

**O/125/18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3185359  
BY MAGNUS INTERNATIONAL LTD.**

**TO REGISTER THE TRADE MARK:**

**MAGNUS**

**IN CLASSES 14, 16, 25, 26 AND 38**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 408720  
BY HI-TEC SPORTS INTERNATIONAL HOLDINGS B.V.**

## **Background and pleadings**

1. On 13 September 2016, Magnus International Ltd. (“the applicant”) applied to register the trade mark **MAGNUS** for a range of goods and services in classes 14, 16, 25, 26 and 38.

2. The application was published for opposition purposes on 9 December 2016. It is opposed by Hi-TEC Sports International Holdings B.V. (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed against the following goods in the application:

Class 25      Clothing; footwear; headgear; swimwear; sportswear; leisurewear.

3. The opponent relies upon the following trade mark registrations:

(i) UK trade mark number 2181516: **MAGNUM**

Filing date 4 November 1998; date of entry in the register 4 July 2008

Class 25: Footwear

(ii) UK trade mark number 2297210: **MAGNUM**

Filing date 5 April 2002; date of entry in the register 11 July 2008

Class 25: Footwear

4. The opponent relies upon all of the goods for which its marks are registered. As the opponent’s marks are identical and nothing turns on the different filing and registration dates, I will, for convenience, refer to them in the singular.

5. Given their dates of filing, the opponent’s marks qualify as earlier marks in accordance with s. 6 of the Act. The opponent states in its Notice of Opposition that it

has used both of its trade marks in relation to all of the goods relied upon. This statement is made because the earlier marks are subject to the proof of use provisions contained in s. 6A of the Act. According to that section, the relevant period in which genuine use must be established is the five-year period ending on the date of publication of the mark applied for. The relevant period is, therefore, 10 December 2011 to 9 December 2016.

6. The opponent claims that there is a likelihood of confusion, including a likelihood of association, because the marks are similar and because the goods are identical or similar.

7. The applicant filed a counterstatement in which it denies the grounds of opposition and puts the opponent to proof of the use of the earlier marks in respect of the goods for which they are registered. It acknowledges “some similarities” between the goods but disputes whether all of the goods at issue are similar. It claims that the marks are “entirely different”. It also characterises as “extremely low” the level of distinctive character of the earlier mark and argues that these factors mean there is no likelihood of confusion.

8. The applicant is not professionally represented; the opponent has been represented throughout by Osborne Clarke LLP. Only the opponent filed evidence. Neither party asked to be heard, although the opponent filed written submissions in lieu of a hearing. I have read all of the papers carefully and will bear both parties’ comments in mind, referring to them, as necessary, below.

## **Evidence**

### **Opponent’s evidence**

9. This consists of the witness statement of Edward van Wezel, who has held the position of CEO of the opponent company since 2011.

10. Mr van Wezel explains that the opponent has used the “MAGNUM” brand in the UK since 1982. Exhibits EVW1 and EVW2 are prints from the opponent’s websites which detail the history of the opponent and the “MAGNUM” brand. The prints are not dated, save for a copyright date in 2016.<sup>1</sup>

11. Mr van Wezel states that the opponent uses its “MAGNUM” trade marks in relation to footwear and apparel. He indicates that the product range includes boots, shoes, insoles and socks, as well as goods such as gloves, bags and waterproof jackets.<sup>2</sup> Exhibit EVW3 comprises five product catalogues, dated 2011 to 2016. The catalogues show a range of boots and shoes, as well as footwear such as trainers, for men and women as well as unisex styles.<sup>3</sup> The vast majority of the items of footwear incorporate protective features, such as steel/composite toecaps, or are certified to European occupational footwear standards. There are, however, a few instances of more general purpose footwear which do not appear to have specific safety features.<sup>4</sup> UK contact details are provided at the end of the catalogues (though the first catalogue also lists contact details for various world regions).<sup>5</sup> The word “MAGNUM”/“Magnum” is used repeatedly, including in the website address [www.magnumboots.com](http://www.magnumboots.com). The mark shown below is also used throughout (in the 2015 and 2016 catalogues, it is on nearly every page):



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<sup>1</sup> p. 35.

