O/1198/23

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NUMBER 3802218

BY

PLUSME S.R.L.

TO REGISTER THE FOLLOWING TRADE MARK
IN CLASSES 18 AND 25

PIUMESTUDIO

AND OPPOSITION THERETO UNDER NUMBER 436653

BY

PUMA SE

Background and Pleadings

1. On 23 June 2022, PLUSME S.R.L. ("the Applicant") applied to register in the UK the figurative trade mark numbered 3802218 as displayed on the front cover page ("the contested mark") for the goods as set out below. It was accepted and published for opposition purposes on 8 July 2022.

Class 18: Luggages; travel bags; duffel bags, carry-on bags; wallets; garment carriers

Class 25: Footwear

2. On 4 October 2022, the application was opposed by PUMA SE ("the Opponent") relying on grounds under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act").

3. Under sections 5(2)(b) and 5(3) the Opponent relies upon the following earlier trade marks namely:

(i) UKTM 874725

(Mark '725)

PUMA

Filed and subsequently registered on 25 January 1965 for goods in class 25 namely '*shoes and parts thereof included in Class 25, all for use in sports and athletics'.*

(ii) UKTM 912579728

(Mark '728)

Filed on 6 February 2014 and registered on 30 June 2014

Whilst registered in classes 18, 25 and 28, for the purposes of this opposition it only relies upon the following goods:

Class 18: Leather and imitations of leather, and goods made of these materials, namely briefcases, bags, bags for clothing, holdalls, weekend bags, multipurpose bags, all-purpose athletic bags, all-

purpose sports bags, work bags, attaché cases, shopping bags, two-wheeled shopping bags, souvenir bags, bags (envelopes, pouches), for packaging, tote bags, handbags, small clutch purses, sling bags, Gladstone bags, ladies' handbags, gentlemen's handbags, bags for men, hip bags, evening handbags, evening bags, beach bags, bags for sports, courier bags, changing bags, tool bags, bags for campers, belt bags and hip bags, pouches, gym bags, shoe bags, satchels, school book bags, school bags, shoulder belts and straps, shoulder bags, haversacks, camping bags, boston bags, casual bags, sling bags for carrying infants, diplomatic bags, document cases, folders, document wallets, boxes, luggage, travel luggage, trunks for travel purposes, baggage, flight bags, trunks and travelling bags, travel bags, flight bags, wheeled shopping bags, travelling handbags, vanity cases, not fitted, garment carriers, suit carriers, travel garment covers, duffel bags, rucksacks, bags for climbers, bags for campers, nappy bags; Bags and pouches, included in class 18, and small goods of leather, namely luggage tags, Luggage label holders, Bags for men, Baggage, Coin purses, Coin purses, Pocket wallets, Wallets, Coin purses, Card holders, Card holders, Briefcases, Credit-card holders, Credit-card holders, Credit-card holders, Business card cases, Driving licence cases, Key bags, Key bags, Fanny packs, Clutch bags, Small pouches, Toiletry bags, Cosmetic purses, Cosmetic purses, Make-up bags, Cosmetic purses, Cosmetic purses, Cosmetic purses, Tie cases, Laces; Wallets, pocket wallets, key cases, handbags, briefcases, shopping bags, satchels, carrier bags, travelling bags, sports bags, included in class 18, duffel bags, rucksacks, school bags, belt bags, toiletry bags, trunks and travelling bags; Umbrellas, parasols and walking stick.

Class 25: Apparel, footwear, headgear.

(iii) UKTM 779443

(Mark ‘443)

Puma

Filed and subsequently registered on 4 July 1958.

Class 25: Articles of clothing, none being made of fur.

4. Under section 5(2)(b) the Opponent claims that as a result of the high similarity between the marks and the identity/similarity between the goods there is a likelihood of confusion on the part of the relevant public, including a likelihood of association.

5. Under section 5(3), the Opponent claims that use of the contested mark would without due cause take unfair advantage of, or be detrimental to the distinctive character and/or repute of the earlier marks.

6. Under section 5(4)(a) the Opponent relies upon its unregistered sign PUMA said to have been used throughout the UK since at least 1948 for *clothing, footwear, headgear, sportsware, leather goods, bags and fashion accessories*. The Opponent claims its use of the sign has generated a protectable goodwill and that the use of the contested mark will give rise to a misrepresentation resulting in damage to its business and the distinctiveness of its brand.

7. The Applicant filed a defence and counterstatement denying each of the Opponent's claims, putting it to strict proof. In particular the Applicant denies any similarity between the marks or that the respective goods are identical or similar that would lead to a likelihood of confusion. In so far as the other grounds of opposition relied upon the Applicant submits as follows:

> "7. The Applicant denies the assertions and statements it has made regarding its trading history, operations and activities, its alleged sponsorship and collaborations, and its (and the Opponent's Registrations') alleged reputation generally. Absent such evidence, the owner denies that the Opponent and/or the Opponent's Registrations have a "significant reputation".
>
> 8. The Applicant further denies that use of the Applicant's mark would take unfair advantage of, or be detrimental to the alleged (and to be proved) distinctive character or reputation of the Opponent's Registrations. As such, the Applicant denies all of the Opponent's assertions regarding the potential (and unsubstantiated) "economic effect" on the Opponent.

11. Concerning the claims and assertions under section 5(4)(a) of the Act, the Applicant denies that use of the Application would be contrary to the law of passing off."

8. The trade marks upon which the Opponent relies qualify as earlier trade marks pursuant to section 6 of the Act. As the earlier marks completed their registration process more than 5 years before the application date, they are subject to the proof of use requirements under section 6A of the Act. The Applicant requested that the Opponent provide proof of use for each of its marks and for all the goods it relies upon.

9. The Applicant is represented by AA Thornton IP LLP and the Opponent is represented by Appleyard Lees IP LLP. Both parties filed evidence. The Opponent requested a hearing which was listed before me on 17 August 2023 by video conference. Mr Chris Hoole of Appleyard Lees IP attended the hearing and filed skeleton arguments prior to the hearing. The Applicant chose not to attend but filed written submissions in lieu of attendance.

