

O-213-19

TRADE MARKS ACT 1994  
IN THE MATTER OF  
TRADE MARK APPLICATION NO 3253853  
BY ALAN BENNETT  
TO REGISTER

BLACKMARKET  
闇市 やみいち

AS A TRADE MARK  
IN CLASSES 16 & 25  
AND OPPOSITION THERETO (UNDER NO. 411604)  
BY  
BLACK MARKET GROUP LTD

## Background & pleadings

1. Alan Bennett ('the applicant') applied to register the trade mark set out above on 31 August 2017. The mark was published on 10 November 2017 in classes 16 and 25 but only class 25, set out below, forms the basis of this opposition.

*Class 25: T-shirts; Menswear; Ladies' clothing; Long sleeve pullovers; Head wear; Hooded pullovers; Hooded sweatshirts; Hooded tops; Jumpers.*

2. Black Market Group Ltd ('the opponent') opposes the mark under section 5(3) of the Trade Mark Act 1994 ('the Act') on the basis of its earlier UK trade mark, set out below, in which it claims to have a reputation. The earlier mark is registered in classes 9 and 25 but only class 25 forms the basis of this opposition.

UK TM 1432845	Goods relied on:
<b>BLACK MARKET</b>	Clothing; leisurewear; all included in Class 25.
Filing date: 11 June 1990	
Registration date: 11 June 1993	

3. In particular the opponent argues that the applicant's business will benefit from the reputation of the earlier mark and that the use of the applied-for mark would be detrimental to its own business.

4. The applicant filed a counterstatement denying the claim made and requests that the opponent provide proof of use for the goods claimed.

5. In these proceedings both parties represent themselves. The opponent filed evidence and neither party made any written submissions. A hearing was not requested. I make this decision based on the consideration of the material before me.

## Opponent's evidence

6. The opponent submitted a witness statement in the name of Rene Gelston, its founder and managing director and appended 7 exhibits. One notable point from Mr Gelston's witness statement was that the mark was first used in relation to clothing in 1984.

7. Exhibit 1 consists of an image of a sweatshirt and two representations. Of these two representations, one is the applicant's mark and the other is of the letters BLK MKT inside a Japanese style gate device. These images were part of the applicant's TM8 and counterstatement. It is not clear what the relevance of this exhibit is in establishing proof of use of the opponent's earlier mark, or that it has a reputation.

8. Exhibit 2 consists of seven pages of clothing images, two pages containing just graphics and five pages relating to the opponent's organisation of exhibitions.

9. Taking the pages related to the clothing images first, page #4 is a screenshot of a

web page which is headed up using the following mark  and contains images of t-shirts, hoodies, jeans, knitwear and shirts. There is no visible use of the earlier mark on either the knitwear or the shirt. There is a just visible label on the inside waistband of the jeans which contains the same mark as outlined above whereas the hoody and the t-shirts have the following marks emblazoned on the front and back.



The prices are displayed in sterling and there is a copyright date of 2012 at the bottom of the page although it is unclear as to when the screenshot was taken.

10. The pages marked as #5, #6, #7, #8, #10 and #11 of Exhibit 2 consist of single undated images of t-shirts and a hoody featuring variants of the earlier mark.

11. The pages marked #9 and #12 of Exhibit 2 consist of two undated graphic images viz.,



12. The pages marked #13, #14, #15 and #16 of Exhibit 2 consist of publicity material for an exhibition held in 2016 and 2017 in three museums in Mexico. The exhibition was based on the collaboration between the British photographer Brian

Duffy and musician David Bowie. The opponent's marks  and  appear on the publicity material identifying it as one of the parties responsible for organising the exhibition.

13. Finally the page marked #17 consists of an undated publicity poster for an exhibition based on the British punk band The Clash. The exhibition date is stated as 2017 but there are no other details such as location or venue. The opponent's mark appears in the form **Black Market Gallery**.

14. From Exhibit 3, the page marked #19 consists of a screenshot from the opponent's Facebook page for **Black Market Records**. It is unclear on what date it was taken. A photo of the 2016 Duffy/Bowie exhibition poster is visible. The mark

being used on the Facebook page is  set out in white on a black circular background.

15. Also from Exhibit 3, the page marked #20 consists of a screenshot from the opponent's Twitter account for **Black Market Records**. Again it is unclear on what

date it was taken, although the visible tweet is dated July 23 but no year is given.

The mark being used on the Twitter account is  in white on a black circular background.

16. Also from Exhibit 3, the page marked #21 is a screenshot from the opponent's website **blackmarket.co.uk** . Again it is unclear on what date it was taken. The

mark being used on the website is .

17. From Exhibit 3, the page marked #22 is a press release dated 24 July 2018 from a company called 91.Productions. The press release contains details of a TV documentary to be broadcast in 2019 regarding the history of **BLACK MARKET** in the UK dance music scene.

18. Exhibit 4 comprises details of the records released on the Black Market Records label between 1988 and 2017 and photographic images of the awards it has received. The page marked #27 consists of a list of clothing order payments from PayPal dated between November 2017 and June 2018. The payments are in sterling but there are no references to the opponent's mark.

