O/336/21

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS INVOLVING

TRADE MARK APPLICATION
NOs. 3434329 & 3465105 BY

ABOGEAR LIMITED

TO REGISTER:

Wool Kicks

AS A TRADE MARK IN CLASSES 18, 25 & 28

AND

Woolkicks

AS A TRADE MARK IN CLASS 25

AND

TWO OPPOSITIONS THERETO
UNDER NOs. 419849 AND 419850
BY
KICKERS INTERNATIONAL B.V.

BACKGROUND AND PLEADINGS

1. These consolidated proceedings concern, two applications by Abogear Limited ("the applicant") to register:

    a) the words "**Wool Kicks**", with application number 3434329 ('329), in the UK on 07 October 2019. It was accepted and published in the Trade Marks Journal on 20 December 2019 in respect of the following goods:

        Class 18: Leather; imitation leather; beach bags; shoulder bags; rucksacks; backpacks; travelling bags [leatherware]; waterproof bags; shopping bags; luggage; leather credit card wallets; wallets; purses.

        Class 25: Footwear; sneakers [footwear]; athletics footwear; pumps [footwear]; beach footwear; leisure footwear; flip-flops; wellington boots; surfwear; wet suits; snow boots; snowboard boots; snow boarding suits; boardshorts; shorts; t-shirts; shirts; hooded tops; hooded sweatshirts; jeans.

        Class 28: Surfboards; bags adapted to carry surfboards; surf skis; surfboard fins; surfboard covers; bodyboards; bodyboard covers (shaped -); leashes for bodyboards; paddleboards; stand-up paddle boards; hand paddles; skateboards; bags for skateboards; shock absorption pads for protection against injury [sporting articles]; arm pads adapted for use in sporting activities.

    b) and the word "**Woolkicks**", with application number 3465105 ('105), in the UK on 07 February 2020. It was accepted and published in the Trade Marks Journal on 14 February 2020 in respect of the following goods:

Class 25: Footwear; sneakers [footwear]; athletics footwear; pumps [footwear]; beach footwear; inner soles; boots; leisure footwear; flip-flops; slippers; wellington boots; surfwear; wet suits; snow boots; snowboard boots; snow boarding suits; boardshorts; shorts; t-shirts; shirts; hooded tops; hooded sweatshirts; jeans; headgear; caps; tee-shirts; socks; sweaters; ski gloves; scarves; underpants; underwear; coats; belts.

2. Kickers International B.V. ("the opponent") opposes the applications on the basis of Section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The oppositions concern the following applicant's goods in Class 25:

Re Application '329:

Footwear; sneakers [footwear]; athletics footwear; pumps [footwear]; beach footwear; leisure footwear; flip-flops; wellington boots; snow boots; snowboard boots.

Re Application '105:

Footwear; sneakers [footwear]; athletics footwear; pumps [footwear]; beach footwear; inner soles; boots; leisure footwear; flip-flops; slippers; wellington boots; snow boots; snowboard boots; socks.

3. The opponent is the proprietor of the following UK registrations:

Trade Mark no.	1079862 (‘862)
Trade Mark	KICKS
Goods Relied Upon	Articles of outerclothing. CANCELLED IN RESPECT OF: all goods except footwear.
Relevant Dates	Filing date: 17 June 1977 Date of publication: 18 May 1983

Trade Mark no.	1114414 (‘414)
Trade Mark	
Goods Relied Upon	Articles of outerclothing. CANCELLED IN RESPECT OF: all goods except footwear.
Relevant Dates	Filing date: 16 May 1979 Date of publication: 08 June 1983

4. Given the similarity in the issues involved, the Tribunal directed under Rule 62(1)(g) of the Trade Mark Rules 2008 that the two oppositions be consolidated.

5. The opponent argues that the respective marks are highly similar and the respective goods in Class 25 are identical or similar. Therefore, registration of the contested marks should be refused under Section 5(2)(b) of the Act.

6. In response, the applicant filed counterstatements, denying all the grounds and putting the opponent to proof of use of its marks for all the goods relied upon.

7. Only the opponent filed evidence and written submissions in these proceedings, which will be summarised to the extent that I consider necessary. Neither side filed written submissions in lieu of a hearing nor requested a hearing. Thus, this decision has been taken following a careful consideration of the papers.

8. In these proceedings, the opponent is represented by Addleshaw Goddard LLP and the applicant is represented by Taylor Wessing LLP.

9. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

Relevant Dates/Periods

10. An "earlier trade mark" is defined in Section 6(1) of the Act:

> "(1) In this Act an "earlier trade mark" means –
>
> (a) a registered trade mark, international trade mark (UK) or European Union trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,
>
> […]
>
> (2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered. […]"

11. As the earlier marks relied upon had been registered for more than five years on the date on which the contested applications were filed, Section 6A of the Act applies, which states:

> "(1) This Section applies where–

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

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

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

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

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

(3) The use conditions are met if–

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

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

(4) For these purposes–

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

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

(5) In relation to a European Union 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 Union.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(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."

12. In accordance with Section 6(1) of the Act, the opponent's trade marks clearly qualify as earlier marks. There are two relevant periods for proof of use of the opponent's marks: i) from 08 October 2014 to 07 October 2019, for the opposition against 3434329; and ii) from 08 February 2015 to 07 February 2020 for the opposition against 3465105. Although there is a large degree of overlap between the relevant periods, I will, of course, keep in mind the individual periods in the assessment I come to make. The relevant dates for assessing the likelihood of confusion as per Section 5(2)(b) are the dates on which each of the contested applications were filed, namely 07 October 2019 and 07 February 2020.

