O-458-14

TRADE MARKS ACT 1994

TRADE MARK REGISTRATION No. 2624260

IN THE NAME OF SPORTITOTS LIMITED

AND

APPLICATION No. 5000032

BY

SPORTY TOTS LIMITED

FOR REGISTRATION No. 2624260

TO BE DECLARED INVALID AND CANCELLED

Background and pleadings

1. This is an application by Sporty Tots Ltd ("the applicant") to invalidate trade mark registration No.2624260 in the name of Sportitots ("the proprietor"). It illustrates very well why it is important for businesses to register the trade marks they use as soon as possible. In this case a delay in registering the proprietor's mark, which appears to have been in use since at least 2008, has resulted in the registration of the mark being cancelled because another party had already registered a similar mark.

2. The proprietor's mark is shown below.

2. The proprietor applied to register the mark on 12 June 2012. It was registered on 5 April 2013. It is registered for a wide range of goods and services in classes 6, 9, 14, 16, 18, 20, 21, 24, 25, 26, 28, 35, 36, 38 and 41. Notably, the services in class 41 include *'arranging and conducting of education and training in relation to football'.*

3. The applicant was the owner of an earlier trade mark, namely, the words SPORTY TOTS at the time the application for the cancellation of trade mark registration No.2624260 was filed. The application to register the earlier mark was made on 7 July 2011. That mark was registered on 16 December 2011.

4. I note that the earlier trade mark was assigned to Katherine Anne Jeffreys on 1 October 2014. However, no application has been made to substitute Ms Jeffreys as the applicant for cancellation.

5. The proprietor's mark is registered for the same goods/services as the applicant's mark. In fact the proprietor used exactly the same words as the applicant had previously done to describe its goods/services. This is a remarkable coincidence given that the services in class 35 alone are described in 1361 words.

6. The applicant's application to invalidate the proprietor's mark was filed on 9 May 2013. It was based partly on the proprietor's registration being contrary to section 5(2)(b) of the Act. In this respect the applicant relies on the earlier trade mark described above and asserts that there is a likelihood of confusion with the

proprietor's trade mark. There was a second claim: that registration of the proprietor's mark was also contrary to section 5(4)(a) of the Act. In this respect the applicant claimed to enjoy common law rights under the name SPORTY TOTS as a result of the use of that name since at least as early as July 2007 (i.e. nearly 5 years before the proprietor applied to register its mark) in relation to a sports coaching programme for children in Surrey, Kent, Middlesex and parts of London.

7. The proprietor filed a counterstatement denying the grounds for invalidation. In that counterstatement the proprietor describes itself as Sportitots Limited. This has subsequently been confirmed as the correct identity of the proprietor. The proprietor claims that:

- The applicant was not incorporated until 9 April 2009 and filed accounts for the year ending 30 April 2011 stating that it was a dormant company.

- If Sporty Tots Ltd conducted any business it appears to have been geographically limited to Kent.

- Sportitots Limited was incorporated on 11 September 2006 and has conducted business since then under the name Sporti Tots, and under the registered composite mark.

- The registered mark is not the same as SPORTY TOTS because it includes a logo; also the words SportiTots are different to the words forming the applicant's earlier mark. Further, the differences are sufficient to avoid a likelihood of confusion.

- The applicant had not contacted the proprietor before these proceedings started and had not answered two subsequent letters from the proprietor asking it to explain how there was a likelihood of confusion.

- The examiner of the applicant's trade mark application had notified a third party about the applicant's mark: Norwich City Community Foundation, owner of the earlier trade mark No. 2534877, a composite device mark including the words Sporty Tots. The proprietor says that if these two marks can live together without confusion, so too can its' mark.

The evidence

7. Only the proprietor filed evidence. The evidence takes the form of a witness statement by Matthew Dimbylow. Mr Dimbylow does not explain what his role is within the company Sportitots Ltd, but he appears to speak for the company. He confirms the factual data provided in the counterstatement. He also provides some invoices and other documents showing Sportitots trading in 2010. Mr Dimbylow

states that the business had an annual revenue of £59k prior to the date of the application[1].

