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TRADE MARKS ACT 1994

IN THE MATTER OF CONSOLIDATED PROCEEDINGS BETWEEN

PETER HOGAN

AND

MILBRO SPORTS LIMITED

CONCERNING

**PETER HOGAN'S APPLICATION UNDER NO 500 460
TO REVOKE REGISTRATION NO 708 886
IN THE NAME OF MILBRO SPORTS LIMITED**

**PETER HOGAN'S APPLICATION UNDER NO 500 461
TO REVOKE REGISTRATION NO 865 266
IN THE NAME OF MILBRO SPORTS LIMITED**

**PETER HOGAN'S APPLICATION UNDER NO 500 462
TO REVOKE REGISTRATION NO 877 721
IN THE NAME OF MILBRO SPORTS LIMITED**

**AND MILBRO SPORTS LIMITED'S APPLICATION UNDER NO 500 440
TO INVALIDATE REGISTRATION NO 2 544 283
IN THE NAME OF PETER HOGAN**

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Background and Pleadings

1. This decision concerns four sets of proceedings as follows:
 - a) An application under No 500 460 by Peter Hogan (PH) to revoke registration No 708 886 in the name of Milbro Sports Limited (MSL). The registration is for the mark MILBRO which was entered into the register on 14 July 1952 and is registered for *all goods in Class 13*. The application seeks revocation on grounds under Section 46(1)(b) of the Trade Marks Act 1994 (The Act) alleging that the mark has not been used in relation to Class 13 goods within the periods 20 May 1985 to 19 May 1990; 21 May 1990 to 20 May 1995; 22 May 1995 to 21 May 2000; 23 May 2000 to 22 May 2005; 24 May 2005 – 23 May 2010 and 23 June 2009 to 22 June 2014. Revocation is sought from 20 May 1990; 21 May 1995; 22 May 2000; 23 May 2005; 24 May 2010; 23 June 2014 respectively.

MSL filed a counterstatement in which it claimed it had made genuine use of the mark in respect of the following goods:

Air guns; air pistols; air gun pellets; pellets (ammunition); air gun darts; air pistol slugs; ammunition bags and tins; rifle slings, sheaths and moderators; air gun moderators; cleaning implements for air guns; sporting guns; air pistol slugs; slingshots; catapults (weapons-); bags adapted for guns; bullet and pellet moulds; mirrors (sighting-) for guns; non-optical and non-telescopic sights; rifle stocks; rifle straps; rifle and air gun covers; air gun slings; air gun silencers; pellet/ammunition pouches, tins or bags (specially adapted-).

- b) An application under No 500 461 by PH to revoke registration No 865 266 in the name of MSL. The registration is for MILBRO, which was entered into the register on 5 June 1964 and is registered in respect of the following goods: *Fishing tackle (other than nets); and bait and gut, all for fishing* in Class 28.

The application seeks revocation on grounds under Section 46(1)(b) of the Act alleging that the mark has not been used on any of the goods for which it is registered within the periods 8 July 1985 to 7 July 1990; 9 July 1990 to 8 July 1995; 10 July 1995 to 9 July 2000; 11 July 2000 to 10 July 2005; 12 July 2005 to 11 July 2010 and 23 June 2009 to 22 June 2014. Revocation is sought from 8 July 1990; 9 July 1995; 10 July 2000; 11 July 2005; 12 July 2010 and 23 June 2014 respectively.

MSL filed a counterstatement claiming genuine use of the mark in respect of the following goods in Class 28: *bait pellets for fishing; fishing tackle, namely catapults, catapults for spraying bait and bait boxes.*

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- c) An application under No 500 462 by PH to revoke registration No 877 721



in the name of MSL. The registration is for the mark  which was entered into the register on 2 April 1965 and is registered for *fishing tackle (other than nets); and bait and gut, all for fishing* in Class 28.

