

O-553-14

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2621301A  
BY THE JOCKEY CLUB  
TO REGISTER THE TRADE MARK  
THE JOCKEY CLUB  
IN CLASSES 18 & 25  
AND  
IN THE MATTER OF APPLICATION No. 2621303  
BY THE JOCKEY CLUB  
TO REGISTER THE SERIES OF TWO TRADE MARKS**



**IN CLASSES 18 & 25  
and**

**IN THE MATTER OF CONSOLIDATED OPPOSITIONS  
THERE TO UNDER No. 104177A AND 400841 BY  
JOCKEY INTERNATIONAL INC.**

## BACKGROUND



1) On 17 May 2012, The Jockey Club (hereinafter the applicant) applied to register a series of two marks for a number of goods and services. The application was examined, amended and accepted, and subsequently published for opposition purposes on 31 August 2012 in Trade Marks Journal No.6955. On 12 February 2013 the applicant requested that one mark in the series be deleted and that the remaining mark THE JOCKEY CLUB be split into two parts with goods in classes 18 & 25 in part A and goods and services in Classes 9, 35, 36, 41 & 43 in part B. The goods in class 25 were also amended. Part B was not opposed and was registered on 8 March 2013. The specification of mark 2621301A was amended again on 18 December 2013 and the opposition against Class 18 goods was withdrawn by the opponent. At the date of the hearing the class 25 specification for which the mark THE JOCKEY CLUB is sought to be registered, and which is opposed, is as follows:

**Class 25:** Formal shirts; collared shirts; tailored shirts; fitted shirts, buttoned shirts; chinos; twill trousers; cord trousers; waxed trousers; fitted trousers; tailored trousers; formal trousers; tweed trousers; canvas jeans; formal jackets; tailored jackets; blazers; waxed jackets; quilted jackets; waterproof jackets; tweed jackets; wind jackets; waistcoats; gilets; body warmers; coats; trench coats; overcoats; tweed coats; duffle coats; morning jackets; morning suits; tweed suits; belts [clothing]; Braces [suspenders]; ties; pocket squares; scarves; gloves; footwear; shoes; boots; headgear; formal hats; panama hats; sun hats; sun hats and sun caps; fedora hats; trilby hats; tweed hats; wool hats; cashmere hats.

2) On 30 November 2012 Jockey International Inc. (hereinafter the opponent) filed a notice of opposition, subsequently amended. The grounds of opposition are, in summary:

a) The opponent is the proprietor of the following trade marks:

| Mark   | Number  | Date of application / registration | Class | Relevant Specification   |
|--------|---------|------------------------------------|-------|--|
| JOCKEY | 2133883 | 27.05.97<br>14.04.98               | 18    | Carrying cases, bags, shoulder bags, travelling bags, cases for sporting articles, but not including any such goods relating to horses or horse riding.  |
| JOCKEY | 2154295 | 22.12.97<br>21.08.98               | 25    | Leisurewear and sportswear; jerseys, sweaters, pullovers, shirts, sweat shirts, sports shirts and T-shirts; shorts, trousers and jackets; but not including any of the aforesaid goods adapted for wear while horse riding; articles of underclothing; nightwear and swimwear; vests, pants; pyjamas and housecoats. |
| JOCKEY | 1310623 | 20.05.87<br>30.07.93               | 25    | Articles of underclothing, t-shirts; all included in Class 25.   |
| JOCKEY | 1094181 | 17.04.78                           | 25    | Pants (being articles of underclothing) for men.   |
| JOCKEY | 881688  | 08.07.65                           | 25    | Vests for men; sweaters, sweat shirts, sports shirts, sports shorts (outerwear) and swimwear, being articles of clothing;  |

|  |                |   |    |  |
|--|----------------|---|----|--|
| JOCKEY   | CTM<br>191494  | 01.04.96<br>11.05.98  | 25 | but not including vests for boys.<br>Articles of underclothing; nightwear; leisurewear; sportswear and swimwear; vests, pants; jerseys; sweaters; pullovers; shirts; sweat shirts; sports shirts and T-shirts; shorts; jackets; pyjamas and housecoats; hats and caps.   |
| <br>JOCKEY  | CTM<br>4138541 | 23.11.04<br>22.02.06<br><br>Priority date of<br>07.10.04<br>claimed from<br>USA | 25 | Underwear tops and bottoms; shorts, shirts; active wear for men, namely boxer shorts, bicycle shorts, gym shorts, pants, pullovers, sport shirts, sweat pants, sweat shirts, sweat shorts, sweat suits, t-shirts, tank tops, long underwear; sleepwear; nightwear; pyjamas; robes; night and sleeping gowns; hats and clothing caps; jackets; pants; and slacks; swimwear, namely swimsuits, swim trunks and swim shorts.  |
| <br>JOCKEY<br><br>The design portion of the mark consists of a circle with three equally spaced curved lines emanating therefrom; each curved line ends in a closed semicircle. | CTM<br>6894042 | 07.05.08<br>05.06.09  | 25 | <b>Underwear tops and bottoms; shorts; shirts;</b> active wear, namely, boxer shorts, bicycle shorts, gym shorts, pants, pullovers, sport shirts, sweat pants, sweat shirts, sweat shorts, sweat suits, t-shirts, tank tops, jogging suits, warm-up suits; <b>long underwear; thermal underwear;</b> union suits; <b>sleepwear; nightwear; pajamas; robes;</b> panties; bras; all-in-ones in the nature of camisoles with built-in bras; camisoles; foundation garments; crop tops; socks; stockings; tights; hosiery; blanket sleepers; <b>loungewear;</b> gowns; playwear and coordinated separates, namely, creepers, multi-piece sets, overalls, shortalls, coveralls, jumpers, dresses, shirts, sweaters, pants, sweat suits, mitts, headbands, hats, booties, shorts; one-piece underwear; cloth training pants; cloth diaper vests; layettes consisting of one or more of the following: gowns, kimonos, sleep sacks, two-way sleepers, caps, booties, socks, slippers, mittens, bibs, pram suits, blankets, wash cloths, hooded towels, towels, bath mitts, robes, security blankets, burp cloths, cloth diapers, vinyl pants, diaper covers, diaper liners.<br><i>[Items in bold are those which have not been surrendered. See paragraph 16 below]</i> |

