

O-491-21

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3475335
BY TALLIB NADIADI IN RESPECT OF THE FOLLOWING TRADE MARK**



IN CLASSES 8, 9 AND 16

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 420944 BY
ANCHOR INDUSTRIAL SAFETY**

Background and pleadings

1. Tallib Nadiadi (“the applicant”) applied to register the trade mark no. 3475335 in the UK on 16 March 2020. It was accepted and published in the Trade Marks Journal on 24 April 2020 in respect of the following goods:

Class 8: *Scrapers; Scrapers [hand tools]; Scrapers for floors and windows; Scrapers for skis; Glass scrapers [hand tools]; Hand-operated scrapers for removing ice from vehicle windows; Hand-operated scrapers for skinning fish; Paint scrapers [hand tools].*

Class 9: *Safety goggles.*

Class 16: *Paint brushes; Artists' paint brushes; Brushes for the application of paints; Handles made of plastics for paint brushes; House painters' roller brushes; Paint boxes and brushes; Painters' brushes.*

2. Anchor Industrial Safety (“the opponent”) opposes the trade mark on the basis of section 5(2)(b), section 5(3) and section 5(4)(a) of the Trade Marks Act 1994 (“the Act”). In respect of the ground based upon section 5(2)(b) and section 5(3), the opponent relies upon its earlier UK trade mark no. 2554322, the relevant details of which are shown below:

EQUIP

Filing date: 28 July 2010

Registration date: 7 January 2011

Class 9: *Personal protective equipment; respirators and respiratory masks (other than for artificial respiration); respirators for filtering air; filters for respiratory masks; opto-electronic masks; protective optical instruments; spectacles, correcting lenses, protective masks for the eyes; welders' screens; screens, films, filters and sheets for protecting face and eyes from accidents, ultraviolet radiation and laser beams for workers; safety helmets; hearing*

protection devices, namely earmuffs, earplugs and headbands; automatic dispensers for ear protection devices; safety equipment and equipment for protection against falls; anti-fall devices for workers (apparatus for protection against accidents); safety maintaining devices (other than for vehicle seats and sports equipment); safety belts (other than for vehicle seats); fire lines, safety straps, rescue rope, lumbar belts and safety harnesses other than for vehicle seats or sports equipment; clothing, headwear and footwear (non-orthopaedic) for protection against accidents, irradiation and fire; accident protection suits; gloves for protection against fire, heat, accidents, x-rays and chemical and bacteriological hazards; welders' gloves; gloves for protection against mechanical actions; instruments and devices for controlling gas and test benches for independent breathing assistance apparatus; personal protection devices for accident prevention; protective helmets, caps and headgear.

Class 25: Clothing; footwear; headgear; gloves; boots, overshoes and overboots; footwear parts such as heels, soles and protective endpieces, removable or not, of leather, rubber or any other material; socks, boot liners, slippers, boots, half-boots, clogs (shoes), non-slipping devices for footwear; headgear; all kinds of bibs (not of paper) including of plastic and of non-woven fabric.

Class 35: *Inventory management; stock ordering; stock control.*

Class 39: *Storage of goods; delivery of goods.*

Class 42: Technical support services in the field of personal protective equipment.

(the underlined terms are relied upon for the section 5(2)(b) and section 5(3) grounds. The terms not underlined are relied upon for the section 5(3) ground only)

3. The opponent asserts that the respective marks are highly similar and that the respective goods/services are identical or highly similar. It claims that, as a result,

there is a risk of confusion on the part of the public and the application contravenes section 5(2)(b) of the Act.

4. In respect of the ground based upon section 5(3), the opponent asserts that its earlier mark has a reputation in respect of all the goods and services listed in its earlier mark. It also asserts that:

- a. The relevant public will believe that the goods and services provided under the respective marks originate from the same or linked undertaking because of the similarity between the respective marks;
- b. Use of the applicant's mark would take unfair advantage of its mark because it would unfairly trade off (or ride of the coat tails of) the significant reputation of the opponent's mark. The applicant's mark would benefit from the power of attraction, reputation and prestige associated with the opponent's mark;
- c. Use of the applicant's mark would result in detriment to the reputation of the opponent's mark (tarnishment) where the consumer is dissatisfied with the applicant's goods;
- d. Use of the applicant's mark would result in detriment to the distinctive character of the opponent's mark because its uniqueness and distinctiveness would be reduced by use, without due cause, of the applicant's mark.