8. Mr Dimbylow further states that the proprietor's registered mark has been used in the North West of the UK in relation to sporting goods and services.

The law

9. Sections 47(2) and (2A) of the Act are as follows:

> "(2) The registration of a trade mark may be declared invalid on the ground-
>
> (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
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> (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied, unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.
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> (2A) But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless -
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> (a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,
>
> (b) the registration procedure for the earlier trade mark was not completed before that date, or
>
> (c) the use conditions are met."

Section 5(4)(a) ground struck out

10. As the applicant filed no evidence (and therefore no evidence of use of SPORTY TOTS), its application was struck out under Rule 42(4) of the Trade Mark Rules 2008 to the extent that it was based on an earlier common law right to the words SPORTY TOTS. However, as the registration procedure for the earlier registered mark had been completed less than 5 years before the date of the application for invalidation on 9 May 2013, s.47(2A)(a) applies. This means that the applicant can rely on the registration of the earlier mark for all the goods/services for which it is registered without providing proof of use, or answering the proprietor's challenge to prove use of its earlier mark.

[1] I take this to mean the date of the application for invalidation.

The hearing

11. The matter came to be heard on 10 October 2014 when the proprietor was represented by Lawrence McDonald of Counsel. The applicant did not appear and was not represented.

Section 5(2)(b)

12. Sections 5(2)(b) of the Act is as follows:

> "5(2) A trade mark shall not be registered if because-
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

The case law

13. 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;

(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) 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;

(g) 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;

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

(i) 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/services

13. As the respective lists of goods/services are literally identical, there can be no dispute that the goods/services are identical.

Comparison of marks

14. The Court of Justice of the European Union ("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."

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.

15. The respective trade marks are shown below:

SPORTY TOTS	
Earlier trade mark	Contested trade mark

16. Whilst accepting (as he had to) that there was similarity between the words SPORTY TOTS and SportiTots, Mr McDonald submitted that the marks as wholes were not similar. The words in the respective marks are plainly very similar. Further, the words SportiTots are a prominent feature of the proprietor's mark. They are as visually dominant in that mark as the device element. The close similarity between the respective words therefore inevitably introduces a degree of similarity between the marks as wholes. Although one can easily tell them apart when placed side by side, in my judgment the marks are quite highly similar to the eye. They are identical to the ear. The device element of the proprietor's mark, consisting of a lion club (representing youth) and a football (representing sport) against the background of a star, complements the meaning of the words SportiTots. In my view, the respective marks convey the same concept of 'sporty youngsters'.

Average consumer and the purchasing act

17. 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*[2]. The goods and services at issue in this case are wide and varied. Many are goods and services selected by the general public exercising an average level of attention, such as badges, DVDs, imitation jewellery, books, key rings, mugs, textiles, clothing, toys, retail services for a wide range of goods, telecoms, entertainment and educational services, including football coaching. Others are likely to be selected by the general public paying an above average level of attention, such as insurance services. And some are likely to be selected by a specialist public again paying a higher than average level of attention, such as *'the bringing together, for the benefit of others, of a variety of common metals and their alloys, transportable buildings of metal, materials of metal for railway tracks'.*

[2] Case C-342/97

Distinctive character of the earlier trade mark

18. In *Lloyd Schuhfabrik Meyer,* the CJEU stated that:

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

19. The earlier mark is allusive of sporting goods and services aimed at youngsters, such as '*arranging and conducting of education and training in relation to football'* in class 41 and sporting articles in class 28. It is therefore of below average distinctive character for these types of services and goods. The earlier mark is of average distinctiveness for other goods and services covered by the marks, such as badges, DVDs, imitation jewellery, books, key rings, mugs, textiles, clothing, toys, telecoms.