- b) The opponent contends that the marks and goods of the two parties are identical and/or similar such that it will lead to confusion in the minds of the average consumer as to from which party the goods originate. The mark in suit offends against section 5(2)(b) of the Act.
- c) The opponent claims that it has reputation in the marks and specifications shown below. It contends that use of the mark in suit would take unfair advantage of the reputation and be detrimental to it as the relevant public will believe that the goods are from the same or associated undertakings. Use of the mark in suit would free ride on the investment by the opponent in its brand. It is also claimed that use of the mark in suit will dilute the opponent's marks. The mark in suit therefore offends against Section 5(3) of the Act on the basis of use of:

2154295: Leisurewear and sportswear; jerseys, sweaters, pullovers, shirts, sweat shirts, sports shirts and T-shirts; shorts, trousers; but not including any of the aforesaid goods adapted for wear while horse riding; articles of underclothing; nightwear; vests, pants; pyjamas and housecoats.

1310623: Articles of underclothing, t-shirts; all included in Class 25.

1094181: Pants (being articles of underclothing) for men.



881688: Vests for men; sweaters, sweat shirts, sports shirts, being articles of clothing.

191494: Articles of underclothing; nightwear; leisurewear; sportswear; vests, pants; jerseys; sweaters; pullovers; shirts; sweat shirts; sports shirts and T-shirts; shorts; pyjamas and housecoats.

4138541: Underwear tops and bottoms; shorts, shirts; active wear for men, namely boxer shorts, pants, pullovers, sport shirts, sweat pants, sweat shirts, sweat shorts, sweat suits, t-shirts, tank tops, long underwear; sleepwear; nightwear; pants and slacks.

6894042: Underwear tops and bottoms; shorts; shirts; long underwear; thermal underwear; sleepwear; nightwear; pyjamas; robes; loungewear.

- d) The opponent contends that it has reputation in the marks shown below. It is claimed that use of the mark in suit would mislead consumers into believing that the applicant's goods originate from the opponent or from an economically linked undertaking causing damage to the opponent's goodwill. The mark in suit offends against Section 5(4)(a) of the Act.

|      | Mark  | First use. |
|------|---|------------|
| i)   | JOCKEY  | 1940s      |
| ii)  |  | March 2012 |
| iii) |  | July 2006  |

3) On 8 February 2013 the applicant filed a counterstatement, denying all the grounds and putting the opponent to strict proof of use on a number of its marks, although it did accept that the opponent had reputation for underwear.

4) On 17 May 2012, The Jockey Club (hereinafter the applicant) applied to register a series of two marks for a goods in classes 18 and 25, amended on 26 September 2014. The application was examined and accepted, and subsequently published for opposition purposes on 12 July 2013 in Trade Marks Journal No.2013/028. The series of two marks are as follows:



The goods for which the marks are sought to be registered, which are opposed, are:

Class 25: Formal shirts; collared shirts; tailored shirts; fitted shirts; buttoned shirts; chinos; twill trousers; cord trousers; waxed trousers; fitted trousers; tailored trousers; formal trousers; tweed trousers; canvas jeans; formal jackets; tailored jackets; blazers; waxed jackets; quilted jackets; waterproof jackets; tweed jackets; wind jackets; waistcoats, gilets; body warmers; coats; trench coats; overcoats; tweed coats; duffle coats; morning jackets; morning suits; tweed suits; belts [clothing]; braces [suspenders]; ties; pocket squares; scarves; gloves; footwear; shoes; boots; headgear; formal hats; panama hats; sun hats and sun caps; fedora hats; trilby hats; wool hats; cashmere hats.

5) On 12 September 2013 the opponent filed a notice of opposition identical to that set out above. The applicant filed a counterstatement on 18 November 2013 denying the grounds and putting the opponent to proof of use on certain of its claimed earlier rights. On 19 February 2014 the two oppositions were consolidated and the evidence already filed adopted into both cases. The opponent withdrew its opposition to the goods in Class 18 on 6 August 2014.

6) Both sides filed evidence. Both parties seek an award of costs in their favour. The matter came to be heard on 29 September 2014. At the hearing, the opponent was represented by Ms Clark of Counsel instructed by Messrs Dehns; whilst the applicant was represented by Mr Norris of Counsel instructed by Messrs Reddie and Grose LLP.

