods and services at issue are as set out below.

Opponent's goods	Applicant's goods and services
	<p><u>Class 9</u></p> <p>Music recordings; music tapes; music cassettes; musical cassettes; musical recordings; sound recordings; musical sound recordings; video recordings; musical video recordings; optical discs featuring music; prerecorded music audio tapes; prerecorded music compact discs; prerecorded music videos; prerecorded non-musical videos; downloadable digital music; downloaded music files; downloadable musical sound recordings.</p>
<p><u>Class 25</u></p> <p>Sports clothing; T-shirts, sweatshirts; hoodies; headgear.</p>	<p><u>Class 25</u></p> <p>Clothing; footwear; headwear; t-shirts; hoods [clothing]; clothes; boots; sweatshirts; trainers [footwear]; shoes; jerseys [clothing]; gloves [clothing]; wristbands [clothing]; short-sleeved t-shirts; flip-flops for use as footwear; printed t-shirts; jackets [clothing]; casual shirts; belts [clothing]; sneakers [footwear]; turtleneck shirts; casual footwear; casual clothing; footwear for men and women; children's clothing;</p>

	<p>shirts; knitted clothing; shorts [clothing]; denims [clothing]; tops [clothing]; collared shirts; hooded sweat shirts; ties [clothing]; hats; bobble hats; socks; men's socks; ankle socks; footless socks; sports socks; small hats; baseball caps and hats; beanie hats; socks for infants and toddlers; tennis socks; fashion hats; sweatpants; trousers shorts; vests; trousers; men's and women's jackets, coats, trousers, vests; jogging shoes; corduroy trousers; jogging pants; vest tops; fleece vests; waterproof trousers; sports vests; jogging outfits; jogging bottoms [clothing]; underpants; boxer shorts; boxer briefs.</p>
	<p><u>Class 41</u> Audio entertainment services; children's entertainment services; cinematographic entertainment services; club entertainment services; conducting of entertainment activities; corporate entertainment services; entertainment services; entertainment by IP-TV; entertainment by film; entertainment club services; entertainment information; entertainment information services; entertainment provided by telephone; hospitality services (entertainment); interactive entertainment; interactive</p>

	entertainment services; internet radio entertainment services; live entertainment; live entertainment production services; live entertainment services; music entertainment services; musical entertainment; musical group entertainment services; online entertainment; online entertainment services; online interactive entertainment services; online interactive entertainment; production of live entertainment; providing entertainment information; providing facilities for entertainment; radio and television entertainment; radio entertainment production; showing of prerecorded entertainment; sports entertainment services; theatre entertainment; musical festival services.
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Class 9

105. The applicant’s Class 9 goods are different from the opponent’s goods in terms of nature, purpose, method of use and trade channels. They are not complementary, nor are they in competition. The respective goods are dissimilar.

Class 25

106. “Headwear” is identical to the opponent’s “headgear”.

107. “T-shirts” are identical to the opponent’s “T-shirts”.

108. "Sweatshirts" are identical to the opponent's "sweatshirts".
109. "Hooded sweat shirts" are identical to the opponent's "hoodies".
110. "Clothing" and "clothes" are *Merix* identical to the opponent's "sports clothing" in that the goods designated by the earlier mark are included in a more general category designated by the trade mark application.
111. "Hoods [clothing]" (which I consider to be a form of headgear), "hats", "bobble hats", "small hats", "baseball caps and hats", "beanie hats" and "fashion hats" are *Merix* identical to the opponent's "headgear" in that the goods designated by the trade mark application are included in a more general category designated by the earlier mark.
112. "Short-sleeved t-shirts" and "printed t-shirts" are *Merix* identical to the opponent's "T-shirts" in that the goods designated by the trade mark application are included in a more general category designated by the earlier mark.
113. "Sports socks", "tennis socks", "sweatpants", "jogging pants", "sports vests", "jogging outfits" and "jogging bottoms [clothing]" are *Merix* identical to the opponent's "sports clothing" in that the goods designated by the trade mark application are included in a more general category designated by the earlier mark.
114. I have found the applicant's sports socks to be *Merix* identical to the opponent's "sports clothing" and given that these goods are encompassed by the opponent's broader "socks", this latter term is also caught by that finding.
115. "Casual shirts", "casual clothing", "shirts" and "tops [clothing]" are *Merix* identical to the opponent's "T-shirts" in that the goods designated by the earlier mark are included in the more general categories designated by the trade mark application.