Evidence and submissions

10. The Opponent's evidence in chief consists of the witness statement of Ms Desiree Russo dated 16 February 2023 accompanied by seventeen exhibits marked DR1-DR17. Ms Russo is Trade Mark Counsel for the Opponent company, who has been employed in this capacity since December 2021. Ms Russo's evidence goes to the use, reputation, goodwill and enhanced distinctive character of the earlier trade marks/sign.

11. The Applicant's evidence consists of the witness statement of Mirko Rizzi dated 19 April 2023 accompanied by three exhibits marked MR1-MR3. Mr Rizzi's evidence goes to the history of its brand and company and sets out why the name was chosen. There is some limited non specified use of the applied for mark shown in evidence in and around 2022 and 2023.

Relevance of EU Law

12. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU

Directive. That is why this decision continues to refer to the case law of the EU courts on trade mark matters.

Decision

Proof of use

13. Section 6A of the Act is relevant to the proof of use in the opposition, which states as follows:

> "(1) This section applies where
>
> (a) an application for registration of a trade mark has been published,
>
> (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
>
> (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.
>
> (1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.
>
> (2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.
>
> (3) The use conditions are met if –
>
> (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
>
> (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.
>
> (4) For these purposes -

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

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

(5)-(5A) [Repealed]

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

14. Given that mark ‘728 is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union."

15. Section 100 of the Act is also relevant. It states that:

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

Relevant period

16. The relevant period for assessing whether there has been genuine use of the earlier marks is the five year period ending with the date of the application in issue namely 24 June 2017 to 23 June 2022. Mark '728 became a comparable mark as at the end of the implementation period on 31 December 2020 ("IP Completion Day"), and therefore any evidence of use of the corresponding EUTM in the EU in that part of the relevant period, up until 31 December 2020, will be taken into account in determining whether there has been genuine use of the comparable trade mark. Whilst there are references to the Opponent's use in Europe, its evidence predominantly focuses on use in the UK, and consequently I shall take the same approach.

Form of the mark

17. Where the Opponent has used the mark in its registered word only or stylised form this is clearly use upon which it may rely. The evidence clearly shows the word PUMA in both its word only and figurative form being used to describe the products or displayed on the products themselves. The marks are also shown in combination with other trade marks/words/devices for example PUMA x AMI, PUMA x FENTY and  . These are all permissible forms of the marks.[1]

Genuine use

18. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

[1] *Colloseum Holdings AG v Levi Strauss & Co*., Case C-12/12 at [31] to [35].

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, 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 Bundervsvereinigung 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], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], 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], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles 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]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(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]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(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]. 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].

(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]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(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]; *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]."

19. Proven use of a mark which fails to establish that "the commercial exploitation of the mark is real" because the use would not be "viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark" is not genuine use.[2]

20. I note in the skeletons filed and at the hearing that for the purposes of the proof of use assessment, Mr Hoole asked me to limit the goods relied upon in class 18, to *bags, weekend, bags, rucksacks, gym bags, handbags fanny packs, travel bags, tote bags shopping bags and wallets* as this represented the Opponent's best case. I shall assess the evidence of use, therefore, in so far as they relate to class 18 only as applying to these goods. The reliance on goods in class 25 remain unchanged.

21. I note the following from the Opponent's evidence:

(i) In accordance with the information taken from its website www.puma.com and Wikipedia, the Opponent is a multinational company having used the word mark PUMA in relation to footwear since 1948 and in relation to clothing, headgear, leather goods, bags and accessories since 1950.[3] Examples of use of goods bearing the mark are produced from various websites (via the Way Back Machine archive tool dated between May 2019 to October 2021) to include use of sports, leisure and fashion clothing, underwear, footwear, headgear and various types of bags.[4]

(ii) The Opponent has entered into various collaborations and sponsorship deals with high profile athletes, artists, brands and fashion houses creating and designing custom collections. It sponsors a multitude of sporting personalities, sporting teams and events in the field of inter alia tennis, athletics, football, motor racing and boxing. It has long term sponsorship deals with clubs such as Manchester City and individuals such as Usain Bolt, Rihanna, Fenty, Pele,

[2] *Naazneen Investments Ltd v OHIM*, Case T-250/13; C-252/15 P
[3] Exhibits DR1 and DR2
[4] Exhibit DR7 – JD Sport, Sports Direct and Zalando

Martina Navratilova, Colin Jackson, Linford Christie, The Weeknd, Jay-Z and Kylie Jenner.[5]

(iii) The Opponent has three different distribution channels of its goods namely wholesale, PUMA owned and operated retail outlets and e-commerce stores. Its flagship store was opened in the UK in 2002 in London which remains open to this day.[6]

(iv) The Opponent's worldwide, EMEA[7] and UK sales figures are taken from its annual report dated 2021 and half year report dated 2022 as reproduced below.[8] The total sales figures are not broken down by specific category but are said to cover footwear, apparel and accessories. Ms Russo states that the accessories column consists of mainly sales figures relating to bags, balls and sports accessories but also includes wallets. It is said that its worldwide sportswear sales total $6.2 billion as at 2022.[9]

Year	Worldwide sales – € Million	Worldwide footwear sales – € Million	Worldwide apparel sales – € Million	Worldwide accessories sales – € Million	EMEA sales – € Million	UK Sales – £ Million
2017	4,135.9	1,974.5	1,441.4	719.9	1,646.2	146.1
2018	4,648.3	2,184.7	1,687.5	776.1	1,800.3	175.0
2019	5,502.2	2,552.5	2,068.7	881.1	2,001.4	179.2
2020	5,234.4	2,367.6	1,974.1	892.7	1,982.9	163.3
2021	6,805.4	3,163.6	2,517.3	1,124.5	2,531.7	242.1
Jan - Jun 2022	3,914.1	1,948.6	1,304.4	661.1	1,415.1	

[5] Exhibit DR3 screenshot taken form Wikipedia accessed 15 February 2023 and DR10
[6] Exhibit DR4 – screenshot of an article taken from www.campaignlive.co.uk dated 24 January 2002 referring to the launch and screenshot accessed 16 February 2023 from www.puma.com showing images of the location of its London stores
[7] EMEA – defined as European, Middle East and Asia
[8] Exhibit DR 5
[9] Exhibit DR6 - All Top Everything website