## **OPPONENT'S EVIDENCE**

7) The opponent filed a witness statement, dated 14 June 2013, by Tony Joseph Harings the opponent's Director, International Finance, a position he has held since June 2009, having worked for the opponent since 2002. He states that he has had day to day involvement in the opponent's European business since 2002 and his statement comes from his own knowledge and also the opponent's records. He provides a history of the business which is not relevant to these proceedings. He states that whilst the company sells a range of products, underwear accounts for over 50% of sales in the UK, with sales of nightwear and sportswear also being significant. He states that many of the products within the underwear and nightwear designations can be worn as sports or lounge wear. The company makes clothing for men and women as well as accessories such as bags. He states that the products are distributed to retailers throughout the UK and Europe by main distributors whose contact details are provided in the various brochures. He states that the company's German distribution centre deals with retailers in the UK and that there are approximately 360 retailers throughout the UK who have been supplied with JOCKEY products in each year during the period 2007-2012 inclusive. In addition there are numerous retailers who have received JOCKEY products during part of this period. During the period 2007-2012 approximately 950

outlets in the UK were supplied with JOCKEY products. Mr Harings provides the following table for articles sold in the UK:

| Division   | 2007   | 2008   | 2009   | 2010   | 2011   | 2012   |
|------------|--------|--------|--------|--------|--------|--------|
| Nightwear  | 504    | 1998   | 2948   | 4370   | 9502   | 11580  |
| Socks      | 389    | 27     | 0      | 0      | 0      | 0      |
| Sportswear | 449    | 4352   | 6304   | 4799   | 4484   | 5378   |
| Underwear  | 210668 | 307173 | 314146 | 307890 | 299982 | 290206 |
| Women      | 0      | 0      | 7533   | 14701  | 0      | 0      |
| Total      | 212010 | 313550 | 330931 | 331760 | 313968 | 307164 |

8) Mr Harings provides further details of what the above table contains by stating how many garments were sold during the period 2008-2011 inclusive in the UK:

|                             |        |
|-----------------------------|--------|
| Pullovers                   | 963    |
| Cardigans                   | 201    |
| Sweatshirts                 | 443    |
| Tank tops                   | 325    |
| Loungewear tops and bottoms | 77     |
| Swim shorts                 | 5591   |
| Pyjamas                     | 211000 |
| Bath robes                  | 12900  |
| Polo shirts                 | 2068   |

9) He also claims that the opponent has sold “many” shirts, and hundreds of thousands of vests and pants. He provides some approximate figures for the value of sales which are confidential and contained in the attached annex A. Mr Harings also provides a table for JOCKEY garments sold in Germany as follows:

| Division   | 2008    | 2009   | 2010   | 2011   | 2012   |
|------------|---------|--------|--------|--------|--------|
| Nightwear  | 106676  | 94084  | 99285  | 100942 | 142489 |
| Socks      | 184     | 1148   | 6114   | 0      | 0      |
| Sportswear | 155121  | 101744 | 46784  | 41767  | 33644  |
| Underwear  | 738852  | 726010 | 685451 | 699574 | 543548 |
| Women      | 7003    | 5993   | 16617  | 185    | 27     |
| Total      | 1007836 | 928979 | 854251 | 842468 | 719708 |

10) Mr Harings provides further details of what the above table contains by stating how many garments were sold during the period 2008-2011 inclusive in Germany:

|                             |        |
|-----------------------------|--------|
| Pullovers                   | 165909 |
| Cardigans                   | 25138  |
| Sweatshirts                 | 79598  |
| Tank tops                   | 20553  |
| Loungewear tops and bottoms | 455362 |

|             |        |
|-------------|--------|
| Swim shorts | 48751  |
| Bath robes  | 199275 |
| Polo shirts | 617000 |

11) He also claims that the opponent has sold hundreds of thousands of vests, pants, shirts, pyjamas and T-shirts. He states that the mark JOCKEY has been used in the UK since 1938 in relation to underwear and latterly in relation to other garments. He states that the mark appears upon labels sewn into the garments e.g. neck labels, on the outside of garments such as on the waistband of underwear, on swing tags, display stands and brochures. He states that the brochures are used by sales representatives, and they are used by retailers to place orders. The purchasing public can also use these brochures to order items. He states that the JOCKEY brand is promoted via *FaceBook*, *Twitter* and *youtube*, and that it also receives many mentions in the media. He provides some instances of advertising in the UK such as advertising in, inter alia, the *Evening Standard* magazine in 2011, *The Sports Review* in 2010, the *Rugby 6 Nations Champions Magazine* in 2008 and *The Rugby World Cup Guide* in 2011. He also provides the following exhibits:

- TJH4: Copies of the company's Never Out of Stock (NOS) brochures, dated between July 2007 and Spring/Summer 2012. This includes use of the CTM 4138541 mark on men's underwear on the 2007 catalogue only. The other catalogues show use of the trade mark CTM 6894042 in respect of underwear, T-shirts, socks, swimwear, jumpers, shirts, jogging/sweat suits, shorts, caps; pyjamas and dressing gowns. They also show use of the word JOCKEY in respect of men's underpants (particularly on the waistband) and vests, also on packaging for same. The catalogues are clearly aimed at retailers as it also offers them the chance to purchase hangers, carrier bags and display fixtures with the word JOCKEY upon them. What is said to be use of the word JOCKEY on bags at pages 615 and 643 turns out to be the mock car licence plate "JKY1876" printed on the side of a bag. The page has mark CTM 6894042 upon it at the top. The same two bags are described in the opponent's table of proof of use as "bags"; "carrying cases"; "cases for sporting articles"; "holdalls"; "shoulder bags" and "travelling bags". It is clear that the term "housecoat" and "robe" refers to a dressing gown as the same description is used for a single item. The term "co-ordinated separates namely multi piece sets" is used to describe vest and pant sets as well as pyjamas. Similarly the term "jerseys" is used to describe a long sleeved vest. Roll neck shirts are described on the agents proof of use list as pullovers, sweaters and jumpers. The term "trousers" is applied to long legged underpants and pyjama bottoms. The term "jacket" is applied to a sweat top, and a jumper.
- TJH5: Seasonal brochures dated between Autumn/Winter 2006/07 and Spring/Summer 2012. These show use of the trade mark CTM 6894042 in respect of underwear; T-shirts; shorts; socks; swimwear; jumpers, cardigans & pullovers; sweatshirts and pants; hooded tops; shirts; caps; pyjamas and

dressing gowns. It also shows use of the word JOCKEY on the waistband of men's underwear and also on packaging for same.

- TJH6: Copies of "LOOK BOOKS" for underwear and nightwear for the period September 2010 to February 2012. These show use of the trade mark CTM 6894042 in respect of underwear and nightwear.
- TJH7: Two copies of "MOOD" brochures both from 2011. These show use of mark 2154295 in respect of swimwear, underwear, nightwear, T-shirts, sweatpants, sweat tops and shirts. There is a single use of a mark which has the words "JOCKEY INTERNATIONAL COLLECTION" and a globe device on a bag, underwear and on the brochure itself.
- TJH8: A list of approximately 360 retailers in the UK who were provided with JOCKEY products during the period 2007-2012 inclusive. These are located throughout the UK.
- TJH9: Copies of screenshots from the opponent's current UK website which provides information on UK retailers. These are dated 10 May 2013 and show use of CTM 6894042.
- TJH10 A breakdown of the product sales table shown in the above summary. This does not add much to the summary table.
- TJH13: Copies of invoices from Jockey GmbH to retailers in the UK dated between 1 January 2007 and 31 August 2012. These show use of trade mark CTM 6894042 in respect of underwear, T-shirts, shirts, swimwear and nightwear.
- TJH14: Copies of invoices from Jockey GmbH to retailers in Germany dated between 2008 and 2012. These invoices include bags. These show use of CTM 6894042 in respect of underwear, nightwear, shirts, and 19 bags. Also included are copies of invoices from Jockey GmbH to retailers in Austria dated between 2008 and 2011. These invoices include bags. These show use of CTM 6894042 in respect of underwear, shirts, nightwear
- TJH15: an internal brochure setting out packaging requirements used in the UK and Europe since 2010. This shows use of CTM 6894042 in respect of underwear and shirts. Also use of "Jockey International Collection" and a globe device in respect of underwear and nightwear.
- TJH16: Copies of press cuttings in which the opponent's products were mentioned. These date between 2004 and 2009 and include articles from, inter alia, Daily Mirror, Daily Star, Vogue, Daily Telegraph, Rugby World Magazine, The Times, GQ Magazine, which mention JOCKEY in respect of underwear and T- shirts. Also included are articles from German and Spanish magazines and newspapers dated 2009/2010 which shows use of the mark JOCKEY on

underwear. In this exhibit it was, for the most part impossible to see the date of the publication and I had to rely upon the groupings and dates written on by the opponent. I note that at page 67 which is supposed to date from 2010 the article, shown is from GQ Directory and the date shown on the actual photocopy of the magazine is November 2009.

- TJH17: Copies of marketing materials, which show use of CTM 6894042 in respect of underwear, in brochures dated 2010. Also provided are photographs of POS material, brochures, banners and advertising used around the world. These mostly use CTM6894042 in respect of underwear although there are photographs of swimwear, shirts and nightwear. There are also examples of advertising of the Jockey International Collection and globe device which appeared in an earlier exhibit.
- TH18: Copies of three pages from the Eire website of the opponent which is said to be like the UK website. These are dated May 2013.