EVIDENCE

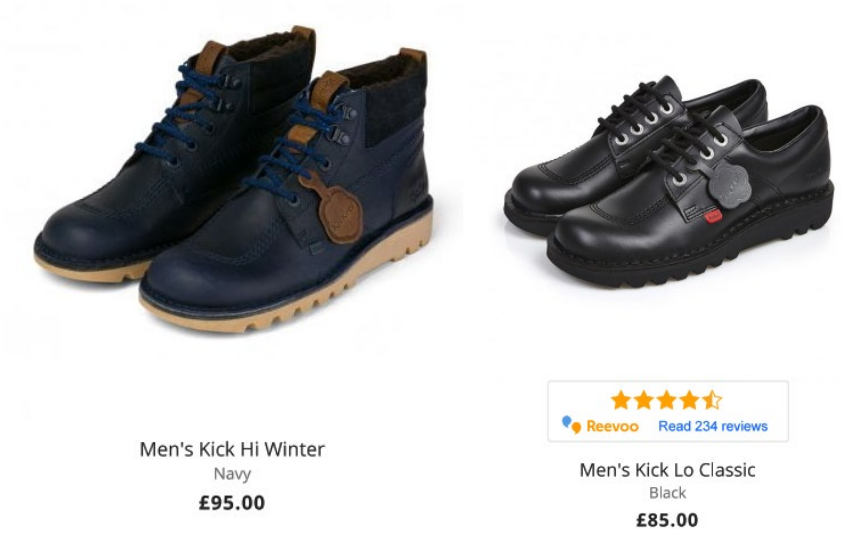
Opponent's Evidence

13. The opponent filed a witness statement, dated 20 October 2020, of Mr Jacques Louis Armand Royer, one of the directors of Kickers International B.V., confirming that he has held this position since 1 February 2007. Mr Royer describes that:

> "2. The Opponent is a well-known provider and manufacturer of footwear, among other products. In 1975 it launches [sic] the first UK store. Kickers and its authorised licensees have been using, in the UK, its Kick and Kicks marks on their own, or by adding insignificant variations, since 1975. […]
>
> 3. Kickers owns the domain name www.kickers.co.uk, which was registered on 3 June 1997. This domain name has been live since the aforementioned date, making the Opponent's products, including footwear goods offered under the Kick, or insignificant variations of the Kick mark, available for sale across the United Kingdom."

14. With Exhibit JLAR1, Mr Royer provides prints, dated 15 October 2020, from the *kickers.co.uk* website describing the history of the company, including a timeline of key events.

15. Further, Mr Royer's Exhibit JLAR2 consists of prints, dated 16 October 2020, from the *whois.net* website providing details for the domain name *kickers.co.uk*. With the same Exhibit, prints from a variety of "MEN'S KICK" footwear, including "KICK LO", "KICK LO CLASIC", "KICK HI", "KICK HI CLASIC", "KICK HI WINTER", and "KICK ROVER", are provided. These signs appear, as reproduced below, in the caption underneath the pictures of the relevant products. Also, the depicted shoes bear a leather tag attached to the shoelaces with the word "KICKERS" encased within a fleurette shape.



16. Mr Royer explains that:

> "4. The Kick and Kicks marks, are used as word marks on their own or by adding insignificant variation to them such as the syllables "lo", "hi", "T-bar", among others. Words or elements that are insignificant because they describe characteristics of the shoes, for example "lo" is an abbreviation of "low" and refers to "low cut style boots", "hi" is an abbreviation of high and refers to "high cut style boots", and "T-bar", a "T-bar" shoes is a closed, low-cut shoe with two or more straps forming one or more T shapes."

17. In this regard, Mr Royer provides the supporting Exhibit JLAR3 that consists of prints, dated 16 October 2020, from the *wikipedia.org* website, according to which:

> "A T-bar sandal or T-bar shoe (also known in the United Kingdom as "school sandal" or "closed-toe sandal") is a closed, low-cut shoe with two or more straps forming one or more T shapes (one or more straps across the instep passing through a perpendicular, central strap that extends from the vamp)."

18. Mr Royer's Exhibit JLAR4 consists of several prints from various websites selling the opponent's goods which are said to illustrate the use of the marks in the UK. These are as follows:

    a) Prints, dated 14 October 2020, from *footasylum.com, lookagain.co.uk, jdsports.co.uk, office.co.uk, very.co.uk, johnlewis.com,* and *housefraser.co.uk* websites demonstrating a selection of shoes in relation to:

        i. men's footwear: "KICKERS KICK HI BOOT", "KICKERS KICK HI CLASSIC BOOTS", "KICKERS KICK HI BOOTS", "KICKERS KICK WALL", "KICKERS KICK LOW";

        ii. kids footwear: "KICKERS JUNIOR KICK", "KICKERS KICK HI JUNIOR", "KICKERS KICK HI CHILDREN", "JUNIOR KICK HIGH CORE BOOT", "KICK LO STROLL", "KICKERS CHILDREN'S KICK T-BAR";

        iii. infant footwear: "INFANT KICK LOW", "KICK T BAR INFANT"; and

        iv. girls footwear: "KICK PATENT T-BAR".

        Together with the pictures and order information of the products above, customer reviews are also provided. More specifically, there are 4 reviews from 2015, 2 reviews from 2014, 4 reviews from 2019, and 27 reviews from 2018.

    b) Prints, dated 14 October 2020, from the *reevoo.com* website demonstrating customer reviews in relation to "KICK STYLY INFANT (BLACK)". The product scores 8.2/10, and there are 3 customer reviews from 2015 and 1 from 2016.

    c) Prints, taken from the WayBack Machine internet archive and dated between 04 October 2014 and 30 December 2019, from the

kickers.co.uk website demonstrating the following products: “KICK SO HI YOUTH”, “MEN’S KICK HI”, “KICK HI YOUTH”, “WOMEN’S KICK HI”, “KICK PIRAHI INFANT”, “KICK HI INFANT”, “KICK HI JUNIOR”, “KICK HI SPACE INFANT”, “WOMEN'S KICK KULE - THE ESPANA EDIT”, “WOMEN'S KICK LO PATENT”, “CLASSIC KICK HI BABY”, “MEN’S KICK LOSUMA”, “KICK T YOUTH”, “KICK LO CLASSIC TEEN”, “KICK T-BAR CLASSIC TEEN”, “KICK HI CLASSIC TEEN”, “KICK HI CLASSIC JUNIOR”. Also, the prints illustrate, as seen below, banner ads that contain footwear with the headings “NEW KICKS” and “CUSTOMISE YOUR KICKS”.