116. I compare “jerseys [clothing]” with the opponent’s “sweatshirts”. While jerseys are more commonly made of wool and sweatshirts are more commonly made of thick cotton, the respective goods have the same purpose and method of use. They also share trade channels and will be shelved close to each other. They are not complementary, but they would be in competition. I find the respective goods to be highly similar.
117. I compare “knitted clothing” with the opponent’s “sweatshirts”. Knitted clothing usually takes the form of e.g. jumpers and cardigans, and is made of wool, while sweatshirts are normally made of thick cotton. The respective goods have the same purpose and method of use. They also share trade channels and will be shelved close to each other. They are not complementary, but they would be in competition. I find the respective goods to be highly similar.
118. I compare “trainers [footwear]”, “sneakers [footwear]” and “jogging shoes” with the opponent’s “sports clothing”. Sports clothing is clothing for sporting activity made of cloth and is worn on all parts of the body, whereas trainers, sneakers and jogging shoes are made of more robust materials such as leather and rubber and are worn on a specific part of the body – the feet. While trainers, sneakers and jogging shoes have a sporting function, they can also be used for casual fashion purposes, but there will be an overlap of trade channels in respect of sports retailers. They are not complementary, nor are they in competition. I find these goods to be of medium similarity.
119. I have found the applicant’s trainers, sneakers and jogging shoes to be of medium similarity by comparison to the opponent’s “sports clothing” and given that these goods are encompassed by the applicant’s broader footwear terms, “footwear”, “shoes”, “casual footwear” and “footwear for men and women”, these latter terms are also caught by that finding.
120. I compare “wristbands [clothing]” with the opponent’s “sports clothing”. Sports clothing is clothing for sporting activity and is worn on all parts of the body, whereas wristbands are worn around the wrist. Wristbands can be used for sporting activity when made of towelling in which case there would be an

overlap of trade channels in respect of sports retailers, but they can also be made of other types of material and worn as a fashion item. They are not complementary, nor are they in competition. I find these goods to be of medium similarity.

121. I compare “footless socks” with the opponent’s “sports clothing”. Sports clothing is clothing for sporting activity and is worn on all parts of the body, whereas footless socks cover the lower leg. Footless socks are close-fitting and can aid sporting activity in which case there would be an overlap of trade channels in respect of sports retailers, but they can also be worn as a fashion item. They are not complementary, nor are they in competition. I find these goods to be of medium similarity.
122. I compare “turtleneck shirts” with the opponent’s “sweatshirts”. While a turtleneck shirt is generally made of a thinner material and has a different type of neckline, the respective goods have essentially the same purpose and method of use. They share trade channels and will be shelved close to each other. They are not complementary, but they would be in competition. I find the respective goods to be of medium similarity.
123. I compare “men’s socks” with the opponent’s “sports clothing”. Sports clothing is clothing for sporting activity for the general public at large and is worn on all parts of the body, whereas men’s socks are for men and cover the foot and lower leg. Men’s socks can be used for sport in which case there would be an overlap of trade channels in respect of sports retailers, but they can also be worn for day-to-day casual or formal purposes. They are not complementary, nor are they in competition. I find these goods to be of medium similarity.
124. I compare “ankle socks” with the opponent’s “sports clothing”. Sports clothing is clothing for sporting activity and is worn on all parts of the body, whereas ankle socks cover the foot. Ankle socks can be used for sport in which case there would be an overlap of trade channels in respect of sports retailers, but

they can also be worn for day-to-day purposes. They are not complementary, nor are they in competition. I find these goods to be of medium similarity.