5. In respect of the ground based upon section 5(4)(a), the opponent claims that it has the requisite goodwill and that its EQUIP sign has been used throughout the UK since 2009 in respect of a range of goods and services that correspond to the list of goods in Class 9 and services in Class 42 shown in paragraph 2, above. It asserts that, because of the highly similar marks and identical or related goods/services, use of the applicant's mark would constitute a misrepresentation leading to a real likelihood that damage, in the form of loss of sales or damage to reputation, would result.

6. The applicant filed a counterstatement denying the claims made and requesting that the opponent provides proof of use of its earlier trade mark.

7. The parties both filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary.

8. Both sides also filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following careful consideration of the papers.

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 Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

Evidence

10. The opponent's evidence-in-chief takes the form of the witness statement of Martyn Tydeman, a founder and member of the opponent, a partnership and owner of the earlier mark. Mr Tydeman is also director of Anchor Safety LLP, a related company that uses the earlier mark with the consent of the ownership. For convenience, when I refer to the evidence of Anchor Industrial Safety Ltd's activities I will refer to it as the activities of "the opponent". Exhibits MT1 - 8 are provided with this witness statement.

11. The applicant provided documents during the evidence rounds entitled "Applicant Statement Overview" and "Applicant Evidence Notes". These documents contain numerous criticisms of the opponent's evidence and, therefore, are in the form of submissions (arguments) rather than in the form of evidence of fact.

12. The opponent's reply evidence consists of a second witness statement of Mr Tydeman and Exhibits MT 2.1 – MT 2.4.

13. The applicant also provided final written submissions. A preliminary view was issued that some of these submissions consisted of evidence and would be ignored for the purpose of my decision. At the subsequent case management conference, I

took the view that the applicant's comments amounted to no more than submissions and admitted them into proceedings.

DECISION

Proof of use

14. The relevant statutory provisions are as follows:

Section 6A:

“(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the 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 Community.

(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.”

15. Section 100 of the Act states that:

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

16. 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 Bunderversvereinigung 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].

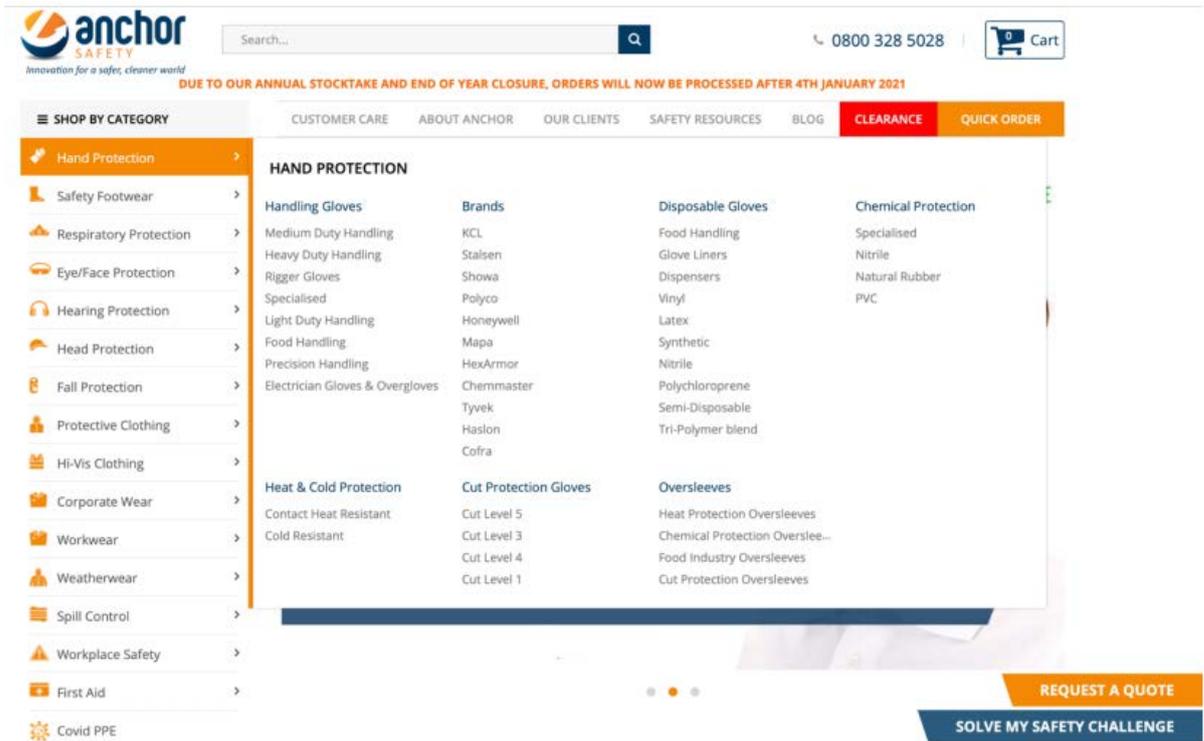
(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