The application seeks revocation on grounds under Section 46(1)(b) of the Act alleging that the mark has not been used on any of the goods for which it is registered within the periods 8 July 1985 to 7 July 1990; 9 July 1990 to 8 July 1995; 10 July 1995 to 9 July 2000; 11 July 2000 to 10 July 2005; 12 July 2005 to 11 July 2010 and 23 June 2009 to 22 June 2014. Revocation is sought from 8 July 1990; 9 July 1995; 10 July 2000; 11 July 2005; 12 July 2010 and 23 June 2014.

MSL filed a counterstatement in which it claimed it had made genuine use of the mark in respect of the following goods in Class 28: *bait pellets for fishing; fishing tackle, namely catapults, catapults for spraying bait, bait boxes, fly hooks and specimen hooks.*

- d) An application under No 500 440 by MSL to invalidate registration No 2 544 283 in the name of PH. The registration is for the mark MILBRO which was entered into the register on 13 August 2010 and is registered in respect of *catapult bait pouches sporting articles* in Class 28. The application for invalidation is founded upon grounds under sections 5(1), 5(2)(a), 5(3) and 5(4)(a) relying on MSL's earlier trade marks numbers 865 266 and 708 886 MILBRO and in respect of 5(4)(a) based upon use of the sign MILBRO in respect of goods in Classes 13 and 28 since 17 April 1997.

PH filed a counterstatement denying the grounds of invalidation and requesting that MSL prove use of its earlier trade marks relied upon in relation to *slingshots; catapults (weapons-)* after 1982 (earlier trade mark 708 886) and *fishing tackle (other than nets); bait and guts, all for fishing* after April 1997.

2. All proceedings were consolidated. Both parties filed evidence, the relevant parts of which are summarised below. No Hearing was requested though submissions were filed in lieu. These have not been summarised but have been fully taken into account when reaching this decision. This decision is taken following a careful perusal of the papers.
3. The parties have, during the evidence rounds (and for reasons known only to them), discussed the jurisdiction of these proceedings. The dispute is in respect of trade marks registered in the United Kingdom. As such, the United Kingdom is the correct jurisdiction.

Evidence filed

4. Evidence has been filed by both parties in these proceedings. This is detailed, complex and includes information and accusations (and indeed cross accusations) not relevant to the issues in hand here. As such, not all of the evidence filed will be summarised, though the contents have been duly noted.
5. MSL's evidence in chief includes a witness statement from Mr Ross Marshall, the General Manager at MSL, a position held since 2008. This describes the use made of MSL's trade marks. He explains that MSL manufactures and sells pellets used as ammunition for air guns, slingshots, catapult or other similar target practice equipment and which are, according to Mr Marshall, also sold and used in the fishing trade. MSL also manufacture and/or sell air guns and accessories relating to air guns such as moderators, darts, cleaning kits, rifle and rod socks, rod/rifle cleaning cloths, target cards, bait boxed (fishing tackle) and fly hooks. The following exhibits are relevant:
 - Exhibit RM1 is a selection of invoices showing a sample of sales for the goods sold under the name MILBRO between 2005 and 2014, together with sample packaging. The sample packaging is in respect of fishing tackle, namely fishing hooks which clearly displays registered trade mark No 877 721; the invoices provided include sales in respect of pellets for ammunition, moderators, sights, darts and rifle shrouds under the MILBRO trade mark and for the sale of MILBRO badged accessories such as fly hooks and specimen hooks, tins and bait boxes.
 - Exhibit RM2 are extracts from the MSL website (and other websites which sell goods bearing the contested marks). It is noted that this exhibit is mainly in respect of rifles and accessories though catapults are also displayed. The information appears to be dated in 2014.
 - Exhibit RM3 is examples of advertisements of MILBRO products placed in specialist magazines such as Shooting Sports, Tackle and Guns, Gun Mart. These are in respect of rifles and related accessories. They are undated with the exception of one dated 2009.
 - Exhibit RM4 is evidence of MSL's presence at Shooting Shows in 2010 and 2014.
6. There are also two witness statements from Eleanor Coates, a Trade Mark Attorney representing MSL (one being evidence in reply). Much of these statements describe previous communications between the parties and submissions. These will not be summarised here but the contents have been noted.