	Second Quarter				First Half-Year			
Sales by regions and product divisions	Q2		growth rates		1-6		growth rates	
€ million	2022	2021	Euro	currency adjusted	2022	2021	Euro	currency adjusted
Breakdown by regions								
EMEA	706,2	572,4	23,4%	21,5%	1.415,1	1.144,8	23,6%	23,5%
Americas	940,6	675,6	39,2%	25,6%	1.756,5	1.209,5	45,2%	33,6%
Asia/Pacific	355,1	341,2	4,1%	-1,8%	742,6	783,6	-5,2%	-10,4%
Total	**2.002,0**	**1.589,1**	**26,0%**	**18,4%**	**3.914,1**	**3.137,9**	**24,7%**	**19,0%**
Breakdown by product divisions								
Footwear	1.007,3	787,8	27,9%	19,7%	1.948,6	1.561,6	24,8%	18,9%
Apparel	665,7	522,8	27,3%	20,2%	1.304,4	1.054,8	23,7%	18,1%
Accessories	329,0	278,5	18,1%	11,2%	661,1	521,5	26,8%	20,9%
Total	**2.002,0**	**1.589,1**	**26,0%**	**18,4%**	**3.914,1**	**3.137,9**	**24,7%**	**19,0%**

(v) The goods bearing the PUMA mark are sold via various well known and high profile retailers in the UK to include Sports Direct, JD Sports, ASOS, Selfridges, FarFetch, End Clothing and Zalando. Screenshots taken from its website and those of these retailers' websites are produced using the Way Back Machine, and show a variety of PUMA branded goods being offered for sale. The screenshots show the selection of goods as set out in paragraph 21(i) as being offered for sale during the relevant period via these outlets.[10]

(vi) The Opponent invests significant sums in marketing its products. Its annual promotional expenditure worldwide and directed specifically at the UK is set out in the following table:[11]

Year	Worldwide marketing expenses – € million	UK marketing expenses – € million
2017	822.9	14.148
2018	931.2	17.838
2019	1,112.1	19.072
2020	1,050.2	15.988
2021	1,309.1	17.060

(vii) A selection of press releases and articles relating to use of the PUMA marks on its goods and its collaborations, are produced taken from various printed and online publications. These include references to 'PUMA news' in

[10] Exhibit DR7
[11] Exhibit DR8 taken from its 2021 annual report

www.fashionunited.uk (various dates); references to the collaboration between Puma and Fenty in www.vogue.co.uk (dated 17 November 2020, 11 September 2019 and Spring 2018) and www.elle.com/uk dated July 2021; reference to PUMA X during London Fashion week in relation to trainers in www.office.co.uk's blog dated 18 September 2019; reference to its collaboration with Balmain in the Mailonline dated 22 November 2019 and a press release dated 20 June 2018 announcing the appointment of Jay-Z as its creative director, overseeing the design of trainers and clothing in the revived basketball category.[12]

(viii) The Opponent has won a number of industry awards for its products, brand and business. A selection are referred to at paragraph 22 and referenced in the press release dated 31 January 2020 in exhibit DR13. Those accolades include the European Top Employer for 2020 and 2021 and the best running shoe award 2021 by UK's The Run Testers for its PUMA velocity Nitro running trainer.[13]

(ix) The Opponent is said to have an extensive social media presence. Its Instagram account is shown to have 12.3 million followers, its Facebook account has over 21 million followers, its Twitter account has over 1.9 million followers and its YouTube account has 596,000 subscribers.[14] While the access dates of the screenshots are dated in September 2022 this significant a number of followers is unlikely to have been achieved overnight or been built up only after June 2022. It is therefore reasonable for me to infer that the number of social media followers that the Opponent had were equally significant during the relevant period, or at the very least the latter part of the relevant period. Similarly, whilst the proportion of its followers are not specified as being located in the UK it is reasonable for me to infer given the other evidence produced, in so far as its sales figures and its promotional spend for the UK, that a significant enough portion of these followers are likely to be UK based.

[12] Exhibit DR11
[13] Exhibit DR13
[14] Exhibit DR12

(x) Screenshots are produced from the YouGov website (accessed 13 February 2023) said to be an independent internet based market research and data analytics firm which placed the Puma brand as the "11th Most Famous fashion and clothing brand in the UK in the last quarter of 2022" with a 'popularity' rating of 48% and a 'fame' rating of 96%.[15] Whilst I am unclear as to the criteria upon which the fame score is based the figures nevertheless appear to support the claim that the mark PUMA is recognised by UK consumers as a fashion and clothing brand.

(xi) The 'statistica' website (published 27 July 2022) lists PUMA as the third biggest athletic apparel accessories and footwear company worldwide in 2021.[16]

22. Although the Applicant criticises the Opponent for not sufficiently showing evidence within the relevant period, or not showing specific evidence relating to the goods relied upon, I bear in mind that it is necessary for me to consider the evidential picture as a whole and not whether each individual piece of evidence shows use by itself. Furthermore whilst the Applicant challenged the evidence in its submissions in lieu of hearing, it did not file evidence to directly contradict Ms Russo's witness statement nor did it apply to cross examine her. Provided the Opponent's evidence is not obviously wrong, incredible or simply amounts to no more than a bare assertion of use, then there is no reason for me to disbelieve or to dismiss it.[17] The evidence is not without its faults with a number of screenshots and documents being either undated or dated/accessed outside or towards the tail end of the relevant period, mainly 2021 and 2022. But in this regard I do not believe that the Opponent's website or social media accounts would have been significantly different during the relevant period, given the extensive sales and marketing expenditure produced by Ms Russo and the figures taken from the Opponent's annual reports dated 2021 and 2022 which cover sales from 2017. The Opponent's sales figures worldwide amount to $6.2 billion in

[15] Exhibit DR14
[16] Exhibit DR6
[17] *Pan Worlds Brands Limited v Tripp Limited (Extreme Trade mark)* [2008] RPC 2 21 Richard Arnold QC (as Appointed Person)

2022, which clearly shows that it is a recognisable brand. In light of the other evidence produced I believe that this would extend to UK consumers.