17. The relevant aspects of the opponent’s evidence can be summarised as follows:

- Mr Tydeman’s company has used the EQUIP mark in respect of his companies “wide range of products for workers, primarily safety products, but also including general workwear”.¹ He states that EQUIP is used as a sub-brand under his company’s overarching ANCHOR house branding.²
- Exhibit MT1 consists of 16 screenshots of Mr Tydeman’s company website, sourced on 23 December 2020. They illustrate a range of work wear and safety equipment but the EQUIP mark does not appear and, further, as shown in the example below, each page shows a list of third party brands for each list of available goods:

¹ Mr Tydeman’s first witness statement (“WS1”), para 5

² Ditto, para 7



- The EQUIP mark has been used since at least 2012.³
- A number of screenshots exhibited have the following banner appearing at the bottom of the page⁴:



- Mr Tydeman states that “[t]he EQUIP mark is ‘used’ in respect of a wide array of products, all combined into one easy to use, tailored package”⁵
- He explains that the “package” comprises:
 - a large array of products broadly matching those generally available under the house “ANCHOR” brand.⁶
 - A platform that acts as a stock management, control and ordering portal for companies and a tailored advice platform for individuals.⁷

³ Ditto, para 8

⁴ See Exhibit MT2

⁵ Ditto, para 9

⁶ Ditto

⁷ Ditto

- Mr Tydeman states that “[t]he mark is therefore in use in respect of a stock management ordering system ...and a technical support and advisory service ...”
- A screen shot obtained on 23 December 2020, from equiponlineco.uk, is provided⁸ showing a list of PPE equipment but does not show the earlier mark (or any other mark).
- A copy of what appears to be a PowerPoint presentation (or similar) is provided⁹. The first two pages are shown below:



⁸ At Exhibit MT3

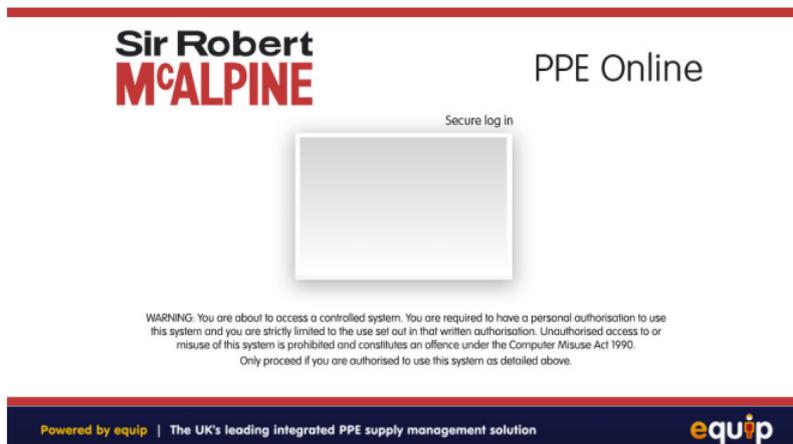
⁹ At Exhibit MT4

- The presentation relates to an “integrated PPE supply management solution” marketed under the name “equip”. This appears to operate by a client having a “virtual warehouse” from which it can use the “equip online ordering system” for any stock in the virtual warehouse. “Equip lockers are also provided at the client’s location with stock that reflects its particular requirements and the client has access to the opponent’s internal stock management software. The presentation includes a number of references to “equip” e.g. “equip is the UK’s leading integrated PPE supply management solution and the benchmark for a PPE programme of excellence”¹⁰.
- The list of clients using the equip platform is increasing and includes¹¹:
 - Brenntag, a global chemical distribution company that first ordered products through the equip platform in 2012;
 - Associated British Ports, owner of 21 UK ports and with over 17,000 employees;
 - Calor, one of the UK’s largest suppliers of liquid petroleum gases.
- A non-exhaustive list of current clients is also provided¹² showing 17 including the three listed above.
- Screenshots of bespoke login pages for 59 clients. These pages are co-branded with the clients branding and the “equip” branding as shown in the example below and include the same banner shown in the fourth bullet point, above:

¹⁰ See page 5 of Exhibit MT4

¹¹ WS1, para 11

¹² At Exhibit MT6



- The following revenue figures “from sales under EQUIP mark” are provided¹³

Year	Revenue
2013	£500,691
2014	£805,817
2015	£1,403,857
2016	£1,413,357
2017	£2,363,757
2018	£2,601,709
2019	£2,988,806
2020	£3,079,844

- A list of many thousands of order records are provided¹⁴ dated from 2011 to beyond the relevant date in these proceedings (16 March 2020). These relate to orders made through the opponent’s EQUIP system¹⁵.

18. The applicant’s submissions regarding this evidence can be summarised as follows:

¹³ WS1, para 13

¹⁴ At Exhibit MT8

¹⁵ WS1, para 16

- It is accepted that “Anchor Industrial Safety” is a PPE products distributor;
- Under the name “Anchor Safety”, it supplies a wide range of PPE products from many well-known manufacturers. These products are sold under the manufacturer’s branding and not as “Anchor Safety” or “Equip” products;
- For larger clients it has an order management portal under the name “equip solutions”. The name “equip” is not used as a mark in respect of any physical products;
- The evidence fails to illustrate use in respect of the classes of goods and services listed in the specifications of the earlier mark except *inventory management, stock ordering control* in Class 35;

19. Mr Tydeman responded to these criticisms in his reply evidence. He contested the applicant’s claim that the opponent does not sell first party products generally or under the EQUIP mark by providing evidence of the opponent’s HASLON and EISEN TECHNICAL branded goods. The issue is whether the opponent has demonstrated genuine use of its EQUIP mark in respect of goods. Use in respect of HASLON or EISEN TECHNICAL branded products does not address the issue and, therefore, this evidence does not improve the opponent’s claim to proof of use.

20. I agree with all of the applicant’s submissions. It is clear from the evidence of the opponent that there is no use of the EQUIP mark shown in respect of any goods. In fact, as the applicant submits, the screenshots of the opponent’s web site show that it offers only goods with third party branding. These third party brands are identified on its website, as exemplified in the screenshot reproduced at the second bullet point of paragraph 17, above. Whilst the reply evidence does show use in respect of two of the opponent’s own marks in respect of goods, no use is shown in respect of “equip”. I conclude that the evidence fails to support any genuine use of its “equip” mark in respect of the opponent’s relied upon goods in classes 9 and 25.

21. The applicant accepts that the evidence illustrates genuine use in respect of *inventory management, stock ordering control*. This is relevant insofar as the opponent’s case is based upon section 5(3) because it claims a reputation in respect

of these services. However, these services are not relied upon by the opponent in respect of the grounds based upon section 5(2)(b) (as shown in the answer to Q1 on page 5 of the Form TM7). Fair protection is achieved by permitting the opponent to retain this category of services¹⁶ rather than the particular example shown in the evidence (where use in respect of this category of services is shown in respect of only safety clothing, footwear and apparatus). Therefore, use has been demonstrated in respect of *inventory management, stock ordering control*.