**APPLICANT’S EVIDENCE**

12) The applicant filed a witness statement, dated 16 December 2013, by Christopher Thomas James Manners the applicant’s Group Brand Development Director, a position he has held since December 2012. He contends that a significant proportion of the population of the UK are aware of the applicant, and that the Jockey Club brand connotes history and prestige to the majority of those aware of the organisation. The applicant plays an important role on the sport of horse racing, which is the second largest spectator sport in the UK after Soccer. He states that the applicant owns a number of racecourses and is governed by a Royal Charter which means that all profits are invested back into horse racing. The Jockey Club was founded in 1750 and has been at the heart of horse racing in the UK ever since. Its role of policing the sport was handed over to the Horserace Regulatory Authority in 2006, but the Club owns racecourses, training grounds, runs the National Stud and also a charity to help all racing’s people in need. Its members include most of the Royal Family. He provides details of the other commercial activities of the applicant and its financial turnover, which in the years 2010-2012 has averaged approximately £135 million per annum. The applicant hosts three of the biggest sporting events each year, The Grand National, The Epsom Derby and the Cheltenham Festival. The popularity of horse racing is confirmed in reports by Deloitte in 2009 and 2013. He states that since 2007 the racecourses owned by the applicant included the strapline “A Jockey Club Racecourse” in its advertising. He provides information from Mintel Market Reports which shows that the UK clothing market in 2011 was worth £33.8 billion, whilst the UK underwear market in 2012 was worth £2.69 billion and the UK nightwear market £476 million in 2010. Research and Markets reports also provide the following figures:

|                           | 2008 US\$ Billion | 2009 US\$ Billion |
|---------------------------|-------------------|-------------------|
| Apparel retail in Germany | 74.9              | 78.7              |
| Menswear in Germany       | 22.7              | 24.2              |

|                          |       |       |
|--------------------------|-------|-------|
| Apparel retail in Europe | 420.9 | 384.1 |
| Menswear in Europe       | 130.0 | 121.4 |

## OPPONENT'S EVIDENCE IN REPLY

13) The opponent filed a witness statement, dated 5 August 2014, by Gavin Sinclair the Sales and Marketing Director of Jockey UK Co Ltd a wholly owned subsidiary of the opponent. He has held his position since October 2003. He points out that although the applicant was, until July 2007, the governing body of racing it now owns racecourses, operates training grounds and a horse breeding programme and is a commercial organisation, albeit still operating a welfare charity. He states that he was aware of the applicant as a horse racing regulatory body but not in any other context. He casts doubt on the claims by the applicant to be well known in the UK, and he states that he has not seen any of their advertising. He notes that the applicant undertook a rebranding exercise in 2013 and he therefore questions what the advertisements prior to the relevant date looked like and whether they were to promote horse racing or the brand.

14) He also points out that the term "CLUB" and also dates are used frequently by clothing manufacturers and he provides a number of examples at exhibits GS3 and 4 which I analyse below:

- GS3: Copies of website pages showing references to, inter alia, Billionaire Boys club Clothing; Charter Club Jewellery; Club Room Shirts; Nike club cuff pants; Nike Women's Club Boyfriend T-shirt; Henri Club Regular shirt; Lyle & Scott Club Polo Shirt; Lyle & Scott Club Cotton Crew Neck Jumper; Lyle & Scott Club Fine Striped Polo Shirt; iBlues Club; Linea Via Delle Perle Club; Babolat Club Line Boys Shorts; Oasis Geo Club Print Trousers; Aquascutum Club Check Placket Polo Shirt and Head Club Tennis skort juniors.
- GS4: Copies of website pages showing use of dates on clothing such as, Abercrombie & Fitch 1892; Levis Straus & Co 1853; California 73 Levis & Gap 1969 / GAP EST 1969.

15) That concludes my summary of the evidence filed, insofar as I consider it necessary.

## DECISION

16) I turn first to deal with the issue of partial surrender of many of the marks relied upon. The opponent points out that a number of its marks have been the subject of partial surrender since the filing of the notices of opposition. The opponent's marks thus affected by the reduction in specification effective as of March 2013 are UK2154295, 881688, and CTM191494 and 4138541. As, in respect of these registrations, the opponent does not seek to rely upon a wider specification than the newly reduced version, the specifications in paragraph 2 above reflect the current status. I also note that the opponent has, as of 1 July 2014, surrendered part of its specification in respect

of CTM 6894042. However, the opponent still seeks to rely upon the whole of the original specification (shown in paragraph 2 above) rather than the restricted specification of “underwear tops and bottoms; shorts; shirts; long underwear; thermal underwear; sleepwear; nightwear; pyjamas; robes; loungewear”. As this mark is not subject to proof of use the original specification would normally remain unchanged into the comparison of goods test. It is clear that the surrender takes effect only from the date of surrender. Therefore during the period between registration and surrender, the surrendered goods would have formed part of the registration and could, potentially, still provide infringement rights. Should the reliance upon the pre-surrender specification take the opponent further forward under the comparison of goods test I will comment upon the position as and when necessary when I reach my conclusions under the likelihood of confusion.

17) I will deal firstly with the ground of opposition based on section 5(2)(b) which reads:

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

(a) .....

(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.”

18) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark 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.”

19) The opponent is relying upon its trade marks listed in paragraph 2 above which are all, clearly, earlier trade marks. The applicant requested that the opponent provide proof of use and, given the interplay between the dates of both parties’ marks, the opponent’s marks, with the exception of CTM 6894042, are subject to proof of use. Section 6A of the Act states:

“6A Raising of relative grounds in opposition proceedings in cases of non-use.

(1) This section applies where-

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark 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 period of five years ending with the date of publication.

(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 period of five years ending with the date of publication of the application 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 differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, 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 Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(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.