23. Furthermore, whilst I note that the sales figures and marketing spend have not been broken down by specific category, the other evidence clearly shows use of the marks on a wide range of goods to include those as relied upon by the Opponent. I have no hesitation in finding, therefore, that the Opponent has commercially exploited its mark both in its word only and figurative form during the relevant period for sports, leisure and fashion clothing, footwear, headgear and bags.

Fair specification

24. I must now consider whether, or the extent to which, the evidence shows use of the earlier mark in relation to the goods relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C.[18], 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."

25. 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 (at [47]):

> "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

[18] As he was then.

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 Pl*c [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."

26. The majority of the use demonstrated concern clothing, headgear, footwear and bags at large which are broad terms. I consider that genuine use has been made of the marks for goods that fall into these categories. I will now consider these categories in turn.

27. The evidence shows a range of different headgear upon which the marks have been used to include caps, beanies and baseball caps. I consider that headgear would be a fair specification for these goods.

28. In terms of clothing, evidence has been produced to show use of the marks on a variety of different goods to include clothing of various kinds. It is my view that *casual, leisure and sports clothing* would be a fair specification encompassing the range of different items that are shown in the evidence.

29. In terms of footwear, the evidence shows use of the marks for football boots, trainers, casual shoes and flip flops/sliders. I consider that the term *footwear* covers the use of these sub category of goods.

30. I accept that the Opponent has shown use for bags to include sports and gym bags, rucksacks, travel and weekend bags, handbags, shopping bags, tote bags, cross over and bum bags.

31. At the hearing Mr Hoole argued that the Opponent had shown use for wallets and directed me to three images taken from the Opponent's website showing cross over/bum bags and purses.[19] He argued that these goods could reasonably be described as wallets, since a cross over bag/bum bag is used to carry personal items including money. Mr Hoole submitted that it was reasonable for me to construe these items as showing use for wallets. I am not persuaded by this argument. Taking the ordinary meaning of the word from the view point of the UK consumer, a wallet is generally regarded as a "a small folding case for carrying paper money, credit cards and other flat objects that can be carried in a pocket and is used especially by men."[20] Whilst I accept that the Cambridge dictionary definition of a wallet also extends to a "small container for carrying coins, paper money and credit cards used especially by women" this meaning is attributed to the US. The evidence of images showing a cross over bag, a bum bag and a purse is not specific enough to satisfy me that use has been shown for wallets, especially where the sales figures are not broken down by category specifically showing sales for these particular goods.

32. I consider that the Opponent has shown genuine use for the following goods in classes 25 and 18, for which it may rely for the purposes of its section 5(2)(b) and 5(3) grounds:

Mark '725: Sports and athletic footwear in class 25.

[19] Exhibit DR7
[20] www.dictionary.cambridge.org

Mark ‘443: Casual, leisure and sports clothing in class 25.

Mark ‘728: Sports and gym bags, rucksacks, travel and weekend bags, handbags, shopping bags, tote bags, cross over bags and bum bags in class 18; and

Casual, leisure and sports clothing; headgear and footwear in class 25.

33. Additionally as this will have relevance to the Opponent’s claims under sections 5(3) and 5(4)(a), these findings will apply equally to the Opponent’s claim to a goodwill and reputation in the UK as at the relevant date, namely 23 June 2022. Furthermore, the evidence also supports the Opponent’s claim to an enhanced degree of distinctive character for these goods.

Section 5(2)(b)

34. 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.”

35. Section 5A of the Act is as follows:

> “5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

Case law

36. 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.

Comparison of the goods

37. When conducting a goods comparison, all relevant factors should be considered as per the judgment of the Court of Justice of the European Union ("CJEU") in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc* Case C-39/97, where the court stated at paragraph 23 of its judgment that:

> "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".

38. I am also guided by the relevant factors for assessing similarity identified by Jacob J in *Treat*, [1996] R.P.C. 281 namely:

(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.

39. In *Gérard Meric v Office for Harmonisation in the Internal Market ("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 Applicant relies on those goods as listed in paragraph where the goods designated by the trade mark application are included in a more general category designated by the earlier mark."

40. The Opponent argued that the goods were identical or highly similar.

41. Other than a bare denial in its counterstatement, the Applicant did not advance any detailed submissions regarding the identity, similarity or otherwise of the goods at issue.

42. I shall go through the contested goods in turn comparing these as against the goods upon which the Opponent may rely following my earlier findings.

Footwear

43.The contested goods are either self-evidently identical or are identical in accordance with the principles in *Meric* to the '725 and '728 marks' terms, namely 'footwear' and 'sports and athletic footwear'.

44. Given that the '443 mark is only registered for 'articles of clothing…' I also find that the goods for which I found use falling into this category namely 'casual, leisure and sports clothing' are similar to the applied for footwear. Clothing and footwear are often seen and sold together in the same retail outlets, within close proximity to each other. I consider that they also overlap in purpose, each intended to cover and protect parts of the body, albeit different parts of the body. The respective goods would also reach the market by the same methods and are directed at the same end user. I consider that the goods are similar to a medium degree.

Luggages; travel bags; duffel bags, carry-on bags; garment carriers

45. These goods are self-evidently identical or identical in accordance with *Meric* to the Opponent's class 18 goods for which use has been shown for its '728 Mark.

Wallets

46. In so far as the Opponent's term *wallets*, these are similar to a medium degree to the Opponent's bum bags and cross over bags for which use has been shown, overlapping in purpose (both being used to carry and safeguard a person's personal belongings which would include money), trade channels, producer and end user.

Average consumer and the purchasing process

47. When considering the opposing trade marks, I must determine, first of all, who the average consumer is for the goods. I must then determine the purchasing process. The average consumer is deemed reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion the average consumer's level of attention is likely to vary according to the category of goods in question.[21]

48. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited, [2014] EWHC 439 (Ch),* Birss J described the average consumer in these terms:

[21] *Lloyd Schuhfabrik Meyer*, case C-342/97.

> "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."

49. Overall, I consider that the contested goods will be directed at members of the general public, who predominantly select the goods via visual means by inspection from rails or shelves of retail premises or their online equivalents. Aural considerations may also play a part, where requests/enquiries are made to sales assistants for example.[22] Whilst accounting for variations in price, overall, the goods are neither particularly expensive nor infrequent purchases, with considerations such as fashion trends, price, quality and suitability/fit taken into account in the selection process. For these reasons, I consider that an average degree of attention will be undertaken in the purchasing process i.e. no higher or lower than the norm for such goods.