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7. PH's evidence includes several witness statements. One from PH himself describes how he came to produce catapults, having first noticed an interest in vintage catapults being sold under the name MILBRO. He therefore commenced work on reproduction catapults. Much of the remainder of this statement describes the goodwill that PH claims to have acquired in respect of these catapults and the channels through which he has sold them such as via the website Ebay. Further, there is mention of demonstration videos being uploaded to YouTube along with other video sequences being filmed by hobbyists such as sequences showing PH's stands at relevant national events. Finally, many of the pre action interactions between the parties are described.
8. Another witness statement is from a catapult hobbyist John Webb. He explains that he has known about PH and his catapults since 2011. He also corroborates PH's assertion regarding the filing of video sequences and presence of stands at relevant national events.
9. The final witness statement for PH is from Stephane Dominique Fernand Ambrosini, a Patent and Trade Mark Attorney representing PH who describes the previous communications to the parties. The remainder of this statement contains submissions regarding goodwill and genuine use which will not be summarised here, but which have been taken into account when reaching this decision.

Revocation Decision

10. Section 46(1) of the Act states that:

"The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

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

(c).....
.....

(d).....
.....

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(2) For the purpose of subsection (1) 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 use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made: Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation may be made by any person, and may be made to the registrar or to the court, except that –

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

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

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

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

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

11. Section 100 is also relevant, which reads:

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

12. In *Stichting BDO v BDO Unibank, Inc.*, [2013] EWHC 418 (Ch), Arnold J. stated as follows:

“51. Genuine use. In *Pasticceria e Confetteria Sant Ambroeo SRL v G & D Restaurant Associates Ltd* (SANT AMBROEUS Trade Mark)

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[2010] R.P.C. 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV* (C-40/01) [2003] E.C.R. I-2439; [2003] R.P.C. 40 ; *La Mer Technology Inc v Laboratoires Goemar SA* (C-259/02) [2004] E.C.R. I-1159; [2004] F.S.R. 38 and *Silberquelle GmbH v Maselli-Strickmode GmbH* (C-495/07) [2009] E.C.R. I-2759; [2009] E.T.M.R. 28 (to which I have added references to *Sunrider v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) (C-416/04 P) [2006] E.C.R. I-4237):

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

(2) The use must be more than merely token, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(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, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider* [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] -[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a

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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: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]”.

13. Although minimal use may qualify as genuine use, the CJEU stated in Case C-141/13 P, *Reber Holding GmbH & Co. KG v OHIM* (in paragraph 32 of its judgment), that “*not every proven commercial use may automatically be deemed to constitute genuine use of the trade mark in question*”. The factors identified in point (5) above must therefore be applied in order to assess whether minimal use of the mark qualifies as genuine use.
14. In respect of the evidence filed by MSL it is noted that MILBRO is sometimes used in an alternative form. In this respect the following guidance is useful: 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."
15. See also *Remus Trade Mark* – BL O/061/08 (Appointed Person) & *OAO Alfa-Bank v Alpha Bank A.E.* - 2011 EWHC 2021 (Ch) and *Orient Express Trade Mark* - BL O/299/08 (Appointed Person).
16. Although these cases were 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, they remain 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.
17. Although there is clearly use of MILBRO (word only), there is also use of a stylised version with MILBRO appearing in blue block writing together with

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a bullet/pellet device in respect of the Class 13 goods as shown:



It is considered that MILBRO is the outstanding distinctive part of this form and retains its distinctive character because the differences are cosmetic and/or include non distinctive matter. MSL are therefore also able to rely on this stylised use shown.