<sup>2</sup> §15.

<sup>3</sup> For example, pp. 50-52, 133, 143-149.

<sup>4</sup> See pp. 46, 48, 72, 73, 128.

<sup>5</sup> pp. 62, 75, 90, 111, 151.

12. The mark also appears on the goods themselves, variously on the tongue, sole and heel, in the form below:



13. Mr van Wezel states that the opponent has contracts to supply “MAGNUM” footwear to a range of UK agencies and government bodies, such as the Ministry of Defence, North Wales Police and the Home Office. He indicates that sixteen contracts of this type were entered into during the relevant period. Further details, such as the value of the contracts or the precise goods to which they relate, are not provided.

14. Exhibit EVW4 is said to be the “2013 Magnum Brand document”, the main thrust of which is the promotion of Magnum-branded footwear. The document names as customers bodies such as the UK Border Agency, Royal Mail and the NHS. The word “Magnum”/“MAGNUM” and the mark shown at paragraph 11, above, are visible throughout the document.

15. Exhibit EVW5 consists of prints from the Millets, Amazon, Sports Direct and Screwfix websites showing “Magnum” boots and shoes for sale. The prices are all in sterling. Although the prints are not dated (save for the printing date in July 2017), I note that there are reviews dated within the relevant period,<sup>6</sup> and that the Amazon prints give the dates on which the goods were first available on the site as April 2010, November 2013 and September 2015.<sup>7</sup>

16. Exhibit EVW6 comprises prints from [www.magnumboots.com](http://www.magnumboots.com) showing a range of boots and shoes for sale. Prices are given in sterling but the prints are not dated, save for the printing date in November 2017.

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<sup>6</sup> pp. 173, 184 and 191

<sup>7</sup> pp. 179, 183 and 187, respectively.

17. Exhibit EVW7 consists of prints taken from the wayback machine web archive of [www.magnumboots.com/uk](http://www.magnumboots.com/uk) from January 2012 to April 2015. I note that prices are in sterling. In addition to the website address, “Magnum” is used in word-only form to identify the goods.<sup>8</sup>

18. At exhibit EVW8 is a print from the [magnumboots.com](http://magnumboots.com) website giving a list of stockists. The copyright date is 2017; it is not clear whether the list was current during the relevant period.

19. Exhibit EVW9 includes sixteen copies of advertisements clearly dated between January 2013 and December 2016. The publications are special interest magazines but they are not restricted to one particular sector (for example, there are advertisements from *Soldier* and *Raider* magazines, as well as *RCN Congress* and *Health & Safety International*). Various items of footwear are advertised, some of which bear the mark shown at paragraph 12, above (e.g. pp. 214, 241). From October 2016, some of the advertisements feature the following mark:



20. Mr van Wezel provides approximate annual sales figures of “MAGNUM” products in the UK as follows:<sup>9</sup>

<b>Year</b>	<b>Amount (£)</b>
2011	5,000,000
2012	5,000,000
2013	7,500,000

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<sup>8</sup> pp. 197, 198, 204.

<sup>9</sup> §26.

2014	8,000,000
2015	8,500,000
2016	10,000,000

21. He states that “[all] of these products were sold by reference to the MAGNUM Trade Mark and most bore the MAGNUM Trade Mark”.<sup>10</sup> However, there is no further breakdown of the figures. Mr van Wezel also provides, at exhibit EVW9A, what he describes as “a selection of invoices for MAGNUM Products sold in the UK”. Eight fall within the relevant period. All have delivery addresses in the UK. The mark shown at paragraph 11 is at the top of all of the invoices. A number of the goods are specifically identified by the name “MAGNUM”. The quantities shown in the invoices are very modest: at best, they show sales of 153 pairs of boots/shoes amounting to sales worth approximately £8,600 exc. VAT.