125. I compare “vest tops” and “fleece vests” with the opponent’s “sweatshirts”. While a vest top is sleeveless, the respective goods have essentially the same purpose and method of use. They share trade channels and will be shelved close to each other. They are not complementary, but they would be in competition. I find the respective goods to be of medium similarity.
126. I compare “shorts [clothing]” and “trousers shorts” (which I take to be trousers in the form of shorts) with the opponent’s “sports clothing”. Sports clothing is clothing for sporting activity and is worn on all parts of the body, whereas shorts cover the pelvic region and the top of the legs. Shorts can be used for sport in which case there would be an overlap of trade channels in respect of sports retailers, but they can also be worn for day-to-day purposes. They are not complementary, nor are they in competition. I find these goods to be of medium similarity.
127. I compare “collared shirts” with the opponent’s “T-shirts”. Both are types of shirts, but a T-shirt is usually round-necked and is an informal garment, whereas a collared shirt can be informal (such as a polo shirt), or formal (such as a dress shirt). They share trade channels and will be shelved close to each other. They are not complementary, but they could be in competition. I find the respective goods to be of medium similarity.
128. I compare “children's clothing” with the opponent’s “T-shirts”, “sweatshirts” and “hoodies”. While children’s clothing comes in forms other than T-shirts, sweatshirts and hoodies, it includes such garments. However, while the trade channels will overlap in that department stores and clothes shops would routinely stock children’s clothing in general and T-shirts, sweatshirts and hoodies for the general public as a whole, there will generally be a specific section in such stores for children’s clothing. Adult versions of the opponent’s goods will be found elsewhere in the store. The respective goods are not complementary but there would be a certain amount of competition where the

consumer faced a choice between the children's versions of the opponent's goods and other types of children's clothing. I find the respective goods to be of medium similarity.

129. I compare "boots" and "flip-flops for use as footwear" with the opponent's "T-shirts", "sweatshirts" and "hoodies". The opponent's goods are made of cloth and worn on the top half of the body, whereas the applicant's goods are made of more robust materials such as leather or rubber and are worn on feet. As such, while they are all worn on the body, they differ as to their specific nature, purpose and method of use. There are specialist shoe shops that would not stock the opponent's goods, but the trade channels will overlap to the extent that department stores and clothes shops would routinely stock both the opponent's and the applicant's goods. The respective goods are neither complementary, nor are they in competition. I find them to be of low similarity.
130. I compare "gloves [clothing]" with the opponent's "T-shirts", "sweatshirts" and "hoodies". The opponent's goods are made of cloth and worn on the top half of the body, whereas the applicant's goods are typically made of wool or leather and are worn on the hands. As such, while they are all worn on the body, they differ as to their specific nature, purpose and method of use. The trade channels will overlap in that department stores and clothes shops would routinely stock both the opponent's and the applicant's goods, but they would not be shelved together. The respective goods are neither complementary, nor are they in competition. I find them to be of low similarity.
131. I compare "belts [clothing]" with the opponent's "T-shirts", "sweatshirts" and "hoodies". The opponent's goods are made of cloth and worn on the top half of the body, whereas the applicant's goods are typically made of leather and worn around the waist. As such, while they are all worn on the body, they differ as to their specific nature, purpose and method of use. The trade channels will overlap in that department stores and clothes shops would routinely stock both the opponent's and the applicant's goods, but they would

not be shelved together. The respective goods are neither complementary, nor are they in competition. I find them to be of low similarity.