18. In considering the evidence filed, I find that it clearly shows use of MILBRO in respect of a variety of goods proper to Class 13 including air guns and related accessories such as moderators, darts, pellets, socks, cleaning cloths. Genuine use is clearly established in this regard.
19. The matter is less clear in respect of goods in Class 28 for which there are invoices with a spread of dates from 2005-2011 in respect of products such as hooks and bait boxes. There is also an example of packaging in respect of hooks. This displays the name MILBRO and also the stylised trade mark No 877 721. The use is small but consistent over the period and use of the mark need not be quantitatively significant for it to be deemed genuine. Minimal use can qualify as genuine. Further, the use requirement in trade mark proceedings is not designed to assess commercial success or to restrict protection only to those marks which have been used on a large scale commercially. It is true that not all commercial use is deemed to be genuine use. However, taking into account all of the evidence filed, considered in totality, it is considered that it does show that there has, on balance, been genuine use of MSL's trade marks in the UK in respect of some Class 28 goods.
20. However, the evidence filed by MSL does not show genuine use of the trade mark in connection with all the goods covered by the earlier trade marks. As such, one must arrive at a fair specification that reflects the use made. In this regard, the following guidance is helpful:
 - a) In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”
 - b) In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. (with whom Underhill L.J. agreed) set out the correct approach for devising a fair specification where the mark has not been used for all the goods/services for which it is registered. He said:

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“63. The task of the court is to arrive, in the end, at a fair specification and this in turn involves ascertaining how the average consumer would describe the goods or services in relation to which the mark has been used, and considering the purpose and intended use of those goods or services. This I understand to be the approach adopted by this court in the earlier cases of *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2002] EWCA Civ 1828, [2003] RPC 32; and in *West v Fuller Smith & Turner plc* [2003] EWCA Civ 48, [2003] FSR 44. To my mind a very helpful exposition was provided by Jacob J (as he then was) in *ANIMAL Trade Mark* [2003] EWHC 1589 (Ch); [2004] FSR 19. He said at paragraph [20]:

“... I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. ... Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods – are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

64. Importantly, Jacob J there explained and I would respectfully agree that the court must form a value judgment as to the appropriate specification having regard to the use which has been made. But I would add that, in doing so, regard must also be had to the guidance given by the General Court in the later cases to which I have referred. Accordingly I believe the approach to be adopted is, in essence, a relatively simple one. The court must identify the goods or services in relation to which the mark has been used in the relevant period and consider how the average consumer would fairly describe them. In carrying out that exercise the court must have regard to the categories of goods or services for which the mark is registered and the extent to which those categories are described in general terms. If those categories are described in terms which are sufficiently broad so as to allow the identification within them of various sub-categories which are capable of being viewed independently then proof of use in relation to only one or more of those sub-categories will not constitute use of the mark in relation to all the other sub-categories.

65. It follows that 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 belong to the same group or category as those for

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which the mark has been used and which are not in substance different from them. But conversely, if the average consumer would consider that the goods or services for which the mark has been used form a series of coherent categories or sub-categories then the registration must be limited accordingly. In my judgment it also follows that a proprietor cannot derive any real assistance from the, at times, broad terminology of the Nice Classification or from the fact that he may have secured a registration for a wide range of goods or services which are described in general terms. To the contrary, the purpose of the provision is to ensure that protection is only afforded to marks which have actually been used or, put another way, that marks are actually used for the goods or services for which they are registered.”