22. Exhibit EVW10 contains prints of the opponent’s Facebook, Twitter, YouTube and Google+ pages. The Twitter and Google+ account show posts in 2016 and 2015, respectively.

23. Details of events which the opponent has attended are provided at EVW11, along with, at EVW12, photographs of the opponent’s stands at various shows. All of the events were in the UK in the relevant period. Boots are plainly visible on the stands, along with the mark shown at paragraph 19, above (though in black and white).

24. Mr van Wezel also provides annual UK advertising spend for “MAGNUM” products, which rose from £250,000 in 2011 to £450,000 in 2016.<sup>11</sup>

25. Details of awards which the opponent has won for footwear are provided, these being two awards for “Best Innovation in Safety Footwear” in 2012 and 2014 and the “Innovation in Footwear” award 2016, all at the UK Professional Clothing Awards.<sup>12</sup>

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<sup>10</sup> §27.

<sup>11</sup> §34.

26. Exhibit EVW16 contains information about the opponent's membership of the British Footwear Association. It does not assist.

27. That concludes my summary of the evidence, insofar as I consider it necessary.

### **Proof of use**

28. The first issue is whether, or to what extent, the opponent has shown genuine use of the earlier mark. The relevant statutory provisions are as follows:

“Raising of relative grounds in opposition proceedings in case of non-use

6A- (1) This section applies where -

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

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (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 period of five years ending with the date of publication.

(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 –

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<sup>12</sup> Exhibits EVW13, 14 and 15.

(a) within the period of five years ending with the date of publication of the application 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 differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, 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) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(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”.

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

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

30. When considering whether genuine use has been shown, I must apply the same factors as if I were determining an application for revocation based on grounds of non-use. What constitutes genuine use has been subject to a number of judgments. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, 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].

(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].

(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].

(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]”.

31. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C., sitting as the Appointed Person, stated that:

“22. The burden lies on the registered proprietor to prove use [...]. However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public”.

32. He added at paragraph 28:

“28. [...] I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious

reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted”.

33. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in

order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use”.

34. The correct approach to assessing the evidence is to view the picture as a whole, including whether individual exhibits corroborate each other.<sup>13</sup>

#### Sufficiency of use

35. It is clear that the opponent produces footwear, for men and women, in various, if specialist, fields. However, much of the evidence shows use not in respect of class 25 but in relation to protective and safety footwear in class 9: almost all of the footwear has occupational or higher standard accreditation and is possessed of features such as reinforced toecaps, fire retardant properties or anti-puncture materials. However, I indicated, above, that there is evidence of a handful of footwear items which are not safety footwear.<sup>14</sup> These include items such as general purpose combat boots, patrol boots and trainers. The features of these goods appear to be enhanced features of ‘normal’ footwear which do not cross over into being protective or safety footwear, in the same way that standard motorcycle boots (in class 25) offer rigidity and a certain level of protection for the feet, as against motorcycle boots with steel toecaps, which are protective footwear in class 9. For example, a pair of trainers are described as having a

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<sup>13</sup> See the comments of Mr Geoffrey Hobbs QC, sitting as the Appointed Person in *Brandconcern BV v Scooters India Limited* (“*Lambretta*”) BL O/065/14.

<sup>14</sup> See EVW3 and paragraph 11, fn 4, above.

“reinforced heel counter & hot melt toe box for extra support” (p. 128). In the context of footwear which is said to be engineered “to compliment [sic] the running gait and minimise pronation”, which has no safety standard attached and where the features are claimed to be for support rather than safety, I take the view that these are goods covered by the opponent’s registration in class 25. The same applies to the other goods I have identified, above, and their attributes.