19. Further prints of the opponent’s goods are provided with Exhibit JLAR5. These are said to demonstrate examples of use of the marks on the Amazon UK website, along with a number of customer reviews. Also, customer reviews collected by Reevoo are exhibited. In particular, Exhibit JLAR5 consists of the following:

    a) Prints, dated 13 and 15 October 2020, from the *amazon.co.uk* website demonstrating “KICKERS UNISEX KID’S KICK LO CORE”

with 1,603 customer ratings. The prints show a number of customer reviews: 12 from 2019, 4 from 2018, 2 from 2017, and 2 from 2015.

b) Prints, dated 13 and 15 October 2020, from the *amazon.co.uk* website demonstrating "KICKERS WOMEN'S KICK LO CORE" with 897 customer ratings. The following number of customer reviews are demonstrated: 1 from 2020, 9 from 2019, 12 from 2018, 11 from 2017, 9 from 2016, and 10 from 2015.

c) Prints, dated 15 October 2020, from the *amazon.co.uk* website demonstrating "KICKERS WOMEN'S KICK LO (PATENT BLACK)" with 282 customer ratings. Also, the following number of customer reviews are demonstrated: 1 from 2019, 1 from 2017, and 1 from 2018.

d) Prints, dated 15 October 2020, from the *amazon.co.uk* website demonstrating "KICKERS MEN'S KICK LO CORE BLACK" with 1,207 customer ratings and the following number of customer reviews: 6 from 2019, 3 from 2018, and 2 from 2017.

e) Prints, dated 15 October 2020, from the *amazon.co.uk* website demonstrating "KICKERS MEN'S KICK HI BOOTS CLASSIC". The following number of customer reviews is illustrated: 1 from 2020, 8 from 2019, 8 from 2018, 2 from 2017, and 4 from 2016.

f) Prints, dated 13 October 2020, from the *amazon.co.uk* website demonstrating "KICKERS KID'S BLACK KICK KILO SCHOOL" with 287 ratings. Also, the following number of customer reviews are provided: 1 from 2020, 3 from 2019, 5 from 2018, 1 from 2017, 1 from 2016, 1 from 2015.

g) Undated prints from the Reevoo website showing customer reviews for two products. First, the "MEN'S KICK HI (RED)", which received

a total rating of 9.1/10, is demonstrated with the following number of customer reviews: 7 from 2019, 6 from 2018, 1 from 2017, 2 from 2016, and 2 from 2015. Second, the "MEN'S KICK LO CLASSIC", which received 9.0/10, is demonstrated with the following number of customer reviews: 4 from 2019, 2 from 2018, 3 from 2017, 6 from 2016, and 3 from 2015.

20. In summarising Exhibits JLAR4 and JLAR5 above, I have duly considered both relevant periods and will only take into account customer reviews that are dated within the respective relevant periods.

21. Mr Royer provides a table, as reproduced below, with the net sales figures by year in British pounds, which span the relevant periods between October 2014 and March 2020. Particularly, Mr Royer states that:

> "To give an indication of the scale of the business under the Kick/Kicks trade marks we have included in the below table the net sales figures generated by Kickers and its authorised licensees in the UK."

Period	**Net Sales (figures in the multimillion)**
October 2014 – December 2014	1 638 519
2015	11 601 994
2016	10 582 616
2017	10 440 838
2018	8 281 858
2019	9 955 646
January 2020 – March 2020	1 310 049
Total	**53 811 520**

However, it is not specified in the witness statement to what extent the above figures concern the sales of KICK/KICKS goods. The statement is ambiguous and could relate to all KICKERS sales, of which KICK/KICKS is just a subset.

22. In addition to the above figures, the 2019 sales reports (divided into four quarters) are provided as Exhibit JLAR6. These are said to demonstrate the sales of footwear products under the brands “KICK” and “KICKS”. The sales reports indicate Airborne as the licensee and contain tables with a list of items providing the line (men, women, kids), product name and reference, units, price/unit, and net sales. Overall, the reports illustrate the following entries:

    a) For the female line, there are: 95 entries of “KICK HI”; 8 entries of “KICK HIGHER”; 73 entries for “KICK LO”; 9 entries for “KICK C”; 8 entries for “KICK VELSAN”; 7 entries for “KICK T”; 2 entries for “KICK TRISANDAL”; 1 entry for “KICK MANDO”; 1 entry for “KICK X”; 2 entries for “KICK TRIXIE”; and 2 entries for “KICK THROWBACK”.

    b) For the kids line, there are: 113 entries for “KICK HI”; 10 entries for “KICK KILO”; 24 entries for “KICK LO”; 12 entries for “KICK T”; 1 entry for “KICK RACER”; 2 entries for “KICK FLUTTER”; 6 entries for “KICK POP”; 3 entries for “KICK SHI-KNEE”; 14 entries for “KICK GLOW”; 3 entries for “KICK WEAVE”; 6 entries for “KICK SCUFF”; 2 entries for “KICK STYLY”; 2 entries for “KICK BONNI”; 1 entry for “KICK WALLEE”; 2 entries for “KICK WALLBI”; 2 entries for “KICK BOATEE”; 1 entry for “KICK FUR”; 2 entries for “KICK VEL”; 2 entries for “KICKS PATL”; 2 entries for “KICKS MTLR”; 3 entries for “KICKS LTHR”; and 1 entry for “KICKS TEXT”.

23. Four press articles are exhibited at JLAR7, dated between 2015 and 2018, from various online sources. An article, dated 29 September 2018, titled “CLASSIC KICKS THE KICKERS WAY” provides detail about the history of the “KICKERS KICK HI” and how they shaped footwear fashion between the 70s and 90s while being endorsed by the Britpop music scene. Another article, dated 6 December 2015, titled “Kickers 40th Anniversary Denim Kick Hi” describes that Kickers considered a mainstream fashion item in

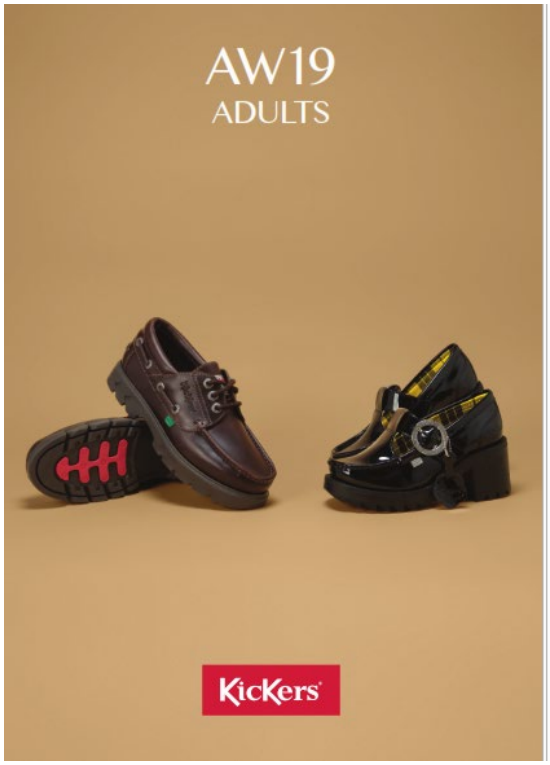
the 90s while introducing “a limited edition all denim Kick Hi”. A third article, dated (approximately) in 2016, titled “KICKERS HEAVILY REWORKS ITS SIGNATURE STYLE FOR NEW FW16 COLLECTION” describes the release of the new designs for Kickers based on the “KICK HI BOOT”. Last, an article, dated 12 August 2015, titled “Kickers @ 40” describes the success of “KICK HI” over the decades and their significant role, particularly in the music scene, for example, worn by Elton John, David Bowie, Arctic Monkeys, and other famous bands and singers.