Comparison of the trade marks

50. 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."

[22] *New Look Limited v OHIM,* joined cases T-117/03 to T-119/03 and T-171/03

51. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to consider 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 trade marks.

52. The respective trade marks are as follows:

Contested mark	Earlier Marks
PIUMESTUDIO	Mark '728  Mark '725 PUMA Mark '443 Puma

53. In so far as the contested mark is concerned, the Opponent submits that the dominant and distinctive element is the word PIUME. It argues that the word STUDIO is non distinctive and simply refers to the fact that the opposed goods were created and manufactured in a design studio and/or that they are to be worn in a fitness studio. It is argued that little notice will therefore be made of the word STUDIO.

54. In support of this argument the Opponent provides evidence regarding the word STUDIO being used descriptively by the Opponent and a number of third parties.[23] It is also said that the Opponent's evidence of how the Applicant is using the mark is a factor to consider in respect of analysing a likelihood of confusion. In particular Mr Hoole submitted that:

[23] Para 25 of Ms Russo's statement and exhibit DR15.

25. In considering the similarity between the marks, it is important to consider a notional (or normal) fair use of Opposed Mark and, to the extent that it has been used, the actual use. In the decision of the Supreme Court dated 5 December 2006 in case A3/2006/0976 and 0977, O2 Holdings Limited, O2 (UK) Limited v Hutchinson[5], it was held that:

> *34. I also see no good reason to say that the consideration (for either Art.5.1(a) or (b)) is limited to a comparison between the defendant's sign with the registered mark. Indeed the very Article clearly calls for an examination of the context of the use – you have to consider how the defendant is using the sign complained of to answer the basic question of whether he is using it "in the course of trade." So it is particularly artificial then to go on to try to isolate the sign of which complaint is made devoid from the context of its use. Nor am I impressed by the fact that the same test applies at the registration stage. For then any notional fair use of the mark applied for must be considered, whether it has in fact been used at all.*

26. Further, in a decision of the General Court of the European Union dated 11 December 2014 in case T-480/12, The Coca-Cola Company v OHIM[6], it was held that:

> *90. It must therefore be found that the Board of Appeal erred in disregarding that evidence when applying Article 8(5) of Regulation No 207/2009 in this case.*
>
> *93. It will therefore be for the Board of Appeal, when examining the conditions for applying Article 8(5) of Regulation No 207/2009 (see paragraph 76 above), to take into consideration the evidence relating to the commercial use of the mark applied for, as produced by Coca-Cola during the opposition proceedings.*

55. In this regard Mr Hoole argues that the same reasoning is applicable in respect of analysing a likelihood of confusion under section 5(2)(b) as was held in *O2 Holdings Limited, O2 (UK) Limited v Hutchinson* [2006] EWCA Civ 1656.

56. In effect Mr Hoole argues that I should focus solely on the word PIUME when undertaking the comparison. I disagree. Firstly the evidence itself of screenshots showing the use of the word STUDIO by third parties is dated in 2023. This evidence is not material since it tells me nothing as to the position as at the relevant date in June 2022. Secondly, the cases to which Mr Hoole refers are ones relating to infringement actions where use of a trade mark in the course of trade is a relevant consideration. In so far as the claim under section 5(2)(b) the assessment as to a likelihood of confusion is one to be taken on a notional and fair basis in relation to the marks as registered/applied for and not in fact how they are being used in the market place. The commercial use of the applied for mark may have relevance to a claim for damages in so far as demonstrating an intention to take an unfair advantage under the section 5(3) ground, but I shall return to this point later in my decision. Thirdly, even if I were to accept that the word STUDIO is purely descriptive, this does not of itself render this

element negligible or invisible in the assessment.[24] The caselaw is clear I must consider the marks as wholes and undertake the comparison accordingly. I shall bear these points in mind whilst undertaking the comparison.

Overall impression

57. The contested figurative mark consists of the word PIUMESTUDIO in a stylised font. The stylisation and presentation of the letters has little trade mark significance and does not detract from the word itself. Although consumers may recognise the applied for mark as being made up of two elements i.e. the word PIUME and the word STUDIO, the overall impression of the trade mark resides in its totality.

58. Each of the earlier marks consist of the word PUMA. In mark '725 this word is presented in an unremarkable font in capitals whereas for mark '443 it is presented in title case. The variation in casing makes little difference in the overall impression which resides in the entirety of the word. In so far as the '728 mark the word PUMA is presented in a stylised emboldened font. Whilst contributing to the mark, when considered as a whole, again the overall impression resides in the word itself with the stylisation playing a significantly lesser role.

My approach

59. Notional and fair use allows marks to be presented in any font, colour or case and therefore the difference in casing between the '725 and '443 marks will have little impact on the assessment. Further it is accepted by the Applicant that the stylised logo format of mark '728 in block lettering does not detract from the word PUMA itself. Consequently, I shall consider the earlier marks collectively and singularly for the word PUMA.

Visual comparison

60. The Opponent has only focused on the comparison between the word PIUME and PUMA submitting that visually the marks coincide with these words which are highly similar containing the identical string of characters P-UM-. It submits that the difference created by the inclusion of the letter 'I' in the applied for mark will have little visual impact, appearing as it does in between the letters P and U. Furthermore, it is said

[24] *Purity Wellness Group Ltd v Stockroom (Kent) Ltd* O/115/22, Mr Philip Harris as the Appointed Person

that the way in which the Applicant uses the mark on the soles of its footwear would in fact lead to confusion. As stated this latter argument is not relevant to my assessment.

61. Visually the Applicant submits that the marks are dissimilar. Whilst the contested mark is presented as one word it accepts that it may be broken down by consumers into two component parts i.e. “PIUME” and “STUDIO”. In its view both parts are equally dominant and distinctive within the mark as a whole. It refutes that the word STUDIO is low in distinctive character in relation to the relevant goods as it argues that the word refers to the collective of people working on the design of the products and the imagery of the brand rather than a study. The evidence of third parties using the term is only a small number and either not used in relation to relevant goods or used in a way which is distinguishable from the applied for mark. The evidence is insufficient in its view to demonstrate that the mark STUDIO is sufficiently commonly used in the relevant industry that it has no distinctive character and therefore this component should be deemed to have an average degree of distinctiveness. I agree.