(7) Nothing in this section affects –

- (a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

20) I must first consider whether the opponent has fulfilled the requirement to show that genuine use of the marks has been made. In the instant case the publication date of application 2621301A was 31 August 2012, therefore the relevant period for the proof of use is 1 September 2007 – 31 August 2012, whilst the publication date of application 2621303 was 12 July 2013, therefore the relevant period for the proof of use is 13 July 2008 – 12 July 2013. In *Stichting BDO v BDO Unibank, Inc.*, [2013] F.S.R. 35 (HC), Arnold J. stated as follows:

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

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

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

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider* [70]; *Silberquelle*, [17].

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

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

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

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

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]”.

21) Although minimal use may qualify as genuine use, the CJEU stated in Case C-141/13 P, *Reber Holding GmbH & Co. KG v OHIM* (in paragraph 32 of its judgment), that “*not every proven commercial use may automatically be deemed to constitute genuine use of the trade mark in question*”. The factors identified in point (5) above must therefore be applied in order to assess whether minimal use of the mark qualifies as genuine use.

22) I also take account of the comments in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, where the Court of Justice of the European Union noted that:

“36.It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And



“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

23) The court held that:


“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

24) A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

25) The applicant, in its written submissions dated 18 December 2013, accepts that the opponent has shown the following use:

| Mark  | Goods  |
|---|--|
| JOCKEY  | Articles of underclothing; nightwear; pyjamas; pants (being articles of underclothing) for men and boys; T-shirts.   |
| <br>JOCKEY | Underwear tops and bottoms for men; active wear for men namely, boxer shorts; active wear for men, namely T-shirts; long underwear; sleepwear ( <i>on the basis that it is the same as nightwear</i> ). Nightwear. |
|  JOCKEY    | Underwear tops and bottoms; active wear, namely boxer shorts; active wear, namely t-shirts; long underwear; thermal underwear; sleepwear; nightwear; pyjamas; robes.   |

26) Therefore the opponent has been tasked with providing evidence of use of the following goods in relation to each of the two marks which are subject to proof of use:

| Mark  | Goods  |
|---|--|
| JOCKEY  | Leisurewear and sportswear; jerseys, sweaters, pullovers, shirts, sweat shirts, sports shirts; shorts, trousers and jackets; but not including any of the aforesaid goods adapted for wear while horse riding; swimwear; housecoats; hats and caps.      |
| <br>JOCKEY | shorts, shirts; bicycle shorts, gym shorts, pants, pullovers, sport shirts, sweat pants, sweat shirts, sweat shorts, sweat suits, tank tops, hats and clothing caps; jackets; pants and slacks; swimwear, namely swimsuits, swim trunks and swim shorts. |

27) At the hearing the opponent contended that use of its Community Trade Mark 6894042, which appears in most of the brochures etc. equates to use of the “Jockey plus device” (CTM 4138541) where the device is above the word rather than in front of it and also to use of the word “Jockey” *solus*. In determining this issue I look to the case of *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union 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). (emphasis added)

28) The opponent’s three trade marks are shown at paragraph 25 above. It is clear that the only difference in the three marks is the addition and the location of a “swirl” device. To my mind, the average consumer will regard the word “JOCKEY” as being the indicator of origin. I therefore regard use of CTM 6894042 to be use of the other two registered marks. In the opponent’s evidence Mr Harings refers to use of the “Jockey” mark in his statement and he does not provide any comments as to which of the three registered marks, or indeed any unregistered marks that he might be referring to. This is typical of the lackadaisical manner the opponent has taken in providing its evidence. However, for the purposes of the proof of use I am going to accept that the garments will mostly have been sold with CTM 6894042 upon them, with the word “Jockey” solus being on the neck or waist label. As such it is clear from the evidence summary at paragraphs 7-11 above that the opponent, particularly in Germany, has made use of CTM 6894042 and the word “Jockey” on a range of garments which covers the whole of the specifications. By way of example in just two exhibits, TJH5 & 7, use is shown of CTM 6894042 on shorts; socks; swimwear; jumpers, cardigans & pullovers; sweatshirts, sweat tops and sweat pants; hooded tops; shirts; caps; pyjamas and dressing gowns.

29) Of the items listed at paragraph 26 above which require proof of use many such as “shirts” are mentioned directly. Others are clearly encapsulated for instance “jerseys, sweaters, pullovers and tank tops” are identical to “jumpers, cardigans and pullovers”. Similarly they are all “leisurewear”. Sweatshirts, tops and pants” and “swimwear” constitute “sportswear” and “sports shirts”. Similarly, “pyjamas” and “sweat pants” are “trousers”; and “Sweat tops” and “cardigans” can be considered “jackets”. “Sweat shorts” equates to “gym shorts” and are similar to “bike shorts”, whilst “dressing gowns” can be referred to as “housecoats”. When one takes into account the references in Mr Harings statement of the substantial sales in Germany then I am content that the opponent has provided evidence which can be interpreted as showing genuine and sufficient use to satisfy the requirements set out above. **In my opinion the opponent has shown use on all of the goods within its specifications.**