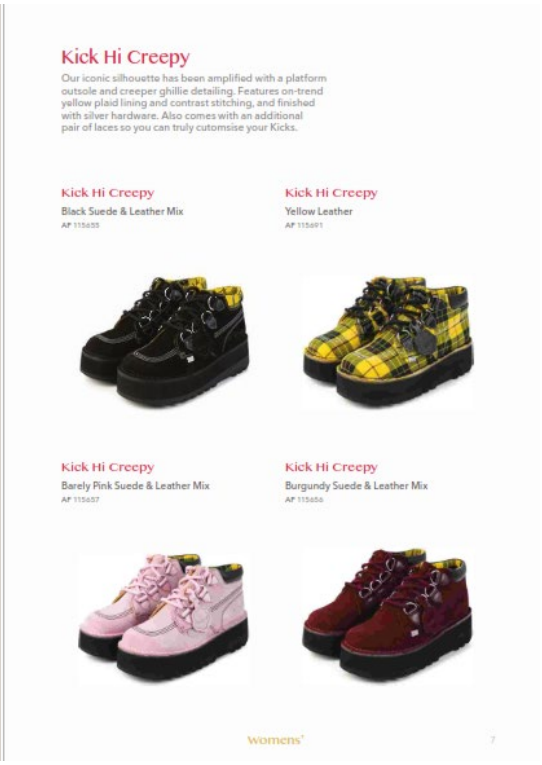
24. In addition, prints from the Kickers UK Twitter account, illustrating a group of pictureless Tweets from 2017 are provided. Six of these Tweets mention the word “KICK” in the caption. By way of example, the below pictures are reproduced:

25. Another group of Tweets from 2014 to 2017 (examples reproduced below) show the use of the word “KICK”, such as “KICK HI”, accompanied by pictures of shoes and a caption.

Further, two prints from the website *youtube.com* are provided, dated 28 September 2018 and 17 January 2019, respectively. These show two screenshots from videos titled “KICK 18 BY KICKERS” and “KICK LEGEND – KICKERS X SWAGGERS”.

26. Moreover, prints from the opponent’s marketing catalogues for “Autumn – Winter 2018” and “Spring – Summer 2019” are exhibited with Exhibit JLAR8. These show the words “KICK” and “KICKS”, reproduced below, in various font colours and cases used throughout in relation to footwear lines for men, women, girls, boys, babies, core, and school. The catalogues showcase the opponent’s goods with relevant pictures, promotional ads and information about the goods.





1st Kicks

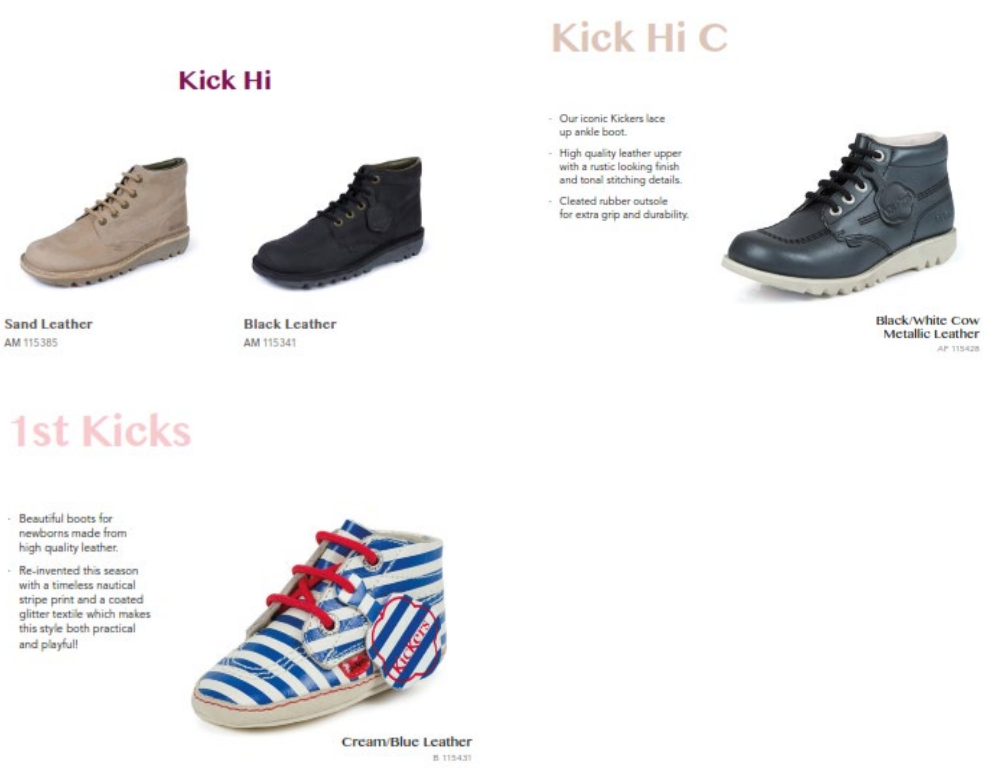
Light Pink Patent Leather
IU 114982

Kick Hi

Dark Grey Leather
YM 115343

Kick Hi

Taupe Metallic Leather
YF 115334



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

DECISION

Proof of Use

28. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

> "114. […]The CJEU has considered what amounts to "genuine use" of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C 416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I 4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009]

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

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

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

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

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

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which

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

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

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

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such

use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus, there is no de minimis rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

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

29. The onus is on the proprietor of the earlier mark to show use. This is in accordance with Section 100 of the Act, which states:

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

Form of the Marks

31. In Case C-12/12 *Colloseum Holdings AG v Levi Strauss & Co.*, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union ("CJEU") found that:

> "31. It is true that the 'use' through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas 'genuine use', within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, 'use' within the meaning of Article 7(3) for the purpose of registration may not be

relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.”