19. Exhibit 5 consists of two images of cars with what appears to be the applicant's mark in the form of decals applied to the windscreens. It is not clear what the relevance of this exhibit is in establishing proof of use of the opponent's earlier mark, or reputation.

20. Exhibit 6 consists of undated images of the opponent's audio headphones. The opponent's mark **Black Market** appears on the packaging and **Black Market London** appears on the earpieces of the headphones themselves.

21. Exhibit 7 is a copy of a WHOIS search which confirms that the opponent owns the domain name **blackmarket.co.uk**.

22. That concludes my summary of the evidence.

## Legislation

23. Section 5(3) states:

“(3) 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.”

24. The relevant case law can be found in the following judgments of the Court of Justice of the European Union (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 law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the

relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

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

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

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

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

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of

the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

## Reputation Threshold

25. 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.”

26. I have considered the opponent's evidence with regard to the above guidance, especially in relation to paragraph 27. Although the declarant stated that the earlier mark was first used on clothing in 1984, the remaining evidence does not contain any of the conditions required to establish that a reputation has been established in clothing goods. For example there is no indication given of the opponent's market

share in the clothing sector neither are there any indications that the customer base for the clothing goods are geographically widespread. Furthermore there are no turnover figures or advertising expenditure in relation to the clothing goods. In this regard, I bear in mind the guidance given in *Rise Construction Management Limited v Barclays Bank* (BL O/635/17), where Professor Philip Johnson sitting as the Appointed Person rejected an appeal against the Hearing Officer's decision that the earlier mark had not been shown to have acquired a reputation for s.5(3) purposes. He said:

"76. Even if the Hearing Officer had considered all the evidence of other successful management projects (Bow Street Magistrates' Court, the UK Pavilion at the Madrid Expo, the Royal Opera House, or Kidzania) and the attendant publicity as well as given some (possibly) very little weight to the awards it would have made no material difference. None of this material addresses the fundamental difficulties faced by the Respondent namely that there was no evidence presented as to market share, no evidence from trade bodies or from people with standing in the industry, and no evidence of the market in which the reputation was claimed.

77. In respect of this final point, at the end of the Hearing, I asked Mr Hollingworth in what market the Respondent claimed reputation. He said the "construction industry" and that his client was known as a project manager in that industry. There was no evidence presented as to the size of the construction industry market (a further problem for Mr Hollingworth identified by the Hearing Officer: see paragraph 56). Nevertheless, I can take notice of the fact that the industry is worth many tens of billions of pounds and employs well over a million people. The Respondent's turnover (which as the Hearing Officer pointed out, does not break down between UK and overseas: paragraph 12) is at most £8million and the number employed nearly 100.

78. While the requirement for a reputation is "not onerous" (see *Enterprise Holdings, Inc v Europcar Group UK Ltd & Anor* [2015] EWHC 17 (Ch) at paragraph 120) and there was possibly more evidence the Hearing Officer should have considered to make her determination, none of the missing

evidence could have materially changed her conclusion that “RISE has positive connotations of moving upwards” (paragraph 56) and that the Respondent did not have the necessary reputation in relation to construction management (paragraph 73). Furthermore, once the relevant market was identified by Mr Hollingworth as the behemoth that is the construction industry, the Hearing Officer’s statement might even appear generous. Accordingly, I dismiss the cross-appeal in relation to section 5(3).”

28. Much like the extract given above referencing the size of the construction industry, the UK clothing market is undoubtedly a multi-million pound industry. The opponent’s evidence does provide some evidence of a social media and online presence for its business, but it is difficult to assess its reach and impact with regard to the clothing goods absent any turnover figures. This is a significant flaw as regards proving a reputation. The other evidence provided focuses on exhibitions outside of the UK and a record label/music business. However these are not services for which the opponent is claiming a reputation as per its notice of opposition. Taking all these factors into account, I do not find that the evidence is at all persuasive as regards proof of reputation and as the opponent has not demonstrated the necessary reputation, the opposition does not clear the first hurdle required under section 5(3).

29. Even if I am found to be wrong in this finding and the opponent had shown, at best, a modest reputation in clothing goods, I still do not think it would be sufficient to the point that an average consumer would make the link between the application and the earlier mark.

30. The opposition fails under section 5(3).

## **Conclusion**

31. The opposition fails in its entirety. The application may proceed to registration.

## **Costs**

32. The applicant has been successful and is therefore, in principle, entitled to a contribution towards its costs. As the applicant is unrepresented, at the conclusion of the evidence rounds the Tribunal invited him, in the official letter dated 12 February 2019, to indicate whether he wished to make a request for an award of costs, and if so, to complete a pro-forma including a breakdown of his actual costs, including providing accurate estimates of the number of hours spent on a range of given activities relating to the defence of the opposition; it was made clear to the applicant that if the pro-forma was not completed then no costs will be awarded. The applicant did not respond to that invitation. Consequently, I make no order as to costs.

**24<sup>th</sup> April 2019**

**June Ralph**

**For the Registrar**

**The Comptroller-General**