36. Turning to the level of sales, Mr van Wezel does not state whether the sales figures provided relate only to footwear or, if not, what the breakdown is between footwear and non-footwear goods. More particularly, the absence of any breakdown means there is no way for me to determine with precision the level of sales in relation to the opponent’s footwear goods in class 25, as opposed to class 9. The invoices provided by Mr van Wezel show sales figures which relate to sales in the UK but which are unimpressive, with none of the goods clearly identifiable as footwear in class 25. This documentary evidence contrasts rather sharply with Mr van Wezel’s evidence of the level of sales in the UK (at its lowest, £5m p.a.). Having said that, the invoices are not said to be exhaustive, Mr van Wezel’s evidence is unchallenged and there is evidence of, for example, substantial advertising spend throughout the relevant period, as well as contracts with government bodies and other large organisations such as police forces. Whilst there is no breakdown of the sales, I note that there are several models of non-specialist footwear which appear throughout the relevant period. Taking into account the overall scale of the turnover (£5m to £10m p.a.), it is likely that a not insignificant proportion of sales relates to the relevant goods. I find, albeit with some hesitation, that the level of sales shown is sufficient to constitute genuine use.

#### Form of the mark

37. The mark is used in word-only and figurative form, as shown below:



38. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was) as the Appointed Person summarised the test under s. 46(2) of the Act as follows:

“33. [...] The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter’s distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all”.

39. Although this case was decided before the judgment of the Court of Justice of the European Union (“CJEU”) in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered. The later judgment of the CJEU must also be taken into account where the mark is used as registered, but as part of a composite mark.

40. The figurative forms of the mark include a slightly stylised presentation of the word “MAGNUM”, either surrounded by a border or with the words “ESSENTIAL EQUIPMENT” underneath. These additions or alterations have little or no distinctiveness and do not change the distinctive character of the mark, which remains dominated by the word “MAGNUM”. I find that the use shown is use of the mark as registered, or at least use of the mark in a form which does not alter the distinctive character of the mark as registered, upon which the opponent is entitled to rely, in addition to the word-only use of the mark.

#### Fair specification

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

42. 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”.

43. The parties have made no submissions on this point. The evidence shows use mainly but not exclusively in relation to boots. Other types of footwear, such as trainers, are also shown. The relevant goods shown in the evidence are not restricted to men’s or women’s shoes. I consider that the average consumer is likely to categorise the goods as “footwear” and that the use is such that further subcategorisation would represent an inappropriate stripping of protection from the opponent. A fair specification is “footwear”.

#### **Section 5(2)(b)**

44. The opposition is based upon s. 5(2)(b) of the Act which reads as follows:

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

[...]

(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”.

45. 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. The principles are:

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

### **The average consumer and the nature of the purchasing act**

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

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The

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

47. The applicant has not made any submissions on this point. The opponent submits that the average consumer is “the general consumer within the UK” and that the goods at issue will be purchased “without a high degree of attention or consideration”.<sup>15</sup>

48. The goods at issue are general consumer items, the average consumer of which will be a member of the general public. The goods are not particularly infrequent or expensive purchases but the consumer will be attentive to ensure that the goods are, for example, the desired fit, colour or style. An average degree of attention is, therefore, likely to be paid to the selection of these goods. I acknowledge that the goods might be purchased for work purposes, though I do not consider that that would materially increase the degree of care and attention. The goods at issue are generally sold through bricks and mortar retail premises on the high street and their online equivalents, and they will normally be chosen via self-selection from a shelf or the online equivalent. In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the General Court (“GC”) stated that:

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

49. The same considerations apply to all of the goods at issue. Consequently, while I do not rule out that there may be an aural component (advice may, for example, be sought

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<sup>15</sup> Submissions in lieu, §27.

from a shop assistant), when considered overall, the selection process will be mainly visual.

### **Comparison of goods**

50. When making the comparison, all relevant factors relating to the goods in the specification should be taken into account. In *Canon*, the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

51. 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.