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1)”.

32. *Castellblanch SA v OHIM, Champagne Louis Roederer SA* [2006] ETMR 61 (General Court) is an acceptable example of a registered mark being used in conjunction with another mark.

33. 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 Section 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."

34. Although this case was decided before the judgment of the CJEU in *Colloseum*, 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.

35. The opponent has filed submissions regarding the use of the earlier marks. While I have read these submissions and bear them in mind, it suffices to say that the opponent claims that the earlier marks have been used "on

their own, in conjunction with the home mark and company name, i.e. Kickers" during the relevant periods. There are examples of use of the earlier word mark "KICKS" in the evidence, such as in catalogues, for the duration of the relevant period. Clearly, this will be use upon which the opponent may rely. There is also use in the following forms:

a) 

b) 

36. Registration of a word mark protects that word in any normal font, irrespective of capitalisation.[1] Bearing this in mind, I find that use of the mark in 'a)' above is to be regarded as use of the word mark "KICKS" as registered in normal and fair use.[2]

37. Further, I note that the figurative mark  is often presented as a plain word or in the script as shown above in 'b)'. Taking into account the requirements of Section 6A(4)(a) of the Act, I consider that the distinctive character of the earlier figurative mark lies predominantly in the word "KICK". The absence of the stylisation of the figurative mark, nor the different stylisation in b) above, would not be enough to alter the distinctive character of the mark. Consequently, I find that the mark used by the opponent falls into the category of variant use and qualifies as use of the opponent's earlier mark.

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[1] See *Bentley Motors Limited v Bentley 1962 Limited,* BL O/159/17.

[2] See *Dreamersclub Ltd v KTS Group Ltd*, BL O/091/19.

38. Moreover, I note that in much of the use the KICK/KICKS mark is used alongside various designations, such as “HI”, “LO” and “T”, but in my view, this constitutes use in combination with additional matter, upon which the proprietor may rely as explained in *Colloseum*. The marks retain their independent use as indicators of origin. Even if I am wrong in this finding, the addition of such descriptive and non-distinctive elements will not alter the distinctive character of the marks. I, therefore, consider such use would, in any event, be acceptable variant use of the registered marks as per *Nirvana*.

Sufficient Use

39. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.[3]

40. As indicated in the case law cited above, use does not need to be quantitatively significant to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as “warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark”.

41. I have noted above that Mr Royer’s witness statement provides a breakdown of the UK net sales figures for the relevant periods, the total of which is in excess of £53 million.[4] Notably, as mentioned above, Mr Royer has not explained whether the entirety of the sales figures solely cover the sales of goods in relation to which the earlier marks have been used. That said, there is unchallenged evidence of sales reports (in relation to the earlier marks) from 2019 in the UK, showing sales of various quantities of

[3] See *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09.

[4] See paragraph 7 of the witness statement.

the relevant goods from the female and kid's lines to one of the opponent's licensees. However, I note that this evidence covers only part of the five-year period. Undoubtedly, the UK footwear retail market is a significant one, and even though the opponent did not provide any evidence as to the market share it possesses, I am satisfied with the evidence that it operates in a way aimed at real commercial exploitation and has done so for a number of years.

42. Further, there are ample examples in the opponent's evidence that shows sufficient use with the forms that I have already identified in the previous section on various websites selling the opponent's goods. These are displayed in the listings, the product description, the web link and the product reviews. The evidence also demonstrates customer reviews and ratings of the relevant products, which sufficiently cover the relevant periods. Whilst, based on the evidence before me, the use in relation to "KICKS" amounts to a smaller subset of goods, i.e. footwear for infants, with a narrower use. These were primarily demonstrated in the catalogues,[5] indicating the efforts of the opponent to create and maintain a share in the market.

43. While there is a lack of evidence in relation to marketing expenditure, the opponent gives evidence of adverts, such as online magazine articles and catalogues, including social media posts from the opponent's Twitter account, dated during the relevant periods. Most magazine articles focus on the strong link between the opponent's products (e.g. the "KICK HI") and the music scene and the influence of the former on fashion thereafter. The earlier marks were clearly referenced and displayed in the description of the above evidence.

[5] See Exhibit JLAR8.

44. Although the evidence could have been better, an assessment of genuine use is a global assessment, which requires looking at the evidential picture as a whole and not whether each individual piece of evidence shows use by itself. While bearing in mind the two relevant periods and the two different marks, including their forms of use, that I have identified above in this decision, I am satisfied that the opponent has demonstrated genuine use in the UK of its marks during the relevant periods. As such, the opponent can rely upon them for the purpose of these proceedings.

Fair Specification

45. I must now consider what a fair specification would be for the use shown.

46. 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."

47. 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."

48. The goods at issue are *"footwear"* in Class 25, and these are the goods for which the opponent made a statement of use. The applicant has not commented upon the specific goods it believes the earlier mark has, or has not, been used, nor what a fair specification should be.

49. From the opponent's evidence, it is clear that the earlier figurative mark "KICK" ('414) has been used for a wide range of footwear, including boots, such as chukka, desert, combat, and work boots; shoes, such as T-bar, black patent, loafers, brogues, boats, derby-style, slip-on, sneakers, and Velcro sneakers; and sandals with lines covering all ages and genders, i.e. men, women, boys, girls, kids, and infants. Therefore, the opponent may rely on the earlier figurative mark for *"footwear"*; this, in my view, is how the average consumer would categorise the range of goods.

50. The earlier word mark "KICKS" ('862) has been used in relation to a narrower range of goods, as outlined previously in this decision, namely footwear for infants/new-borns. I consider that the average consumer would describe the use as "*footwear for infants*". Consequently, I consider a fair specification to be:

Class 25: *Footwear for infants.*

Section 5(2)(b)

51. Section 5(2)(b) of the Act states:

> "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".

52. The principles, considered in this opposition, stem from the decisions of the European 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (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-334/05 P) and Bimbo SA v OHIM (Case C-519/12 P):

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.

COMPARISON OF GOODS

53. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the CJEU stated 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 complementary."[6]

54. Guidance on this issue was also given by Jacob Justice (as he then was) in *British Sugar Plc v James Robertson & Sons Limited ("Treat")* [1996] RPC 281. At [296], he identified the following relevant factors:

> "(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;

[6] Paragraph 23.