Likelihood of confusion

20. Mr McDonald relied on the lack of evidence of confusion in support of his submission that there was no likelihood of confusion between the trade marks. Such submissions are very common in trade mark proceedings. However, they are rarely persuasive. In *Compass Publishing BV v Compass Logistics Ltd* [3] Laddie J. noted:

> "22. It is frequently said by trade mark lawyers that when the proprietor's mark and the defendant's sign have been used in the market place but no confusion has been caused, then there cannot exist a likelihood of confusion under Article 9.1(b) or the equivalent provision in the Trade Marks Act 1994 ("the 1994 Act"), that is to say s. 10(2). So, no confusion in the market place means no infringement of the registered trade mark. This is, however, no more than a rule of thumb. It must be borne in mind that the provisions in the legislation

[3] [2004] RPC 41

> relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place.
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> 23. This is of significance in this case because, as noted above, there is no suggestion that there has been any confusion in the market place between the activities of the Defendant under the sign "COMPASS LOGISTICS" and the Claimant, or any other member of the Compass Group, under the mark "COMPASS". Mr Wyand relies on this as being a good indication that there is no likelihood of confusion. But in my view Mr Purvis is right when he argues that the question of infringement has to be answered by assessing the likelihood of confusion were the Claimant to use the mark "COMPASS" in a normal way in respect of all services covered by the registration, including for business consultancy services in the field of logistics, that is to say the same specialist field the Defendant operates in."

21. This appears to be consistent with the later judgment of the CJEU in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*[4]*,* in which the court held that when assessing the likelihood of confusion under the equivalent of s.5(2) it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered.

22. In *Rousselon Freres et Cie v Horwood Homewares Limited*[5] Warren J. commented:

> "99. There is a dispute between Mr Arnold and Mr Vanhegan whether the question of a likelihood of confusion is an abstract question rather than whether anyone has been confused in practice. Mr Vanhegan relies on what was said by Laddie J in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at paragraphs 22 to 26, especially paragraph 23. Mr Arnold says that that cannot any longer be regarded as a correct statement of the law in the light of *O2 Holdings Ltd v Hutchison 3G Ltd* [2007] RPC 16. For my part, I do not see any reason to doubt what Laddie J says...".

23. A similar point was also made by the Court of Appeal in *The European Limited v The Economist Newspaper Ltd* [6] in which Millett L.J. stated that:

[4] Case C-533/06, at paragraph 66 of the judgment
[5] [2008] EWHC 881 (Ch)
[6] [1998] FSR 283

"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark."

24. The reasons why there could be no evidence of confusion in this case are obvious. Firstly, the applicant's mark may not have been used at all. Secondly, if it has been used, the use appears to be limited to the South East of England, possibly just Kent, whereas the proprietor's mark has been used in the North West of England. Neither party is big enough to have generated a national reputation on the basis of such regional use. Consequently, the public (or at least the same public) has not been exposed to the concurrent use of both marks. It follows that no one could have been confused by such concurrent use. However, my role is to assess the likelihood of future confusion on the basis that both marks are used concurrently across the UK in relation to the same goods and services.

25. Mr McDonald submitted that I should nevertheless be cautious about finding that there is a likelihood of confusion between the marks in circumstances where the applicant has filed no evidence. However, evidence of a likelihood of confusion is not always necessary or helpful. In *esure Insurance Ltd v Direct Line Insurance Plc*[7], L.J. Arden stated that:

"56. In my judgment, Mr Hobbs is correct on this point. What the hearing officer had to determine was what the average consumer would have thought of the two marks and whether they would have confused him. The services sold by the parties were identical and were of a kind familiar to members of the public. In those circumstances, I see no reason why the hearing officer should not have decided the issue of similarity on his own in the absence of evidence apart from the marks themselves and evidence as to the goods or services to which they were, or, in the case of esure's mark, were to be applied. As Lord Diplock held in *Re GE Trade Mark* at 321:

"My Lords, where goods are of a kind which are not normally sold to the general public for consumption or domestic use but are sold in a specialised market consisting of persons engaged in a particular trade, evidence of persons accustomed to dealing in that market as to the likelihood of deception or confusion is essential. A judge, though he must use his common sense in assessing the credibility and probative value of that evidence is not entitled to supplement any deficiency in evidence of this kind by giving effect to his own subjective view as to whether or not he himself would be likely to be deceived or confused … But where goods are sold to the general public for consumption or domestic use, the question whether such buyers would be likely to be deceived or confused by the use of the trade mark is a "jury question". By that I mean that if the issue had now, as formerly, to be tried by a jury, who as members of the general public would themselves be potential buyers of the goods, they would be required not only to

[7] [2008] EWCA Civ 842

> consider any evidence of other members of the public which had been adduced, but also to use their own common sense and to consider whether they would themselves be likely to be deceived or confused.
>
> The question does not cease to be a "jury question" when the issue is tried by a judge alone or on appeal by a plurality of judges. The judge's approach to the question should be the same as that of a jury. He, too, would be a potential buyer of the goods. He should, of course, be alert to the danger of allowing his own idiosyncratic knowledge or temperament to influence his decision, but the whole of his training in the practice of the law should have accustomed him to this, and this should provide the safety which in the case of a jury is provided by their number. That in issues of this kind judges are entitled to give effect to their own opinions as to the likelihood of deception or confusion and, in doing so, are not confined to the evidence of witnesses called at the trial is well established by decisions of this House itself."

> 57 An example of such a decision would, as Mr Hobbs submits, be *Spalding v Gamage (1915) 32 RPC 273* . The *GE Trade Mark* decision was under the provision in the Trade Marks Act 1938 for the rectification of the Register of Trade Marks. But the principle that it enunciates is one which is derived from the law of evidence and the decision is thus not limited to trade marks, or the 1938 Act."

26. The absence of specific evidence of a likelihood of confusion does not therefore preclude me from making such a finding on the basis of just the marks at issue and my assessment of the likely result of the concurrent use of those marks in relation to the goods and services for which they are registered.

27. The proprietor also seeks to rely on the existence of another similar mark on the UK trade mark register in order to show that such marks can co-exist without a likelihood of confusion. However, in the absence of evidence that such marks are in use, this sort of evidence has always been given short shrift. There is ample national authority to justify that approach[8]. In *Il Ponte Finanziaria SpA v OHIM*[9], the CJEU considered the opposite argument: that a number of registrations of similar marks in the name of the same opponent *increased* the likelihood of confusion. The court rejected that saying that:

> "62. While it is true that, in the case of opposition to an application for registration of a Community trade mark based on the existence of only one earlier trade mark that is not yet subject to an obligation of use, the assessment of the likelihood of confusion is to be carried out by comparing the two marks as they were registered, the same does not apply where the opposition is based on the existence of several trade marks possessing common characteristics which make it possible for them to be regarded as

[8] See, for example, TREAT [1996] RPC 281

[9] Case C-234/06

part of a 'family' or 'series' of marks.

> 63 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 within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon* v *OHIM*, paragraph 55, and, to that effect, *Canon*, paragraph 29). Where there is a 'family' or 'series' of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.
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> 64 As the Advocate General stated at paragraph 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a 'family' or 'series', the earlier trade marks which are part of that 'family' or 'series' must be present on the market (emphasis added).

28. It is therefore well established that the mere existence of similar marks on trade mark registers neither increases nor decreases the likelihood of confusion between one such mark and another trade mark in a different ownership. The 'state of the register' evidence is therefore of no weight.

29. Putting these considerations to one side, I turn to the relevant issue, which is whether the identity of the respective goods and services coupled with the level of similarity between the respective marks is likely to confuse relevant average consumers into believing that the marks at issue are the same, or used by the same party, or by economically linked parties.