30) Therefore, when conducting the comparison of goods I shall rely upon the following specifications in relation to the opponent’s marks:

|        |  |
|--------|--|
| JOCKEY | Articles of underclothing; nightwear; pyjamas; pants (being articles of underclothing) for men and boys; T-shirts. Leisurewear and sportswear; jerseys, sweaters, pullovers, shirts, sweat shirts, |
|--------|--|

|   |  |
|---|--|
|   | sports shirts; shorts, trousers and jackets; but not including any of the aforesaid goods adapted for wear while horse riding; swimwear; housecoats; hats and caps.  |
|  | Underwear tops and bottoms for men; active wear for men namely, boxer shorts; active wear for men, namely T-shirts; long underwear; sleepwear ( <i>on the basis that it is the same as nightwear</i> ). Nightwear. Shorts, shirts; bicycle shorts, gym shorts, pants, pullovers, sport shirts, sweat pants, sweat shirts, sweat shorts, sweat suits, tank tops, hats and clothing caps; jackets; pants and slacks; swimwear, namely swimsuits, swim trunks and swim shorts.  |
|  | <b>Underwear tops and bottoms; shorts; shirts;</b> active wear, namely, boxer shorts, bicycle shorts, gym shorts, pants, pullovers, sport shirts, sweat pants, sweat shirts, sweat shorts, sweat suits, t-shirts, tank tops, jogging suits, warm-up suits; <b>long underwear; thermal underwear;</b> union suits; <b>sleepwear; nightwear; pajamas; robes;</b> panties; bras; all-in-ones in the nature of camisoles with built-in bras; camisoles; foundation garments; crop tops; socks; stockings; tights; hosiery; blanket sleepers; <b>loungewear;</b> gowns; playwear and coordinated separates, namely, creepers, multi-piece sets, overalls, shortalls, coveralls, jumpers, dresses, shirts, sweaters, pants, sweat suits, mitts, headbands, hats, booties, shorts; one-piece underwear; cloth training pants; cloth diaper vests; layettes consisting of one or more of the following: gowns, kimonos, sleep sacks, two-way sleepers, caps, booties, socks, slippers, mittens, bibs, pram suits, blankets, wash cloths, hooded towels, towels, bath mitts, robes, security blankets, burp cloths, cloth diapers, vinyl pants, diaper covers, diaper liners.<br><br>[Items in bold are those which have NOT been surrendered.] |

31) When considering the issue under section 5(2)(b) I take into account the following principles which 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.

(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.

### **The average consumer and the nature of the purchasing decision**

32) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

33) Both parties have specifications, broadly speaking, of clothing, footwear and headgear. Such goods will be sold in, inter alia, traditional retail outlets on the high street, through catalogues and on the Internet. As neither party’s specifications are limited I must keep all of these trade channels in mind. The average consumer of the goods at issue is a member of the general public who is likely, in my opinion, to select the goods mainly by visual means. I accept that more expensive items may be researched or discussed with a member of staff. In this respect I note that in *New Look Ltd v OHIM Cases- T-117/03 to T-119/03 and T-171/03*, the General Court (GC) said this about the selection of clothing:

“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.”

34) In the same case the Court also commented upon the degree of care the average consumer will take when selecting clothing. It said:

“43. It should be noted in this regard that the average consumer’s level of attention may vary according to the category of goods or services in question (see, by analogy, Case C 342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds it comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.”

35) Clearly, the average consumer’s level of attention will vary considerably depending on the cost and nature of the item at issue. However, to my mind even when selecting routine inexpensive items of clothing such as socks, the average consumer will pay attention to considerations such as size, colour, fabric and cost. Overall the average

consumer is likely to pay a reasonable degree of attention to the selection of items of clothing, footwear or headgear.

### Comparison of goods

36) In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment, that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

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

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) In the case of self serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

38) The specifications of the applicant’s two marks are identical and so for the purposes of the comparison I shall use a single list.

| Applicant’s goods   | Opponent’s goods   |
|---|--|
| Formal shirts; collared shirts; tailored shirts; fitted shirts; buttoned shirts; chinos; twill trousers; cord trousers; waxed trousers; fitted trousers; tailored | JOCKEY: Articles of underclothing; nightwear; pyjamas; pants (being articles of underclothing) for men and boys; T-shirts. Leisurewear and sportswear; jerseys, sweaters, pullovers, shirts, sweat shirts, sports shirts; shorts, trousers and jackets; but not including any of the aforesaid goods adapted for wear while horse riding; swimwear; housecoats; hats and caps. |