(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."

55. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The General Court clarified the meaning of "complementary" goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

> "[…] 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."

56. The General Court confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, paragraph 29, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

> "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".

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

> "[…] the applicable principles of interpretation are as follows:
>
> (1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.
>
> (2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.
>
> (3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.
>
> (4) A term which cannot be interpreted is to be disregarded."

58. In *YouView TV Ltd v Total Ltd, [2012] EWHC 3158* (Ch), paragraph 12, Floyd J (as he then was) gave the following guidance on construing the words used in specifications:

> "[…] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless, the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because

the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words of phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

59. Taking into account the fair specifications I indicated earlier, the competing goods to be compared are shown in the following table:

Opponent's Goods	**Applicant's Goods**
Mark '414 ***Class 25:*** *Footwear*	*Application '329* ***Class 25:*** *Footwear; sneakers [footwear]; athletics footwear; pumps [footwear]; beach footwear; leisure footwear; flip-flops; wellington boots; snow boots; snowboard boots.*
Mark '862 ***Class 25:*** *Footwear for infants*	*Application '105* ***Class 25:*** *Footwear; sneakers [footwear]; athletics footwear; pumps [footwear]; beach footwear; inner soles; boots; leisure footwear; flip-flops; slippers; wellington boots; snow boots; snowboard boots; socks.*

60. In the notice of opposition, the opponent claims that the applicant's goods are identical or similar to goods covered by the earlier marks, although this was before the application of the above fair specifications which, at least insofar as earlier mark '862, is narrower than the statement of use. More specifically, the opponent provides a more detailed comparison of the goods with its submissions:

"21 It is self–evident that the following terms covered by the applications "Footwear; sneakers [footwear]; athletics footwear; pumps [footwear]; beach footwear; leisure footwear; flip-flops; wellington boots; snow boots; snowboard boots; slippers; boots" are **identical** to the goods covered by the Earlier Rights, i.e. "footwear".

22 The terms "inner soles and socks" are **similar** to "footwear", goods covered by the Earlier Rights, as the conflicting goods are complementary, they are likely to be made available through the same distribution channels and in the mind of the public, the goods may have the same usual origin, it is customary in the market for the producers of footwear also to be involved in the manufacture of inner soles and socks."

61. The applicant did not comment on the similarity/identicality of the goods in its counterstatement.

62. The contested goods in Class 25 contain a wide range of footwear items and related articles. For the purpose of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way for the same reasons.[7]

63. It is clear that the contested terms are either literally identical, such as *"footwear"*, or they are encompassed by the opponent's broad terms *"footwear"* and *"footwear for infants".* As such, they are considered identical based on the *Meric* principle or else highly similar.

64. If I am wrong in relation to the applicant's *"inner soles"* and *"socks",* they are used inside or in combination with footwear to provide a warmer or

[7] *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38.

more comfortable fit. Such goods are considered to be complementary to the opponent's *"footwear"* and *"footwear for infants"*, targeting the same end users. Also, the consumers would likely expect them to be produced by the same manufacturer and sold together in the same sales outlets. Therefore, I find them to be similar to a medium degree.

AVERAGE CONSUMER AND THE PURCHASING ACT

65. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes 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 in question: *Lloyd Schuhfabrik Meyer,* Case C-342/97. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

> "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 word 'average' denotes that the person is typical. The term 'average' does not denote some form of numerical mean, mode or median."[8]

66. The goods at issue will be purchased by members of the general public. Such goods are usually offered for sale in stores (e.g. retail outlets), brochures and catalogues, and online. In retail premises, the goods will be displayed on shelves, where they will be viewed and self-selected by consumers. Similarly, for online stores, consumers will select the goods

[8] Paragraph 60.

relying on the images displayed on the relevant web pages. Therefore, visual considerations will dominate the selection of the goods in question, but aural considerations will not be ignored in the assessment.[9]

67. Although these goods are not particularly costly, the average consumer may examine the product to ensure that they select the correct type, size, materials, quality, and aesthetic appearance. In this regard, the average consumer is likely to pay a reasonable (but not high) level of attention to selecting the goods at issue.

COMPARISON OF TRADE MARKS

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

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

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[9] The General Court highlighted this in *New Look Ltd v OHIM Cases* T-117/03 to T-119/03 and T-171/03, at paragraph 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."

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

70. The marks to be compared are:

Earlier marks	Contested marks
Mark ('862) KICKS	Mark ('329) Wool Kicks
Mark ('414) 	Mark ('105) Woolkicks

Overall Impression

71. The earlier mark '862 consists of the word "KICKS" in capital letters and a standard font. Registration of a word mark protects the word itself presented in any normal font and irrespective of capitalisation.[10] The overall impression of the mark lies in the word itself. The earlier figurative mark '414 consists of the word "KICK" presented in a stylised black and title case font. The word has, by far, the greatest weight in the overall impression, while the stylisation has less weight.

72. Both the contested marks, '329 and '105, consist of the words "Wool Kicks" and "Woolkicks", respectively, in title case and standard font. I note the opponent contends that the word "WOOL" is likely to be considered as being "descriptive of characteristics of the goods, i.e. that the goods are made from wool." The overall impression, however, resides in each of the

[10] See *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

marks as a whole. Nevertheless, I acknowledge that the average consumer may attribute a potential descriptive meaning in the word "WOOL", which is still part of the overall impression of the marks at issue.

Visual Comparison

Contested mark '329 and earlier mark '862

73. The respective marks share the word "KICKS", which is the entirety of the opponent's mark and the second word element of the applicant's mark. The applicant has the additional word "WOOL", featuring as its first word element. I also accept that this diverging element appears at the beginning of the competing marks, a position which is generally considered to have more impact while being, of course, just a rule of thumb.[11] Consequently, when considering the marks, I do not find it to be the case that the first element is less significant. The difference in font case will play no role due to the notional and fair use of the word marks in any font case. Taking all the above into account, I find there is a medium degree of visual similarity.

Contested mark '329 and earlier mark '414

74. The word element ("KICK") of the earlier mark is reproduced partly by the second word element ("KICKS") of the contested mark. However, the marks differ in that the applicant's mark has the letter 's' at the end and the word "WOOL" at the beginning. There are further differences due to the figurative aspects of the earlier mark, though the impact of these in the overall impression is less, as the contested mark could be notionally used in a similar stylisation to that of the earlier mark. Therefore, there is a medium degree of similarity.