30. The level of distinctiveness of the earlier mark is relevant to the likelihood of confusion. However, the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element of the marks that are similar[10]. In this case that is the words SPORTY TOTS and SportiTots, which are quite highly similar. I earlier found that these words are of average distinctiveness for most of the goods/services at issue, and that the device element of the proprietor's mark tends to contribute to the impression created by these words, rather than to create a separate impression. The device element of the proprietor's mark is therefore a weak distinguishing element.

31. The proprietor's best case is based on the use of the marks in relation to sporting goods and services, where the distinctiveness of the words at issue is below

[10] *Kurt Geiger v A-List Corporate Limited*, BL O-075-13

average. That fact alone does not preclude a likelihood of confusion. As the CJEU pointed out in *L'Oréal SA v OHIM*[11]:

> "45. The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders."

32. Given the identity of the goods/services, and the quite high level of similarity between the marks, I find that there is a likelihood of confusion, even for the goods/services for which the earlier mark is less than averagely distinctive. In particular, as the respective marks create a similar overall impression it is likely that an average consumer of sporting goods/services will imperfectly recollect one of the marks as being the other, notwithstanding the visual differences that are apparent when the marks are compared side by side. Further, even if average consumers are aware that the marks are different, there is a likelihood of indirect confusion (or 'association' to use the word in the Act). As Mr Iain Purvis Q.C. explained in *L.A. Sugar Limited v By Back Beat Inc.*[12]*:*

> "Indirect confusion.....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."

33. I find that there is a strong likelihood of that happening here. Mr McDonald accepted the theoretical possibility of this kind of confusion, but argued that it was unlikely in this instance because the words SportiTots and SPORTY TOTS are spelt differently. That is true, but Mr McDonald's point depends too much on consumers seeing the marks side by side, or recollecting them perfectly, whereas the case law

[11] Case C-235/05 P
[12] Case BL-O/375/10

tells us that the average consumer will *"rely upon the imperfect picture of* [the marks] *he has kept in his mind"*.

33. Having found that there is a likelihood of confusion even where the earlier mark is of below average distinctiveness, it follows that there is also a likelihood of confusion for the other goods/services covered by the marks where the words SPORTY TOTS/SportiTots have an average degree of distinctive character. That finding also applies when the marks are used in relation to goods and services likely to be selected with an above average level of care and attention, such as *'the bringing together, for the benefit of others, of a variety of common metals and their alloys, transportable buildings of metal, materials of metal for railway tracks'.* Even in this case, there are more factors pointing towards a likelihood of confusion than there are factors pointing the other way.

Outcome

34. I conclude that the application for invalidation succeeds for all the goods/services covered by the proprietor's trade mark registration. This may seem a harsh result given the proprietor's uncontested claim to be the first user of one these conflicting marks[13]. However, it reflects the fact that UK trade mark law (which is based on EU law) now gives priority to the 'first to file' an application to register a trade mark, subject only to the other party having an earlier common law right to its mark. In this case the proprietor has not pursued an application to invalidate the applicant's mark based on an earlier common law right. Indeed, given that the applicant also claims to have used its mark for some years prior to either party applying for registration, such a claim may not have been straightforward to pursue. In any event, as no application has been made to invalidate the earlier mark it must be treated as valid[14] and the proprietor's later filed trade mark cancelled.

[13] With potentially serious consequences: see *Firecraft v Focal Point Fires plc,* [2009] EWHC 2784 (Ch), but also s.11(3) of the Act.
[14] Per s.72 of the Act.

Costs

35. The applicant has been successful and is therefore entitled to a contribution towards its costs. The applicant has played only a limited role in the proceedings and this is reflected in the award of costs. I order Sportitots Limited to pay Sporty Tots Limited the sum of £500 to cover the cost of filing the application for invalidation and considering the counterstatement, including the official filing fee of £200 for the former document.

36. The sum of £500 should be paid within seven days of the expiry of the appeal period or within seven days of the conclusion of any appeal against this decision.

Dated this 24th day of October 2014

Allan James
For the Registrar