52. In *Gérard Meric v Office for Harmonisation in the Internal Market*, 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 fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

53. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

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

54. The term “footwear” is included in both specifications and these goods are self-evidently identical. “Sportswear” and “leisurewear” include footwear and are identical on the principle outlined in *Meric*. As for “clothing”, “headgear” and “swimwear” in the application, these goods share a similar purpose to the opponent’s “footwear”, all being to cover the body and/or provide protection from the elements. Their nature is unlikely to

overlap to any great extent but they share users and channels of trade. The goods are not in competition but they are complementary. These goods are similar to a low to medium degree.

### **Comparison of trade marks**

55. It is clear from *Sabel* (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 *Bimbo*, 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”.

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

<b>Opponent's mark</b>	<b>Applicant's mark</b>
MAGNUM	MAGNUS

57. The applicant submits in its counterstatement that there is no visual, aural or conceptual similarity between the marks. It claims that the shorter the marks, the more apparent are even small differences. It states that:

“Applying these factors to the case at hand, it must be noted that the marks at hand are relatively short. As this is the case, the relevant consumer will instantly perceive the differing letters “M” and “S” falling at the end of the marks”.

58. As far as aural similarity goes, it claims that:

“the difference in the last syllables, changes the rhythm and reading of the earlier mark entirely.

The emphasis in oral use is likely to be on the last syllable. [...] In the present case, the differences between the ‘NUS’ and ‘NUM’ syllables of the marks are significant. It changes the entire pronunciation and as it is the last syllable it lingers in the mind of the relevant consumer”.

59. The applicant also argues that “MAGNUM” means “a wine bottle of twice the standard size” or “a gun designed to fire cartridges that are more powerful than its calibre would suggest”, whilst “MAGNUS” has no meaning in English.

60. The opponent submits that the relevant consumer “will not instantly perceive the single differing letter falling at the very end of each mark (-S and -M). Accordingly, the marks are visually very similar”.<sup>16</sup> It also claims that the marks are phonetically very similar, as “the fact that the marks only differ in respect of the final letter does not sufficiently change the sound of the syllables. [...] the differing final letter of the marks

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<sup>16</sup> §16

will go unnoticed and, as such, unpronounced”.<sup>17</sup> It does not comment on the conceptual similarity between the marks.

61. The earlier mark consists of the word “MAGNUM” presented in capital letters. There being no other elements in the mark, the overall impression and the distinctiveness of the mark rest in that word. The same applies to the applied-for mark: it consists of the single word “MAGNUS” in capital letters, and the distinctiveness and overall impression of the mark are contained in that word.

62. The marks are both six letters long, the first five of which are identical while the last is different. I note the applicant’s submission that differences are more apparent in short marks. The marks are not long but nor do I consider six-letter words to be especially short. Bearing in mind the similarities and differences, there is a reasonably high degree of visual similarity.

63. Both marks will be pronounced entirely conventionally, as “MAG-NUM” and “MAG-NUS”. Both marks have two syllables, the first of which is identical and the second of which differs in its final consonant. I reject the applicant’s submission that the stress will be on the last syllable. The assertion is made without supporting evidence and does not accord with the *Oxford Dictionary of English’s* pronunciation guide for the words, which puts the stress on the first syllable (“magnəm” and “magnəs”).<sup>18</sup> I consider that the marks are aurally similar to a reasonably high degree.

64. The opponent’s mark means either a large bottle or a type of weapon. I am not persuaded, without evidence, that the latter meaning will be attributed to the mark by the average UK consumer. However, I do consider that the average consumer is likely to know that a “magnum” is a large bottle. The applicant submits that “MAGNUS” has no meaning. I do not agree: I think it likely that the word will be recognised by a not

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<sup>17</sup> §17

<sup>18</sup><http://www.oxfordreference.com/search?source=%2F10.1093%2Facref%2F9780199571123.001.0001%2Facref-9780199571123&q=magnum> and <http://www.oxfordreference.com/search?btog=chap&q0=magnus&source=%2F10.1093%2Facref%2F9780199571123.001.0001%2Facref-9780199571123> [accessed 14 February 2018].

insignificant number of average consumers as a male forename. Nonetheless, I will proceed on the basis that the word “MAGNUS” has no clear concept. As one mark has a clear meaning while the other does not, the marks are conceptually different.