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

Contested mark ‘105 and earlier mark ‘862

75. The applicant’s word mark “WOOLKICKS” contains the opponent’s word mark “KICKS” in its entirety. The applicant’s mark consists of nine letters instead of the opponent’s mark, which consists of five. Also, I bear in mind that the first part of a mark usually has more impact. Because of the additional word “WOOL” at the beginning of the contested mark, there is a further point of visual difference. Overall, I find there is a medium degree of visual similarity.

Contested mark ‘105 and earlier mark ‘414

76. Following the analysis above with regard to the additional word “WOOL” at the beginning; the use of the plural form of the earlier word element in the applicant’s mark; and the difference created by the figurative aspects result in what I regard as a medium degree of similarity.

Aural Comparison

77. On the one hand, the contested marks, ‘329 and ‘105, consist of two syllables and will be pronounced as “WUL-KIKS”, notwithstanding the separation of the words. On the other, the earlier marks, ‘862 and ‘414, are both single-syllable words and will be pronounced as “KIKS” and “KIK”, respectively. Although the latter syllable (KIKS) of the contested marks is identical to the earlier mark ‘329 and similar to the earlier mark ‘414, there is no phonetic counterpart of the former syllable (WUL) in either of the earlier marks. Overall, I consider that the marks are aurally similar to a medium degree.

Conceptual Comparison

78. In its written submissions, the opponent contends that the respective marks are conceptually highly similar as “the meaning of the distinctive

element of the Applications, that is Kicks, is identical to the meaning of the Earlier Rights", although it does not say what that meaning is.

79. For the assessment of the conceptual meaning of the marks, I will rely on their ordinary dictionary meaning. In accordance with the Oxford English Dictionary Online, on the one hand, the word "KICKS" is the third person of the verb "KICK", which has various meanings but chiefly is defined as "the act of kicking"[12], but on the other, "KICKS" (plural) is a slang term for shoes.[13] Notably, in the absence of evidence and despite the latter dictionary reference, I am unwilling to conclude that the entirety of the consumers in the UK will be aware of this slang meaning.[14] As a result, in my view, a sufficient proportion of consumers will conceptualise the term purely as relating to kicking while a smaller one will be familiar with the slang term. In my view, either the singularisation or pluralisation of the earlier marks does not affect the perception of the average consumer or, if it does, it is minimal.

80. Further, the word "WOOL", found in the contested marks, is a well-known word to the UK average consumer and may serve as a descriptor, capable of conveying the message that something is made of wool. The combination of the words "WOOL" and "KICKS", each of which contributes to the overall impression, will be allusive of a woollen product that is related to kicking for the largest group of consumers, while being suggestive of woollen shoes for a smaller group of consumers that are accustomed to the slang meaning of the term "KICKS". Against this background, I agree that the shared word "KICKS" will bring to mind the same concept between the contested marks for either of the above groups. For completeness, the figurative aspects of the earlier mark '414 will have no conceptual

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[12] See n.1.a. in Oxford English Dictionary Online.

[13] See "kicks, n.6.b." in Oxford English Dictionary Online.

[14] See *Chorkee Ltd v Cherokee Inc.,* Case BL O/048/08; and *Wunderkind Trade Mark* [2002] R.P.C. 45.

meaning. Overall, I find a high degree of conceptual similarity between the marks.

DISTINCTIVE CHARACTER OF THE EARLIER TRADE MARK

81. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

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

82. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent

distinctive character, such as invented words which have no allusive qualities.

83. As noted above, the earlier mark ‘862 consists solely of the word “KICKS”, while ‘414 consists of the verbal element “KICK” and the figurative element. The stylisation of the ‘414 mark is modest and will not increase the distinctiveness of the mark to any material extent. The verbal element in both marks is a dictionary word with the meanings that I have identified above. As I am prepared to accept that the slang meaning of the term “KICKS” is not universally known, I will come to a dual finding in relation to distinctiveness. For the significant proportion of the consumers who are not familiar with that slang term, the marks are somewhat allusive of the goods involved, as they may hint to the medium that enables kicking. However, that allusion is extremely mild, and there is no reason to find that this results in the distinctiveness of the marks being low. Thus, I find that the earlier marks have a medium degree of inherent distinctive character. However, in the case where consumers will be familiar with the slang term, the distinctiveness of the marks will be of a low degree.

84. The level of distinctiveness of a mark may be enhanced through use. The opponent has provided evidence of use of the earlier marks. However, I find the evidence insufficient to demonstrate that the marks have acquired an enhanced degree of distinctive character through use in the UK for the goods that the opponent has genuinely used the marks. Despite the total of the UK net sales, as outlined above, it is unclear whether the figures exclusively concern the sales of KICK/KICKS products or the house mark and company name “KICKERS”. While Mr Royer states that the brand has existed for more than 40 years and has been widely endorsed by the UK music scene, there is no indication of the market share held by the marks and no marketing expenditure figures as to the amount invested by the opponent in promoting the given marks. As a result, it is not possible to establish from the evidence filed to what extent the earlier mark has been

advertised and its position in the market. Consequently, I find that the distinctive character has not been enhanced through use made by the marks.

LIKELIHOOD OF CONFUSION

85. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that 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.[15] It is essential to keep in mind the distinctive character of the opponent's trade mark since the more distinctive the trade mark, the greater the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon imperfect recollection.[16]

86. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking.

87. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU's judgment in *Bimbo*, Case C591/12P, on the Court's earlier judgment in *Medion v Thomson*. The judge said:

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[15] See *Canon Kabushiki Kaisha*, paragraph 17.

[16] See *Lloyd Schuhfabrik Meyer*, paragraph 27.

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent

authority to carry out a global assessment taking into account all relevant factors."

88. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Iain Purvis Q.C., sitting as the Appointed Person, explained that:

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

89. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor QC, also sitting as the Appointed Person, commented on the passage above, stressing that the examples given by Mr Purvis were just that and should not be taken as akin to a statutory test:

> "81.2 […] the reason why the CJEU stressed the importance of the global assessment is, in my view, because it is supposed to emulate what happens in the mind of the average consumer on encountering, for example, the later mark applied for with an imperfect recollection of the earlier mark in mind. It is not a process of analysis or reasoning, but an impression or instinctive reaction.