22. The opponent also relies upon *Storage of goods; delivery of goods*, however, the evidence does not support use of the mark “equip” in respect of these. Mr Tydeman does talk about clients having a “virtual warehouse” but this appears to be nothing more than the stock ordering system providing a tailored list of goods of interest to the client. Whilst the opponent does store goods in its warehouse this is to support the provision of its own services rather than as it being a service offered to third parties. Similarly, in respect of *delivery of goods*, there delivery of goods ordered through its stock ordering control service is the delivery of the goods TO the client rather than providing delivery services FOR the client. Consequently, I conclude that there is no evidence of genuine use in respect of either *storage of goods* or *delivery of goods*.

23. In respect of *technical support services in the field of personal protective equipment* in Class 42. Mr Tydeman has stated that the “equip” platform acts as a stock management, control and ordering portal for companies and a tailored advice platform for individuals. However, there is no corroborative evidence to support the claim in respect of a “tailored advice platform for individuals”.

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

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is

¹⁶ See *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10

all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

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

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

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

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

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

26. Keeping in mind this guidance, whilst Mr Tydeman has made a statement that the mark has been used in respect of *technical support services in the field of personal protective equipment*, the absence of corroborative evidence in circumstances where it would be easy to provide leads me to find that the evidence is insufficient to demonstrate genuine use in respect of such services. The revenue figures provided are not insubstantial but, once again, they lack specificity and it is not possible to conclude that they relate, in part, to technical support services, therefore, they cannot illustrate or support the claim (made in response to Q3a of the Form TM7) to use by the opponent.

27. The evidence shows a logo version of “equip” and also, in the banner appearing at the bottom of many of the pages from the opponent’s website, un-stylised use of the word. Whilst this evidence of use of the mark, as registered, is far from overwhelming, I conclude that the evidence is sufficient to demonstrate genuine use of the registered mark

28. Taking all of the above into account, I conclude that the evidence fails to establish genuine use of the opponent’s “equip” mark in respect of any of the goods or services relied upon except:

Class 35: *Inventory management, stock ordering control.*

29. The significance of this is that the opponent:

- (i) has failed to demonstrate genuine use of its earlier mark in respect of any of the goods and services relied upon for its section 5(2)(b) grounds and is not entitled to rely upon this mark for the purposes of these grounds.
- (ii) Is entitled to rely upon these services, insofar that I am satisfied that the requisite reputation has been demonstrated, for the purposes of its ground based upon section 5(3).

Section 5(2)(b)

30. In light of my finding in respect of proof of genuine use, the opponent is not able to rely upon its earlier mark in respect of any goods or services relied upon for this ground. Consequently, the opposition fails insofar as it relies upon the ground founded upon section 5(2)(b) of the Act.

Section 5(3)

31. Section 5(3) of the Act states:

“(3) A trade mark which-

- (a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.

32. Section 5(3A) states:

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected”.

33. Section 5A states:

“5A. [...] Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only”.

34. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

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

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

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

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the

section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

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

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

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74* and the court's answer to question 1 in *L'Oreal v Bellure*).

35. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Secondly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the later mark. Thirdly, assuming that the first and second conditions have been met, section 5(3) requires that one or more of the types of damage claimed will occur and/or that the contested mark will, without due cause, take unfair advantage of the reputation and/or distinctive character of the reputed mark. It is unnecessary for the purposes of section 5(3) that the goods and services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

Reputation

36. The contested application was filed on 16 March 2020 and this is the relevant date in these proceedings and the date when I must judge if the opponent's mark had the requisite reputation.

37. The evidence illustrates use in respect of the opponent's "equip" programme rising consistently from just over £500,000 in 2013 to nearly £3 million in 2019, the last full year before the relevant date. In addition, the evidence illustrates that at least 59 commercial customers use the "equip" programme, many of them being large organisations. Such a scale of business is not particularly large when considering the self-evident large size of the market in which the opponent operates, however, I conclude that it is sufficient to demonstrate that a significant part of the relevant public will recognise the mark and find that it has a modest reputation in respect of *inventory management and stock ordering control, all relating to safety products*.

38. This is a narrower range of services than for which the opponent is able to rely upon following my findings regarding genuine use because, for those purposes, it was only necessary to identify the category of services rather than the actual services for which the opponent's mark has a reputation.