21. In respect of Class 13, it is noted that the original specification was in respect of all goods in the class. This is due to historical reasons when such expressions were acceptable upon application for a trade mark. In respect of the use shown, a fair specification is considered to be: *air guns and air gun accessories, namely moderators, darts, pellets, socks.*
22. It is noted that there is also use shown on cleaning cloths. These are for guns, but would be proper to either class 03 or 21 (dependant on whether the cloth is impregnated with a cleaning substance). In any case, MSL’s registrations do not cover these classes and so this use shown is of no consequence.
23. In respect of Class 28, the use on fishing products is small but has been found to be genuine. Fishing tackle is considered to be a fairly broad term within which a number of sub categories can be considered such as fishing rods, bait etc. It would be unfair for the term fishing tackle at large to remain as the use shown has been in respect of only a few specific items. A fair specification is considered to be *fishing tackle, namely hooks; bait boxes* in respect of 865 266 MILBRO. In respect of 877 721



the use found was solely in respect of fishing hooks and so the specification will be limited to *fishing tackle, namely hooks.*

24. It is noted that much has been argued regarding use on catapults by MSL and there is the odd piece of evidence in support. This issue will be set aside for the moment and returned to if necessary later in the decision.
25. The sum of all this is that the earlier trade marks upon which the cancellation action against No 2 544 283 is based, survive and so remain registered in respect of:

865 266 MILBRO for *Fishing tackle, namely hooks; bait boxes.*

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708 886 MILBRO for *Air guns and air gun accessories, namely moderators, darts, pellets, socks, cleaning cloths.*



In addition, trade mark No 877 721 remains registered in respect of *fishing tackle, namely hooks.*

26. Having decided as described, attention is now directed towards the invalidation action against PH's trade mark.

Invalidation Decision

27. As already outlined above, this is based upon several grounds. The first to be considered will be Section 5(2)(a) with the remaining grounds to be assessed if necessary later in the decision. Section 5(2)(a) states as follows:

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

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

Identity of marks

28. The marks are, self evidently, identical.

Comparison of goods

29. In the judgment of the CJEU in *Canon*, Case C-39/97, 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”.

30. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

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- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) 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;
- e) 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.

The earlier goods are:

Class 13:

Air guns and air gun accessories, namely moderators, darts, pellets, socks, cleaning cloths.

Class 28:

Fishing tackle, namely hooks; bait boxes.

The challenged goods are:

Class 28:

Catapult bait pouches sporting articles.

- 31. It is noted that punctuation is missing in the later goods. However, it is considered appropriate to interpret the specification to read: catapult; bait pouches; sporting articles.
- 32. The earlier class 13 goods are weapons and related accessories. In particular, the air guns can be used in sports such as hunting and other shooting sports, where proficiency such as speed and accuracy are measured. The later goods are catapults. These can also be used for leisure and accuracy and speed assessed. There is therefore a similarity as regards purpose here. Channels of trade may also coincide as it is considered to be entirely feasible for a shop selling guns to also sell catapults. They are considered to be similar to a moderate degree.

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33. In respect of sporting articles, the term has not been fully qualified and so is broad. It can include the aforementioned catapults and so is at least similar to this extent to the earlier term. It can of course also include items which are not similar. However, PH has offered a fall back specification whereby the term is qualified as being *sporting articles, namely catapults for hobby use*. This does not help PH. Indeed the analysis from the previous paragraph can also be applied here as regards purpose and channels of trade. They are moderately similar.
34. The later *bait pouches* are clearly highly similar to the earlier *bait boxes* as each is containers for fishing bait. Further, the later term is similar to the earlier *hooks* as they are both fishing equipment and so the end user will coincide as will the channels of trade as both are for use in the same pastime activity.
35. PH's fall back position has already been mentioned. This does not help its case in any way as it reads: *Catapults; sporting articles namely catapults for hobby use*. It does not distinguish its goods from those of MSL. If anything, the additional clarification only serves to bring the respective goods closer together.

The level of attention paid by the average consumer

36. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.
37. 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.”
38. The relevant consumer is likely to be comprised of the public at large, those with the requisite licences to fish/shoot and the professional

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sportsperson. They would generally be sold in specialist shops or on specialist websites. The goods in question range in price from relatively cheap (hooks) to relatively expensive (air guns) and irrespective of price will likely be a fairly considered purchase as acquiring the correct equipment will be important. The level of attention expected to be displayed is considered to be at least medium.