81.3 […] when a tribunal is considering whether a likelihood of confusion exists, it should recognise that there are four options:

> 81.3.1 The average consumer mistakes one mark for the other (direct confusion);
>
> 81.3.2 The average consumer makes a connection between the marks and assumes that the goods or services in question are from the same or economically linked undertakings (indirect confusion);
>
> 81.3.3 The various factors considered in the global assessment lead to the conclusion that, in the mind of the average consumer, the later mark merely calls to mind the earlier mark (mere association);
>
> 81.3.4 For completeness, the conclusion that the various factors result in the average consumer making no link at all between the marks, but this will only be the case where either there is no or very low similarity between the marks and/or significant distance between the respective goods or services;
>
> 81.3.5 Accordingly, in most cases, it is not necessary to explicitly set out this fourth option, but I would regard it as a good discipline to set out the first three options, particularly in a case where a likelihood of indirect confusion is under consideration.

81.4 […] I think it is important to stress that a finding of indirect confusion should not be made merely because the two marks share a common element. When Mr Purvis was explaining in more formal terms the sort of mental process involved at the end of his [16], he made it clear that the mental process did not depend on the common element alone: 'Taking account of the common element in the context of the later mark as a whole.'"

90. In *Soulcycle Inc v Matalan Ltd,* [2017] EWHC 496 (Ch), Mann J. approved the approach of the Hearing Officer at first instance in considering the reactions of average consumers who did, and did not, recognise the word SOUL within the mark SOULUXE. The judge said:

> “27. I do not consider that the Hearing Officer made an error of principle in this respect. In considering the question of the effect of the mark within the class, by reference to proportions who did not share the same view, he was following the same line as that pursued by Arnold J at first instance in *Interflora Inc v Marks and Spencer plc* [2013] EWHC 1291 (Ch). Arnold J considered at some length whether there was a "single meaning rule" in trade mark law under which the court had to identify one, and one only, perception amongst the relevant class of average consumer, and judge confusion accordingly. At paragraph 213 he found there is no such rule and then set out his reasoning over the following paragraphs. Paragraph 224 set out important parts of his conclusion; the references to Lewison LJ is to that judge's judgment in an earlier case.
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> > "224 […] Thirdly, Lewison LJ expressly accepts that a trade mark is distinctive if a significant proportion of the relevant public identify goods as originating from a particular undertaking because of the mark. Thus he accepts that there is no single meaning rule in the context of validity. As I have said, that is logically inconsistent with a single meaning rule when one comes to infringement. Fourthly, the reason why it is not necessarily sufficient for a finding of infringement that "some" consumers may be confused is that, as noted above, confusion on the part of the ill-informed or unobservant must be discounted. That is a rule about the standard to be applied, not a rule requiring the determination of a single meaning. If a significant proportion of the relevant class of consumers is confused, then it is likely that confusion extends beyond those

who are ill-informed or unobservant. Fifthly, Lewison LJ does not refer to many of the authorities discussed above, no doubt because they were not cited. Nor does he discuss the nature of the test for the assessment of likelihood of confusion laid down by the Court of Justice. The legislative criterion is that "there exists a likelihood of confusion on the part of the public". As noted above, the Court of Justice has held that "the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion". This is not a binary question: is the average consumer confused or is the average consumer not confused? Rather, it requires an assessment of whether it is likely that there is, or will be, confusion, applying the standard of perspicacity of the average consumer. It is clear from the case law that this does not mean likely in the sense of more probable than not. Rather, it means sufficiently likely to warrant the court's intervention. The fact that many consumers of whom the average consumer is representative would not be confused does not mean that the question whether there is a likelihood of confusion is to be answered in the negative if a significant number would be confused."

28. That justifies a consideration of confusion in relation to a proportion of the class of average consumer by reference to perceptions, in the manner in which the Hearing Officer went about the matter. It also justifies applying the same technique (where appropriate on the facts) to validity and infringement proceedings alike."

91. Earlier in this decision I have concluded that:

- the goods at issue are identical or else similar;
- the average consumer of the parties' goods is a member of the general public, who will select the goods by predominantly visual means, but without dismissing the aural means, and will likely pay a reasonable (but not high) degree of attention to the selection of such goods;
- the competing marks are visually and aurally similar to a medium degree, and conceptually similar to a high degree;
- the earlier marks have a medium degree of distinctive character for a large group of the consumers and a low degree of distinctive character for a smaller one, depending on the familiarity with the slang term.

92. Taking into account the above, particularly the visual differences between the marks, such as the presence of the additional word "WOOL" in the applicant's marks and the predominantly visual purchasing process, and although the difference between the singular and plural forms in the marks may well be lost due to imperfect recollection, I am satisfied that the marks are unlikely to be mistakenly recalled or misremembered as each other. Therefore, I do not find there is a likelihood of direct confusion.

93. Nevertheless, I find that there is a likelihood of indirect confusion for the respective goods, which are identical and/or similar. Considering the dual degree of distinctiveness that I have found in this decision, there is a sufficiently large enough group (as per *Soulcycle)* of consumers who will be unaware of the suggestive significance of "KICKS", i.e. slang for shoes. In particular, while the average consumer will identify the difference in the marks, they will identify the common word element (KICKS/KICK) shared in the respective marks. Given the identity and/or similarity of the goods in

question, it is likely that the average consumer would perceive the competing marks as brand extensions or sub-brands, adding a type of material (that of wool) at the beginning. Therefore, I find that the average consumer would assume a commercial association between the parties, believing that the respective goods come from the same or economically linked undertakings, preceded by a descriptive or informative element. As a result, I find there is a likelihood of indirect confusion.

94. In relation to the group of consumers to which the slang term is known, and while the argument is more borderline, the addition of a form of material, namely “WOOL”, before the shared verbal elements in the respective marks will not alter the outcome of indirect confusion for the reasons that I have advanced above.

OUTCOME

95. The oppositions under Section 5(2)(b) of the Act are successful in their entirety. Therefore, subject to appeal, the applications will be refused.

COSTS

96. The opponent has been successful and is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of £1,950 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

£200	Official opposition fees covering both oppositions
£400	Filing a notice of opposition and considering the counterstatement covering both oppositions
£350	Filing written submissions
£1000	Filing evidence
£1,950	Total

97. I, therefore, order Abogear Limited to pay Kickers International B.V. the sum of £1,950. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 5th day of May 2021

Dr Stylianos Alexandridis
For the Registrar,
The Comptroller General