132. I compare “socks for infants and toddlers” with the opponent’s “T-shirts”, “sweatshirts” and “hoodies”. The opponent’s goods are worn on the top half of the body and are used by the general public at large, whereas the applicant’s goods cover the foot and lower leg and are used by infants and toddlers. The respective goods are all worn on the body, but they differ as to their specific nature, purpose and method of use. The trade channels will overlap to some extent in that department stores and clothes shops would routinely stock clothing in a range of adult and child sizes, but the respective goods would be on separate shelves. They are neither complementary, nor are they in competition. I find them to be of low similarity.
133. I compare “jackets [clothing]” and “men's and women's jackets ...” with the opponent’s “sweatshirts”. While jackets are also worn on the top half of the body, they are generally of a heavier cloth and are tailored. While they share a method of use, they have different purposes in that a jacket is intended to be worn over other clothing and to be more protective of the wearer. They share trade channels but will be on separate racks/shelves. They are not complementary, nor are they in competition. I find the respective goods to be of low similarity.
134. I compare “men's and women's ... coats ...” with the opponent’s “sweatshirts”. While coats also cover the top half of the body, they usually extend to three-quarter or full length, and they are generally of a heavier cloth and are tailored. While they share a method of use, they have different purposes in that a jacket is intended to be worn over other clothing and to be more protective of the wearer. They share trade channels but will be on separate racks/shelves. They are not complementary, nor are they in competition. I find the respective goods to be of low similarity.

135. I compare “trousers”, “men's and women's ... trousers ...”, “corduroy trousers” and “waterproof trousers” with the opponent’s “sweatshirts”. Trousers cover the bottom half of the body, whereas sweatshirts cover the bottom half and so they have different purposes and slightly different methods of use. They share trade channels but will be on separate racks/shelves. They are not complementary, nor are they in competition. I find the respective goods to be of low similarity.
136. I compare “vests”, “men’s and women’s ... vests”, “underpants”, “boxer shorts” and “boxer briefs” with the opponent’s “T-shirts”. Underwear is worn under other clothing and so has a different purpose and method of use from T-shirts. The respective goods share trade channels but will be on separate shelves. They are not complementary, nor are they in competition. I find the respective goods to be of low similarity.
137. I compare “ties [clothing]” with the opponent’s “T-shirts”, “sweatshirts” and “hoodies”. The opponent’s goods are casual garments made of cloth and worn on the top half of the body, whereas the applicant’s goods are formal wear made of a fine material such as silk and worn around the neck. As such, while they are all worn on the body, they differ as to their specific nature, purpose and method of use. The trade channels will overlap in that department stores and clothes shops would routinely stock both the opponent’s and the applicant’s goods, but they would not be on the same racks/shelves. The respective goods are neither complementary, nor are they in competition. I find them to be of low similarity.
138. I compare “denims [clothing]” with the opponent’s “T-shirts”, “sweatshirts” and “hoodies”. The opponent’s goods are relatively smooth to the touch and come in a variety of colours. Denim is a distinctive material, rougher to the touch and normally used to make blue jeans. The respective goods therefore normally differ in nature and purpose. The trade channels will overlap in that department stores and clothes shops would routinely stock both the opponent’s and the applicant’s goods, but they would not be on the same

racks/shelves. The respective goods are neither complementary, nor are they in competition. I find them to be of low similarity.

139. In this section, I do not consider the opponent to have any stronger a point of similarity amongst its goods than those I have chosen for each particular comparison.

Class 41

140. The applicant's Class 41 services are different from the opponent's goods in terms of nature, purpose, method of use and trade channels. They are not complementary, nor are they in competition. The respective services and goods are dissimilar.

The average consumer and the nature of the purchasing act

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

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

142. The goods at issue are clothing, shoes, and headgear with the typical consumer being a member of the public. They would pay attention to quality, style, and price during the purchasing process. While the goods at issue can be expensive in certain cases, they can also be obtained cheaply. Overall, I consider that the level of attention paid during the purchasing process would be medium.
143. The purchasing process would be a primarily visual one as the average consumer inspected the goods and their labels and swing tags in person or browsed the goods online. Verbal factors would be minimal.

Case law

144. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v 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 greater degree of similarity between the marks, and vice versa;

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

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

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

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

Likelihood of confusion

145. 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. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.
146. By comparison with the goods in the fair specification that I have established for the opponent's mark, the applicant's goods and services are either identical, highly similar, of medium similarity, or of low similarity (except where I have found them to be dissimilar).
147. I have found the opponent's mark to be of medium visual similarity by comparison with the applicant's word mark and of low visual similarity by comparison with the applicant's figurative mark.