The distinctiveness of the earlier mark

39. MILBRO is meaningless and has the look and feel of an invented word. It therefore prima facie, has a high degree of distinctive character. MSL have claimed that its trade marks have a reputation. However, although the evidence provided demonstrates genuine use, there is no evidence illustrating the scale of use or market share and so is considered insufficient to demonstrate reputation. Nothing turns on the point however as MILBRO is inherently a trade mark with a high degree of distinctive character.

Likelihood of confusion

40. 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

(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;

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(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 the earlier mark to mind, is not sufficient;

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

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

41. In these proceedings, the respective marks are identical and the goods have been found to be similar, some moderately so, some highly so. Further, the earlier trade marks have a high degree of distinctive

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character. It is considered that confusion is not only likely, it is inevitable. The invalidation action succeeds in its entirety.

42. As MSL has been successful under Section 5(2)(a) of the Act, there is no need to consider the remaining grounds of invalidation which are considered to not materially advance MSL's case.

43. The sum of all this is as follows:

MSL has only provided use in respect of a limited range of goods as already outlined. In respect of those for which no use has been shown, the registrations will be revoked with effect from the earliest dates from which the Applicant sought revocation. This is 20 May 1990 in respect of trade mark No 708 886 and 8 July 1990 in respect of trade mark numbers 865 266 and 877 721.

MSL's marks remain registered according to the following terms:

865 266 MILBRO in Class 28 for:

Fishing tackle, namely hooks; bait boxes.

708 886 MILBRO in Class 13:

Air guns and air gun accessories, namely moderators, darts, pellets, socks, cleaning cloths.



In addition, trade mark No 877 721  remains registered in Class 28 for:

Fishing tackle, namely hooks.

MSL's invalidation action against PH's trade mark registration succeeds entirely.

Final Remarks

44. It has been noted that there has been some suggestion by PH that MSL have acquiesced as regards its invalidation action. Section 48 of the Trade Marks Act 1994 states as follows:

“48 Effect of acquiescence

(1) Where the proprietor of an earlier trade mark or other earlier right has acquiesced for a continuous period of five years in the use of a registered trade mark in the United Kingdom, being aware of that use, there shall cease to be any entitlement on the basis of that earlier trade mark or other right –

- (a) to apply for a declaration that the registration of the later trade mark is invalid, or
- (b) to oppose the use of the later trade mark in relation to the goods or services in relation to which it has been so used, unless the registration of the later mark was applied for in bad faith.

(2) Where subsection (1) applies, the proprietor of the later trade mark is not entitled to oppose the use of the earlier trade mark or, as the case may be, the exploitation of the earlier right, notwithstanding that the earlier trade mark or right may no longer be invoked against his later trade mark.”

45. According to his own evidence, PH began to show an interest in producing catapults in February 2010 and applied to register MILBRO in April of the same year. MSL filed to invalidate PH’s trade mark in May 2014. Clearly a five year period required by Section 48 of the Act had not elapsed. PH suggests that MSL should have filed to oppose its trade mark (and indicated that it intended to do so). However that it did not pursue this course of action is a matter for them. In any case, they have not been shown to have acquiesced and so this matter is set aside.

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COSTS

46. It is true that each of the parties has achieved a measure of success in these proceedings. However, it is considered that MSL have been proportionately more successful than PH as its challenged registrations have partially survived and it has been wholly successful in its invalidation action. In the circumstances I award MSL the sum of £1000 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Invalidation fee - £200

Preparing statements of case – £300

Considering other side's evidence and filing evidence - £500

TOTAL: £1000

47. I therefore order Peter Hogan to pay Milbro Sports Limited the sum of £1000. The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 9th day of July 2015

Louise White

**For the Registrar,
The Comptroller-General**