The Link

39. Having found that the opponent has demonstrated that it has the requisite reputation, I now consider if the requisite link exists. My assessment of whether the public will make this mental ‘link’ between the respective marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

40. The respective trade marks are shown below:

Opponent’s Earlier Mark	Applicant’ Mark
equip	

41. The respective marks both include the word “equip”/“EQUIP” and, therefore, they share at least some similarity. It is the only element of the opponent’s mark and one of a number of elements of the applicant’s mark. The word “EQUIP” is, however, the dominant element of the applicant’s mark with both the device and the word “TRADE” playing a lesser role. I conclude that the respective marks share a medium level of visual similarity. The opponent’s mark consists of the two syllables E-QUIP whereas the applicant’s mark consists of the three syllables E-QUIP-TRADE and I find that the level of aural similarity is somewhere between medium and high. Conceptually, the word “equip” is a verb meaning to “supply with the necessary items for a particular purpose”¹⁷. This meaning is present in both marks but the applicant’s mark also

¹⁷ [Search Results for equip - Oxford Reference](#)

includes the word “TRADE”, meaning “the action of buying and selling goods and services”. This creates a concept absent in the opponent’s mark. Taking account of this I conclude that the marks share a medium level of conceptual similarity.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

42. In considering this issue, I keep in mind that similarity between the respective goods and services is not a requirement for success under section 5(3) but that, nevertheless, it is a relevant factor and a greater similarity may increase the likelihood that detriment or unfair advantage will exist. In considering similarity, I keep in mind the guidance provided in *Canon*, Case C-39/97, *Treat case*, [1996] R.P.C. 281, *Kurt Hesse v OHIM*, Case C-50/15 P, *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06 and *Sanco SA v OHIM*, Case T-249/11 that were cast in the context of similarity between goods and services for the purposes of section 5(2) but also have application here.

43. In respect of the applicant’s *Scrapers; Scrapers [hand tools]; Scrapers for floors and windows; Scrapers for skis; Glass scrapers [hand tools]; Hand-operated scrapers for removing ice from vehicle windows; Hand-operated scrapers for skinning fish; Paint scrapers [hand tools]* in Class 8 and its *Paint brushes; Artists’ paint brushes; Brushes for the application of paints; Handles made of plastics for paint brushes; House painters’ roller brushes; Paint boxes and brushes; Painters’ brushes* in Class 16, there is no obvious similarity to the opponent’s *Inventory management, stock ordering control relating to safety products*. Inventory management and stock ordering control is a service to assist users manage their stock and ordering processes. On the other hand, the applicant’s goods are physical in nature and used primarily to paint or scarp a surface clean or remove an unwanted surface layer. Therefore, they are different in nature and purpose. Similarly, their methods of use are different with the opponent’s services being accessed online or by telephone whereas the applicant’s goods are predominantly hand-held apparatus. The respective goods are not indispensable or important for

the use of the other in such a way that customers may think that the responsibility for both the goods and services lies with the same undertaking. Consequently, they are not “complementary” in the sense described in *Boston Scientific*. Neither are the respective goods and services in competition with each other. Finally, the respective goods and services do not normally share trade channels. Certainly, there is nothing before me to indicate otherwise and it is not obvious to me that these goods would normally be provided by the same trader as would provide the opponent’s services. Taking all of this into account, I conclude that these goods and services share no similarity.

44. In respect of the applicant’s *safety goggles* in Class 9, similar considerations exist in respect of the nature, purpose, method of use and whether the respective goods and services are in competition or whether they are complementary. However, in respect of trade channels, the position is different. The applicant’s safety goggles are not limited to use in a particular field of activity. Consequently, the term includes products used in the same fields of activity as the good that are the subject of the opponent’s *inventory management, stock ordering control relating to safety products*. I conclude that, whilst there is some similarity, it is no more than very low.

The strength of the earlier mark’s reputation

45. I have found that the opponent’s mark has a modest reputation in respect of *inventory management and stock ordering control all relating to safety products*.

The degree of the earlier mark’s distinctive character, whether inherent or acquired through use

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular

undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

47. The opponent's mark consists of the single word "equip" that, as I noted earlier, means "supply with the necessary items for a particular purpose". Invented words that create no message in respect of the goods and services for which they are used are considered to have a high level of distinctive character. On the other hand, ordinary dictionary words that are readily understood by the relevant public are likely to have a lower level of inherent distinctive character especially where the word may serve an allusive function. In the current case, the opponent's mark is a readily understood dictionary word and, is also allusive of the purpose of the opponent's services and is endowed with a reasonably low level of inherent distinctive character.