62. The earlier mark is for the word PUMA whereas the contested mark is for the stylised word PIUMESTUDIO. The marks coincide in the three letters P-U-M at the beginning of each mark, but in the contested mark’s case the letters are interjected by the letter ‘I’ so that the first three letters are P-I-U. The earlier mark ends in the letter A whereas the first element of the contested mark ends in the letter E. The contested mark also includes the word STUDIO there being no counterpart in the earlier mark. Ordinarily the beginning of marks have greater impact visually,[25] however the different lengths of the respective marks and the additional letters/word contained in the applied for mark and their position cannot be ignored. Weighing up the similarities as against the differences, I consider that visually the marks are similar to a low degree.

Aural comparison

63. The Opponent advances the suggestion that its mark will be pronounced as PYOO-MAH whereas the first element and distinctive element of the contested mark will be pronounced as PYOO-MEH or PYOOM. The Opponent ignores the element STUDIO completely in the aural assessment arguing that it will not be pronounced.

[25] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

The Applicant on the other hand argues that the marks are dissimilar. Although the marks overlap with the first sound P it submits that the remaining syllables are entirely dissimilar, and are easily distinguishable from each other when spoken.

64. To my mind the earlier mark will be pronounced as PEWM-AH. There may be a number of ways in which the first element of the contested mark is pronounced but in so far as the word STUDIO this will be given its ordinary English pronunciation. I do not agree with the Opponent that the word STUDIO will not be pronounced. There may be some consumers who do not pronounce the word STUDIO when referring to the contested mark but in my view it will only be by a small minority and an insufficient proportion of consumers.

65. Following normal paradigms I consider when regarded as a whole the contested mark will be pronounced as PEWM-STEW-DEE-OH with a silent E at the end of the first element. But I do not discount that there may be number of variations where for example the first element is pronounced as PEWM-EH or PEWM-EE but neither of these will bring the pronunciation closer in terms of similarity to the earlier mark overall. In my view and it appears accepted by both parties the marks only overlap with the first syllable which will be pronounced identically, but the remaining syllables will differ. Overall I consider the aural similarity between the marks to be low.

Conceptual comparison

66. The Applicant states that PIUME means the plural for feather in Italian such that the difference in the respective meaning of the words will be obvious to consumers. However, no evidence has been provided as to the number of Italian speaking consumers in the UK. Whilst I accept that some UK consumers who speak Italian may understand the meaning advanced by the Applicant I do not consider that this would be a significant number or by the UK population at large. In my view the vast majority of consumers would not attribute any meaning to the first element of the contested mark understating it to be an invented word. The word STUDIO, however, is an English dictionary word and easily recognisable.

67. The earlier mark will be understood to refer to a wild cat.

68. Taking account of these factors where the earlier mark has a clear meaning and the first element of the contested mark will be seen as an invented word with no

meaning, and where the word STUDIO acts as a point of conceptual difference, it follows that, overall, there is no conceptual similarity between the marks.

Distinctive character

69. The case of *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV,* Case C-342/97 sets out the legal position to determine the distinctive character of a mark. In this case the CJEU stated that:

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see Windsurfing Chiemsee, paragraph 51)."

70. Registered trade marks possess varying degrees of inherent distinctive character, some being suggestive or allusive of a characteristic of the goods and services on offer, to those with high inherent distinctive character such as invented words which have no allusive qualities. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark the greater the likelihood of confusion.

71. The word PUMA is an English dictionary word but has no descriptive or allusive connection to the registered goods. Being a dictionary word its inherent distinctive character is medium or average. I do not consider that the stylisation adds anything further to the distinctive character of the '728 mark beyond that which I found for the word itself.

72. In so far as the enhanced degree of distinctive character claimed by the Opponent I have already assessed the evidence when considering the use it has made of its mark. In *Adidas AG v Shoe branding Europe BVBA,*[26] it was found that the assessment of enhanced distinctiveness is to be interpreted the same as that for genuine use. The evidence shows long standing and consistent use and promotion of its marks in the UK by way of sales, sponsorship deals, promotion and advertisements in printed publications, online platforms and via social media. I have no hesitation in finding that the sales and marketing figures produced, demonstrate that the Opponent has enhanced the inherent distinctive character of each of its marks to a high degree for sports, leisure and casual clothing, footwear, headgear and bags.

Likelihood of confusion

73. In determining whether there is a likelihood of confusion between the marks I must consider whether there is direct or indirect confusion. Direct confusion is where one mark is mistaken for the other, whereas indirect confusion is where the average consumer recognises that the marks are not the same but nevertheless due to the similarities between the marks lead them to believe that the respective goods originate from the same or related source.

74. There are a number of factors in the global assessment to bear 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. It is necessary for me to keep in mind the distinctive character of the Opponent's trade marks, the average consumer for the goods and the nature of the purchasing process. In doing so, I must consider that the average consumer rarely has the opportunity to make direct comparisons between

[26] T-307/17.

trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

75. Earlier in my decision I made the following findings

i. The marks were visually and aurally similar to a low degree.

ii. Conceptually the marks were dissimilar.

iii. The earlier marks were inherently distinctive to an average degree and had been enhanced to a high degree by the use made of them.

iv. The goods were identical, save for the term wallets which were similar to a medium degree (in so far as clothing against footwear I found these goods to be similar to a medium degree).

v. The average consumer was a member of the general public paying an average degree of attention in the selection process. The goods were primarily selected by visual means but with aural considerations not being discounted.

76. The Opponent argues that as a result of the non-distinctive element STUDIO effectively being ignored by consumers they would be faced with the word PIUME and PUMA which would lead them to mistake or imperfectly recall the marks one for the other. For the reasons I have already given, I do not find this to be the case. I do not consider that consumers will simply ignore the word STUDIO from the contested mark. On this basis, I see no likelihood of direct confusion. Visually and aurally the similarity between the marks was low when regarded as a whole, and further given that the earlier marks have a clear meaning which is absent from the only element of the contested mark that is similar to them, this clearly helps to distinguish between the marks and helps to avoid confusion, particularly where the goods are purchased predominantly via visual means.