148. I have found the opponent's mark to be of medium aural and conceptual similarity by comparison with the applicant's marks.
149. I have found the earlier mark to be of a medium level of inherent distinctiveness.
150. The level of attention paid during the purchasing process for the competing goods by the average consumer, a member of the general public, would be medium. The process would be primarily a visual one, with verbal factors being minimal.
151. In respect of the opponent's mark by comparison with the applicant's word mark, the average consumer could not fail to notice the two additional words "CHILLER CREW" and so there is no likelihood of direct confusion. I make the same finding for the applicant's figurative mark which differs even more by comparison with the opponent's mark, it having the highly stylised "BBCC" device.
152. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

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

Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

153. In this case, the applicant’s marks would be seen by the average consumer as sub-brands of the opponent’s mark. They share the phrase “BAD BOY”. This phrase, taken together with the additional phrase “CHILLER CREW”, has a consistency of language in that both expressions have a degree of “street” slang about them, and to that extent, the one complements the other. The presence of a device in the applicant’s figurative mark does not detract from it being seen as a sub-brand of “BAD BOY”, the letters of the device serving to reinforce the initial letters of the words “BAD BOY CHILLER CREW”.
154. The average consumer, having encountered the respective marks on the goods at issue, would consider them to belong to the same or related undertakings where the level of similarity was identical, highly similar, or of medium similarity. I therefore find that there would be a likelihood of indirect confusion in these instances.
155. While I find no likelihood of confusion where the goods are dissimilar, taking the various factors into account that are considered as part of the multi-factorial test that I have applied, I also find that there will be no likelihood of confusion where the competing goods are of a low degree of similarity.

Conclusion

156. Subject to appeal, the opponent’s section 5(2)(b) claims have fallen away in respect of its second earlier mark, UK00002405885.
157. The OP000432600 and OP000432601 oppositions succeed under section 5(2)(b) in respect of the opponent’s first earlier mark, UK00002572396, for the following of the applicant’s goods under the applicant’s UK00003733111 and UK00003733149 marks.

Class 25 Clothing; footwear; headwear; t-shirts; hoods [clothing]; clothes; sweatshirts; trainers [footwear]; shoes; jerseys [clothing]; wristbands [clothing]; short-sleeved t-shirts; printed t-shirts; casual shirts; sneakers [footwear]; turtleneck shirts; casual footwear; casual clothing; footwear for men and women; children's clothing; shirts; knitted clothing; shorts [clothing]; tops [clothing]; collared shirts; hooded sweat shirts; hats; bobble hats; socks; men's socks; ankle socks; footless socks; sports socks; small hats; baseball caps and hats; beanie hats; tennis socks; fashion hats; sweatpants; trousers shorts; jogging shoes; jogging pants; vest tops; fleece vests; sports vests; jogging outfits; jogging bottoms [clothing].

158. The OP000432600 and OP000432601 oppositions fail under section 5(2)(b) in respect of the opponent's first earlier mark, UK00002572396, for the following of the applicant's goods and services under the applicant's UK00003733111 and UK00003733149 marks which proceed to registration:

Class 9 Music recordings; music tapes; music cassettes; musical cassettes; musical recordings; sound recordings; musical sound recordings; video recordings; musical video recordings; optical discs featuring music; prerecorded music audio tapes; prerecorded music compact discs; prerecorded music videos; prerecorded non-musical videos; downloadable digital music; downloaded music files; downloadable musical sound recordings.

Class 25 Boots; gloves [clothing]; flip-flops for use as footwear; jackets [clothing]; belts [clothing]; denims [clothing]; ties [clothing]; socks for infants and toddlers; trousers; men's and women's jackets, coats, trousers, vests; corduroy trousers; waterproof trousers; underpants; boxer shorts; boxer briefs.

Class 41 Audio entertainment services; children's entertainment services; cinematographic entertainment services; club entertainment services; conducting of entertainment activities; corporate entertainment services; entertainment services; entertainment by IP-TV; entertainment by film; entertainment club services; entertainment information; entertainment information services; entertainment provided by telephone; hospitality services (entertainment); interactive entertainment; interactive entertainment services; internet radio entertainment services; live entertainment; live entertainment production services; live entertainment services; music entertainment services; musical entertainment; musical group entertainment services; online entertainment; online entertainment services; online interactive entertainment services; online interactive entertainment; production of live entertainment; providing entertainment information; providing facilities for entertainment; radio and television entertainment; radio entertainment production; showing of prerecorded entertainment; sports entertainment services; theatre entertainment; musical festival services.