### **Distinctive character of the earlier trade mark**

65. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. In *Lloyd Schuhfabrik*, 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-2779, 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)".

66. Invented words usually have the highest degree of distinctive character, while words which are highly allusive or suggestive of the goods normally have the lowest. Distinctiveness can be enhanced through use of the mark. The opponent has not made an explicit claim of enhanced distinctiveness but it has filed evidence of use. Whilst the overall turnover figures are significant, they do not specify the amount of turnover in relation to the class 25 goods at issue. There is no evidence of the size of the market, nor of the share in it enjoyed by the opponent. On the basis of the evidence filed, I am unable to determine that the earlier mark has an enhanced distinctive character in relation to the goods at issue.

67. Turning to the inherent position, "MAGNUM" is a dictionary word that is neither allusive nor suggestive of the goods at issue. I consider that the earlier mark has an average level of inherent distinctive character.

### **Likelihood of confusion**

68. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]). I must make a global assessment of the competing factors (*Sabel* at [22]), considering them from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind 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 he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

69. The goods are similar to a low to medium degree and will be purchased by predominantly visual means, with the average consumer paying a medium level of attention. The earlier mark has an average degree of inherent distinctive character. The marks are visually and aurally similar to a reasonably high degree. However, the marks are conceptually different. The impact of conceptual differences was considered in *The Picasso Estate v OHIM*, Case C-361/04 P, where the CJEU found that:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law”.

70. However, it is not always the case that conceptual differences will overcome the visual and aural similarities between two marks. In *Nokia Oyj v OHIM*, Case T-460/07, the General Court stated that:

“Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98)”.

71. I indicated at paragraph 64, above, that I would proceed on the basis that “MAGNUM” has a clear meaning, whilst “MAGNUS” has no clear concept attached to it. Therefore, whilst it is not a question of two competing meanings, there is still a conceptual difference. That notwithstanding, and whilst taking into account all of the other factors, such as the reasonably high degree of visual similarity, which carries more weight in a case concerning a visual purchase, my view is that the average consumer will not be confused. The clear meaning of “MAGNUM” will act as a

conceptual hook for the average consumer, so that even when faced with the mark “MAGNUS”, to which no meaning is attached, the consumer will differentiate between the marks and will not be confused. As a result of the conceptual difference between the marks, it is unlikely that one mark will be recalled for the other, thus avoiding imperfect recollection. The applicant’s position would be even stronger if the average consumer did understand the word “MAGNUS” to mean a male forename. I have also considered whether the average consumer purchasing the goods at issue may simply not notice that the marks are different. However, even though the level of care in the purchase will only be of a medium degree, it is sufficient, in my view, that the average consumer will avoid such a mistake. There is no likelihood of confusion.

## **Conclusion**

72. The opposition has failed. Subject to appeal, the application will proceed to registration.

## **Costs**

73. Awards of costs in proceedings commenced after 1 July 2016 are governed by Tribunal Practice Notice (“TPN”) 2 of 2016. The applicant has been successful and would normally be entitled to a contribution towards its costs. However, as the applicant is unrepresented, at the conclusion of the evidence rounds the tribunal wrote to the applicant and invited it to indicate whether it intended to make a request for the award of costs. The applicant was informed that, if so, it should complete a pro-forma, providing details of its actual costs and accurate estimates of the amount of time spent on various activities in the prosecution of the opposition. It was advised that no costs would be awarded if the pro-forma was not completed. The applicant did not file a completed pro-forma. That being the case, I direct that the parties bear their own costs.

**Dated this 23<sup>rd</sup> day of February 2018**

**Heather Harrison  
For the Registrar  
The Comptroller-General**