77. Even if I accepted the Opponent's argument that the contested mark would be seen or pronounced as just PIUME with no reference to the word STUDIO this does not assist the Opponent. Whilst in this scenario the similarity between the respective marks may be closer, the fact that the words PIUME and PUMA are short words means that any differences between them will have greater impact. The fact that the words

end in different letters and the beginning of these words are different, P-U as opposed to P-I-U, means that they will be easily distinguished.

78. I have taken account of the fact that the majority of goods are identical and that the earlier marks have a high degree of distinctive character by the use that has been made of them for footwear, bags, headgear and leisure/sports and casual clothing. However, these factors do not outweigh the obvious dissimilarities between the marks that I have already outlined.

79. In so far as indirect confusion in order for this to occur consumers would need to imperfectly recall the first element of the contested mark and consider that the addition of the word STUDIO would represent a sub brand or a different range or collection from the same or similar undertaking. I see no reason for this to be the case. There is no logical reason for a brand to use a different word to the original, and then combine it with the word STUDIO to create a sub brand.

80. I do not find either direct or indirect confusion and therefore the opposition under section 5(2)(b) fails in its entirety.

Section 5(3)

81. Section 5(3) of the Act states:

> "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 (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) 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.
>
> (3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected."

82. I bear in mind the relevant case law set out in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel,* Case C-408/01, *Addidas-Salomon*, Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer*

v Interflora. The conditions of section 5(3) are cumulative. Firstly, the Opponent must show that the earlier marks are similar to the contested mark. Secondly, the Opponent must show that the earlier marks have achieved a level of knowledge/reputation amongst a significant part of the 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 marks being brought to mind by the later mark. Fourthly, assuming that the first three conditions are met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) for the goods to 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. For the purposes of section 5(3) the relevant date for the assessment is the date of the application to register the contested mark namely 23 June 2022.

Similarity between the marks

83. I found the marks to be visually and aurally similar, but only to a low degree. I found that conceptually the marks were dissimilar.

Reputation

84. In *General Motors*, Case C-375/97, the CJEU held that:

> "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."

85. In assessing whether the earlier marks have a reputation to a significant number of consumers, I must assess the evidence in terms of the extent it demonstrates "the market share held by the trademark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertaking in promoting it."[27]

86. I note that the assessment of whether the Opponent has a reputation for the goods claimed is a different test to the one undertaken for an enhanced level of distinctive character. However, the assessment for a reputation is based on the same evidence for use. Given my earlier findings I have no hesitation in finding that the Opponent has a substantial reputation for leisure, sports and casual clothing, headgear, footwear and bags.

Link

87. Having found a reputation I must now go on to consider whether this reputation would give rise to the necessary mental link being made between the respective trade marks. The factors to be taken into account to establish as to whether a link would be made, are those as set out in *Intel.*[28] Taking each of the factors in turn.

The degree of similarity between the conflicting marks

Earlier in my decision when considering the section 5(2)(b) ground I found that the visual and aural similarities between the marks were low, and that the earlier marks had a clear meaning whereas the contested mark did not.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services and the relevant section of the public.

I have already found that most of the applied for goods are identical to the registered goods, save for wallets which are similar to a medium degree. In so

[27] *General Motors* para 27
[28] *Intel Corporation Inc v CPM United Kingdom Ltd* - [2009] RPC 15 (CJEU).

far as clothing versus footwear I found these goods to be similar to a medium degree. These findings apply equally here since the Opponent relies on roughly the same goods for each ground.

The relevant public is the member of the general public.

The strength of the earlier marks' reputation

I found that the earlier marks have a substantial reputation for those goods as outlined at paragraph 86.

The degree of the earlier marks' distinctive character, whether inherent or acquired through use

I found that the earlier marks are inherently distinctive to an average degree and by virtue of the evidence filed, I found that the Opponent has enhanced the degree of distinctive character further to a high degree for all the goods to which I found it had a reputation.

Whether there is a likelihood of confusion

I did not find a likelihood of confusion. I see no reason why the average consumer would assume the mark PIUMESTUDIO for footwear and bags/luggage is connected to PUMA for the same or similar goods.

88. The Opponent submits that even if there is no confusion, such is the reputation held by the earlier marks that the average consumer will make a link between them and the contested mark, focusing purely on the first element of the contested mark. A link means that the earlier marks will be brought to mind by the later mark, but I see no reason why this would be the case. Even when focusing purely on the more similar element PIUME as opposed to the mark as a whole, the coincidence of the letters P-U-M are not positioned in the same order and the words also differ in length, although I accept not significantly, but nevertheless sufficient for this to change the overall look of the later mark as against the first element of the earlier mark. When also factoring that the words PUMA/PIUME end in different letters and the obvious differences in meaning, this leads to a further unlikelihood that the public will link the two marks. When taking the contested mark as a whole this is even more unlikely. Even for goods that are identical, I see no reason why the earlier mark PUMA would be brought to

mind when seeing the later mark with or without the element STUDIO. There is no logical reason for the public to bring the other mark to mind just because they overlap in a small number of letters.

89. Mr Hoole referred me to the evidence and the case of *KEYPAL TM,*[29] relying on the way in which the Applicant was using the element PIUME on the sole of its footwear which he argued would lead consumers to make a link with the earlier marks. The evidence consisted of screenshots taken from the Applicant and third party websites where the goods were referenced solely by the word 'Piume' and the mark was displayed on the sole of the feet as follows:

90. In the *KEYPAL* decision (which was a first instance decision) the Hearing Officer found that the way in which the Applicant was commercially using the mark in a similar get up to the Opponent's, demonstrated an intention by it to take an unfair advantage of the reputation of the Opponent. Mr Hoole invited me to follow the same approach. I note that the Hearing Officer only came to this conclusion after having found a link between the respective marks when regarded as wholes i.e the earlier mark PAYPAL versus the contested mark KEYPAL.