48. In respect of whether the opponent's mark benefits from an enhanced level of distinctive character, I note that the mark has been used over a period of over 6 years prior to the relevant date, that turnover has been growing and now exceeds £3 million a year and that the opponent has some large corporate clients. However, there is no indication of what proportion of the market share this is. The evidence does suggest that use of the mark has been reasonably intensive with many thousands of orders being evidenced. The implication from the number of customers and the size of some of them is that there is a broad geographic scope of use of the mark in the UK. Finally,

there is no evidence regarding the amount invested in promoting the mark. Taking all of this together, if there is any enhancement to the distinctive character of the opponent's mark it is not to any significant level.

Whether there is a likelihood of confusion

49. In Case C-408/01, *Adidas-Salomon*, the CJEU held that:

“28. The condition of similarity between the mark and the sign, referred to in Article 5(2) of the Directive, requires the existence, in particular, of elements of visual, aural or conceptual similarity (see, in respect of Article 5(1)(b) of the Directive, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23 in fine, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraphs 25 and 27 in fine).

29. The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23).”

50. The respective marks share the common element “equip”/“EQUIP”, however, the visual differences created by the logo elements of the applicant's mark make it unlikely that one mark will be confused for the other and there is no likelihood of direct confusion. The opponent's services are *inventory management* and *stock ordering control all relating to safety products*. Whilst there is some evidence that the opponent provides own branded products through its “equip” stock ordering system in respect to both third party and own branded safety goods, it is not obvious to me (and there is no evidence) that it is common in the trade to provide both under a common mark. With this in mind, together with the relatively weak level of distinctive character of the opponent's mark and no, or only a very low level of similarity, between the respective goods and services, I conclude that, a member of the relevant public upon encountering, for example, *safety goggles* sold under the applicant's mark, is not likely

to assume that they originate from the same or a linked undertaking as that providing *inventory management* and *stock ordering control* in the field of safety products.

51. It is necessary for the public, when confronted with the later mark, to make a link with the earlier reputed mark in the sense that it calls the earlier mark to mind. This is a lower hurdle than required to demonstrate a likelihood of confusion. There is no requirement for the relevant public to be confused but, rather, it is sufficient that the earlier mark is called to mind. Nevertheless, if the relevant consumer makes any connection at all between the two marks, it is likely to be so fleeting that there will be no detriment or unfair advantage arising. Therefore, in this instance the requisite link does not exist.

52. As a consequence of this finding, it is not necessary that I continue to consider the opponents case in respect of detriment and unfair advantage and the ground based upon section 5(3) fails.

Section 5(4)(a)

53. Section 5(4)(a) states:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

54. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of

application for registration of the trade mark or date of the priority claimed for that application.”

55. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

56. Halsbury’s Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

57. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, as the Appointed Person, endorsed the registrar’s assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

“43. In *SWORDERS TM O-212-06* Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’ ”

58. Goodwill must therefore be assessed at the filing date of the contested mark, namely, 16 March 2020.

59. I have already found that, in respect of the list of goods and services that correspond to the Class 9 goods and Class 42 services of the opponent's earlier mark, there has been no genuine use. Such a finding carries over to the issue of goodwill and I find that there is no goodwill demonstrated in respect of these goods and services. Consequently, the ground based upon section 5(4)(a) fails in its entirety.

Summary

60. The opposition fails in its entirety and the contested application may proceed to registration.

COSTS

61. The applicant has been successful and he would normally be entitled to a contribution towards his costs in accordance with the scale of costs published in Tribunal Practice Notice 2/2016. As a matter of practice, litigants in person are asked to complete a costs proforma. The purpose of this is to ensure that the costs awarded do not exceed the amount spent on the proceedings. The applicant was

sent a blank costs pro-forma on 17 March 2021, however, he has not submitted a completed claim and therefore, I make no award of costs.

Dated this 29th day of June 2021

For the Registrar