Section 5(3)

159. Section 5(3) of the Act is as follows:

“A trade mark which—

(a) is identical with or similar to an earlier trade mark,

[...]

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without

due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

160. The conditions of section 5(3) are cumulative. First, the application must be similar to the earlier mark(s). Secondly, the opponent must satisfy me that the earlier mark has achieved a level of knowledge/reputation amongst a significant part of the relevant public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the application. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods and/or services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.
161. The relevant case law can be found in the following judgments of the CJEU: *General Motors Corp v Yplon SA* (Case C-375/97), *Intel Corporation Inc v CPM United Kingdom Ltd* (Case C-252/07), *Adidas Salomon AG v Fitnessworld Trading Ltd* (Case C-408/01), *L'Oréal SA & Ors v Bellure & Ors* (Case C-487/07), *Interflora Inc & Anor v Marks and Spencer plc & Anor* (Case C-323/09) and *Environmental Manufacturing LLP v OHIM* (Case C-383/12 P). The law appears to be as follows:
- a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.
 - b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.
 - c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls

the earlier mark to mind; *Adidas Salomon*, paragraph 29, and *Intel*, paragraph 63.

d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods and/or services, the extent of the overlap between the relevant consumers for those goods and/or services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42.

e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or that there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68. Whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

f) The more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oréal*, paragraph 44.

g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods and/or services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods and/or services for which the earlier mark is registered, or a serious risk that this will happen in the future; *Intel*, paragraphs 76 and 77, and *Environmental Manufacturing*, paragraph 34.

h) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact on the earlier mark; *L'Oréal*, paragraph 40.

j) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation; *Interflora*, paragraph 74, and the court's answer to question 1 in *L'Oréal*.

162. I have already found that the contested marks are similar to the earlier mark.

Reputation

163. In *General Motors*, the CJEU held that:

“24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or services marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

164. The relevant date on which the opponent must show that the earlier marks have a reputation is the application date of the contested marks i.e. 15 December 2021.

165. While it is stated that the mark was first used in the early 1980s and the opponent first licensed the use of its mark in the UK in 2006, quantified evidence of use prior to the relevant date is limited.

166. By the relevant date, (there being no evidence of note that the opponent had used the mark for services), the opponent's goods in the form of a range of sports clothing, leisure clothing, headgear, boxing gloves, martial arts gloves, protective wear, bags, and water bottles were being sold direct or through wholesalers, or through the third-party platform Amazon. There is also evidence of such goods being prepared for sale prior to the relevant date which

leaves open the possibility that such goods went on to be sold by the relevant date.

167. The volumes, in respect of direct sales and wholesale transactions offered in evidence that had taken place by the relevant date, are not considerable: 59 invoices in total, the invoices for 2017 to 2020 being denominated in euros, totalling 13,100.81 and the invoices for 2021 being denominated in pounds, totalling 12,746.04. The range of the totals of the invoices is 25.98 euros to 3,506.40 euros. not given any dates in relation to them.
168. While the opponent's stated worldwide revenue is considerable, this is not broken down to a UK level in the evidence.
169. In terms of marketing, the opponent has quoted a very large expenditure figure, but again this is not broken down to UK level. While I am not told how much money had been spent in promoting the opponent's brand in the UK by the relevant date, there is a modest amount of evidence of such promotion having taken place. This takes the form of catalogues, the winning of awards sponsored by a magazine that has a UK edition, a promotional video, and the sponsorship of two English MMA fighters. However, no figures were provided as to the distribution of the catalogues, the readership of the magazine and the viewership of the video. For the MMA fighter who had made two Instagram posts prior to the period, these only attracted "likes" in the low hundreds.
170. In my view, the evidence falls short of demonstrating that the earlier mark had a reputation by the relevant date.