91. The *KEYPAL TM* decision, therefore, is to be distinguished with the decision in suit. First and foremost because I have not found that a link would be made by relevant consumers between the respective marks when viewed as wholes, and therefore the question of damage from an unfair advantage being taken does not arise. Furthermore, the evidence produced to show the contested mark in use is far from convincing, as it relates to only a handful of screenshots dated in 2023. I have no way of telling what the position would have been as at the relevant date. It appears that several of the websites are from non UK/EU retailers and no indication is given as to how many consumers viewed the websites in question, let alone whether any goods were sold via these platforms and so there is no way of telling the way in which the contested mark is displayed on the applied for goods would have any impact on the consumer's perception of the contested mark. I also do not consider, nor is there

[29] *Shenzhen Tuohong Technology Co., Ltd v Paypal, Inc* O/0437/23

evidence before me, to suggest that at the point of purchase, the goods would be bought by reference to the 'get up' on the soles of the feet. Consequently, neither the evidence, nor the *KEYPAL TM* decision, assist in the case in suit.

92. Given these findings, the ground based on section 5(3) also fails. This is because in absence of a link then none of the heads of damage as claimed can arise. The contested mark is incapable of taking unfair advantage of, or being detrimental to the reputation or distinctive character of the earlier marks.

93. For the avoidance of doubt even if a link were to have been made it would, at best, be fleeting. That connection would be insufficient to alter the economic behaviour of consumers of either parties' goods, and I do not consider that any evidence has been provided sufficient for me to find that the Applicant's goods are likely to be of an inferior quality so as to affect the reputation or distinctive character of the earlier mark.

94. The opposition under section 5(3) of the Act also fails.

Section 5(4)(a)

95. Section 5(4)(a) of the Act states as follows:

> "5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –
>
> a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,
>
> aa)…
>
> b) … A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of "an earlier right" in relation to the trade mark".

96. Subsection (4A) of section 5 of the Act states:

> "(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application."

97. In order for the Opponent to succeed under this ground it must demonstrate goodwill, misrepresentation and damage. Since goodwill is territorial, the Opponent must establish that it had the requisite goodwill with UK consumers as at the prima facie relevant date, namely 23 June 2022. However, where the Applicant has used the mark before the date of the application, it is necessary to consider what the position would have been at the date the behaviour complained about began, and then to assess whether the position would have been any different at the later date when the application was made.[30] It is unnecessary for the Applicant to have generated its own goodwill as at the date the behaviour complained of began,[31] rather it is the first external act about which the other party could have complained (if it knew about it) as an act of actual or threatened passing off.[32]

98. The Applicant filed evidence in the form of the witness statement of Mr Rizzi.

99. I note that following from his statement:

- The Applicant was established in Milan in 2020 providing vegan shoes and accessories.
- The contested mark was developed, launched and used on shoes at the beginning of 2021 although no indication is given as to where.
- Mr Rizzi gives an explanation as to the meaning and ethos behind the name of the brand and why the name was chosen. He produces a brand strategy document confirming the same, produced in 2022.[33]
- Screenshots are produced taken from the Opponent's website www.piumestudio.com which sets out the history of the company and includes a 'current list of stockists' of the Applicant's products worldwide.[34] The screenshots show 3 images of models wearing clothing and shoes but the text accompanying the images is so small that any reference to the mark is illegible. The screenshots are undated save for an access date of 2023 and copyright date of 2023. Within the list of stockists only two references are made to those

[30] *SWORDERS TM* O-212-06
[31] TM *Casablanca,* O/349/16
[32] *Smart Planet Technologies, Inc. v Rajinda Sharm* [BL O/304/20]
[33] Exhibit MR1
[34] Exhibit MR2

based in the UK, but no indication is given as to when they started stocking the contested goods.

- No sales or marketing figures are produced or examples of the promotion of its goods in the UK.

100. Given the limited extent of the evidence filed, I do not consider that the evidence demonstrates use by the Applicant in the UK sufficient to consider an earlier date than that as at the prima facie date. Even if it did, it would not make any material difference in any event given the dates in play. I shall, therefore, consider the claim to passing off as at the prima facie relevant date.

Goodwill

101. Goodwill arises out of trading activities which must be considered in the context of revenue figures, promotional activity and customers in the UK. In light of the evidence filed as outlined earlier and the nature of the goods in question I am satisfied that the Opponent has a strong degree of goodwill in relation to leisure, sport and casual clothing, footwear, headgear and sportsware bags as at the relevant date and that the Opponent's sign is distinctive of that goodwill. Whilst it relies upon 'leather goods' and 'fashion accessories' very little evidence has been filed (or that I have been directed to) specifically identifying goods which come under these broad categories, sufficient for me to find that the Opponent has demonstrated goodwill for these goods.

102. I note that the test for misrepresentation requires a substantial number of members of the public to be deceived and that this test differs to the one undertaken for a likelihood of confusion where it necessitates that the average consumer is confused.[35] However, applying the different legal tests is unlikely to result in a different outcome.

103. As a result of the differences as outlined earlier in my decision despite a strong goodwill, I do not consider that a substantial number of members of the public are likely to be misled into purchasing the Applicant's goods in the belief that they are those of the Opponent.

104. Since, earlier in my decision I found that use of the contested mark on a fair and notional basis would not result in confusion with the Opponent's mark, accordingly

[35] *Marks and Spencer PLC v Interflora* [2012] EWCA (Civ) 1501

even though the Opponent has established goodwill, the necessary misrepresentation required for a claim of passing off to succeed will not occur. On this basis the claim under section 5(4)(a) also fails.

Conclusion

105. Subject to appeal, the opposition under sections 5(2), 5(3) and 5(4)(a) of the Act fail in their entirety on all three grounds and the application may proceed to registration for all of the goods applied for.

Costs

106. As the Applicant has been successful it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. Taking this into account and applying the guidance, I award costs to the Applicant on the following basis:

Considering the notice of opposition and preparing a defence and counterstatement:	£200
Considering the Opponent's evidence and filing evidence:	£600
Drafting submissions in lieu of hearing:	£400
Total	**£1200**

107. I order PUMA SE to pay PLUSME S.R.L. the sum of £1200 as a contribution towards its costs. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated this 19th day of December 2023

Leisa Davies

For the Registrar