Conclusion

171. Subject to appeal, the oppositions under section 5(3) fail.

Evidence put forward by the applicant

172. Mr Kirk's witness statement sets out how the band "Bad Boy Chiller Crew" has developed, and the supporting exhibits show that its music is of commercial value with a social media following and a streaming audience.
173. The evidence also features band merchandise offered for sale in the form of balloons, cigarette papers, T-shirts and other casual clothing, and caps. This merchandise features the applied-for marks or the device element of the applied-for figurative mark alone.
174. None of this evidence cuts across the opponent's proof of use evidence which, having led to my finding genuine use for a range of goods, then formed the basis for a notional comparison of the marks and the competing goods and services under section 5(2)(b).
175. The claim that the applicant's evidence shows that the applicant has a reputation in its own right does not need to be assessed in the light of my finding that the section 5(3) oppositions have been unsuccessful.

OVERALL CONCLUSION

176. The OP000432600 and OP000432601 oppositions succeed in respect of the following goods under the applicant's UK00003733111 and UK00003733149 marks.

Class 25 Clothing; footwear; headwear; t-shirts; hoods [clothing]; clothes; sweatshirts; trainers [footwear]; shoes; jerseys [clothing]; wristbands [clothing]; short-sleeved t-shirts; printed t-shirts; casual shirts; sneakers [footwear]; turtleneck shirts; casual footwear; casual clothing; footwear for men and women; children's clothing; shirts; knitted clothing; shorts [clothing]; tops [clothing]; collared shirts; hooded sweat shirts; hats; bobble

hats; socks; men's socks; ankle socks; footless socks; sports socks; small hats; baseball caps and hats; beanie hats; tennis socks; fashion hats; sweatpants; trousers shorts; jogging shoes; jogging pants; vest tops; fleece vests; sports vests; jogging outfits; jogging bottoms [clothing].

177. The OP000432600 and OP000432601 oppositions fail in respect of the following goods and services under the applicant's UK00003733111 and UK00003733149 marks which proceed to registration:

- Class 9 Music recordings; music tapes; music cassettes; musical cassettes; musical recordings; sound recordings; musical sound recordings; video recordings; musical video recordings; optical discs featuring music; prerecorded music audio tapes; prerecorded music compact discs; prerecorded music videos; prerecorded non-musical videos; downloadable digital music; downloaded music files; downloadable musical sound recordings.
- Class 25 Boots; gloves [clothing]; flip-flops for use as footwear; jackets [clothing]; belts [clothing]; denims [clothing]; ties [clothing]; socks for infants and toddlers; trousers; men's and women's jackets, coats, trousers, vests; corduroy trousers; waterproof trousers; underpants; boxer shorts; boxer briefs.
- Class 41 Audio entertainment services; children's entertainment services; cinematographic entertainment services; club entertainment services; conducting of entertainment activities; corporate entertainment services; entertainment services; entertainment by IP-TV; entertainment by film; entertainment club services; entertainment information; entertainment information services; entertainment provided by telephone; hospitality services (entertainment); interactive entertainment; interactive

entertainment services; internet radio entertainment services; live entertainment; live entertainment production services; live entertainment services; music entertainment services; musical entertainment; musical group entertainment services; online entertainment; online entertainment services; online interactive entertainment services; online interactive entertainment; production of live entertainment; providing entertainment information; providing facilities for entertainment; radio and television entertainment; radio entertainment production; showing of prerecorded entertainment; sports entertainment services; theatre entertainment; musical festival services.

COSTS

178. While the opponent has achieved some success, the applicant has been the more successful and I award proportionate costs to the applicant in line with Annex A of Tribunal Practice Notice 2 of 2016:

Preparing statements

and considering the other side's statements: £300

Preparing evidence

and considering the other side's evidence: £500

Total: £800

179. I order Platypus Wear, Inc. to pay BBCC LIVES AND ENTERTAINMENT LIMITED the sum of £800. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 15th day of December 2023

JOHN WILLIAMS
For the Registrar