|   |   |
|---|---|
| trousers; formal trousers;<br>tweed trousers; canvas<br>jeans; formal jackets;<br>tailored jackets; blazers;<br>waxed jackets; quilted<br>jackets; waterproof<br>jackets; tweed jackets;<br>wind jackets; waistcoats,<br>gilets; body warmers;<br>coats; trench coats;<br>overcoats; tweed coats;<br>duffle coats; morning<br>jackets; morning suits;<br>tweed suits; belts<br>[clothing]; braces<br>[suspenders]; ties; pocket<br>squares; scarves; gloves;<br>footwear; shoes; boots;<br>headgear; formal hats;<br>panama hats; sun hats<br>and sun caps; fedora<br>hats; trilby hats; wool<br>hats; cashmere hats. |   |
|   | CTM 4138541: Underwear tops and bottoms for men; active wear for men namely, boxer shorts; active wear for men, namely T-shirts; long underwear; sleepwear ( <i>on the basis that it is the same as nightwear</i> ). Nightwear. Shorts, shirts; bicycle shorts, gym shorts, pants, pullovers, sport shirts, sweat pants, sweat shirts, sweat shorts, sweat suits, tank tops, hats and clothing caps; jackets; pants and slacks; swimwear, namely swimsuits, swim trunks and swim shorts.  |
|   | CTM 6894042: <b>Underwear tops and bottoms; shorts; shirts;</b> active wear, namely, boxer shorts, bicycle shorts, gym shorts, pants, pullovers, sport shirts, sweat pants, sweat shirts, sweat shorts, sweat suits, t-shirts, tank tops, jogging suits, warm-up suits; <b>long underwear; thermal underwear;</b> union suits; <b>sleepwear; nightwear; pajamas; robes;</b> panties; bras; all-in-ones in the nature of camisoles with built-in bras; camisoles; foundation garments; crop tops; socks; stockings; tights; hosiery; blanket sleepers; <b>loungewear;</b> gowns; playwear and coordinated separates, namely, creepers, multi-piece sets, overalls, shortalls, coveralls, jumpers, dresses, shirts, sweaters, pants, sweat suits, mitts, headbands, hats, booties, shorts; one-piece underwear; cloth training pants; cloth diaper vests; layettes consisting of one or more of the following: gowns, kimonos, sleep sacks, two-way sleepers, caps, booties, socks, slippers, mittens, bibs, pram suits, blankets, wash cloths, hooded towels, towels, bath mitts, robes, security blankets, burp cloths, cloth diapers, vinyl pants, diaper covers, diaper liners. |

[Items in bold are those which have NOT been surrendered.]

39) Taking into account the criteria set out earlier in relation to comparing goods I make the following findings.



- “Formal shirts; collared shirts; tailored shirts; fitted shirts; buttoned shirts” are identical to the term “shirts” found in all three of the opponent’s specifications.
- “Chinos; twill trousers; cord trousers; waxed trousers; fitted trousers; tailored trousers; formal trousers; tweed trousers; canvas jeans” are identical to the term “trousers” (JOCKEY) or “**pants**” (CTM 4138541 & CTM 6894042 )which can be found in the opponent’s specifications.



- “Headgear; formal hats; panama hats; sun hats and sun caps; fedora hats; trilby hats; wool hats; cashmere hats” are identical to the term **“hats and caps”** (JOCKEY and CTM 6894042) and “hats and clothing caps” (CTM 4138541) which can be found in the opponent’s specifications, albeit items that have, subsequent to the opposition being filed, been surrendered.
- “Formal jackets; tailored jackets; blazers; morning jackets” are identical to the term “jackets” which can be found in two of the opponent’s specifications, (JOCKEY & CTM 4138541).
- “Waxed jackets; quilted jackets; waterproof jackets; tweed jackets; wind jackets; waistcoats, gilets; body warmers; coats; trench coats; overcoats; tweed coats; duffle coats; morning suits; tweed suits” are very similar to the term “jackets” which can be found in two of the opponent’s specifications, (JOCKEY & CTM 4138541).
- “Footwear; shoes; boots” are very similar to the terms **“booties; slippers”** which can be found in the opponent’s CTM 6894042 specification.
- “Gloves” are very similar to the terms **“Mitts; mittens”** which can be found in the opponent’s CTM 6894042 specification albeit items that have, subsequent to the opposition being filed, been surrendered.
- To my mind the opponent does not have any items within its specifications which are identical or even similar to the following items in the applicant’s specification: “belts [clothing]; braces [suspenders]; ties; pocket squares; scarves” albeit items that have, subsequent to the opposition being filed, been surrendered.

40) In the above conclusions I have found that certain terms (in bold above) have been found to be identical/similar to the goods of the applicant even though they have been surrendered. I will address this issue, if required, after I have made my decision on the likelihood of confusion.

### Comparison of trade marks

41) The trade marks to be compared are:

| Opponent’s trade marks  | Applicant’s trade marks  |
|---|--|
| JOCKEY  | THE JOCKEY CLUB  |
|  |  |

|   |  |
|---|--|
|   |  |
|  |  |

42) The opponent's strongest case must be under its JOCKEY mark without the device element. Clearly, the word appears in full in the applicant's marks and so there is a degree of visual and aural similarity. There are also visual and aural differences in that the applicant's mark is longer in that it is three words or three words and a date. Verbally the opponent's mark is two syllables to the four syllables of 2621301 and nine syllables of mark 2621303. **To my mind, there is only a low level of visual and aural similarity between the marks.** Conceptually the opponent's mark calls to mind an image of a horse rider, of very small stature, in racing colours or silks. The applicant's marks bring to mind an organisation. The use of the definite article cannot be overlooked in this comparison. I do not accept the contention that the average consumer will assume that it is a club for Jockeys and therefore the conceptual image would be similar to that of the opponent. The average consumer is used to various organisations and charities selling all kinds of merchandise, including clothing. The Jockey Club is well known as having been the arbiter of all matters concerning horse racing in the UK since Georgian times. Other parts of the Empire also formed their own Jockey clubs to regulate horse racing in the various territories. The opponent contended that use of the word "Club" was common amongst clothing manufacturers and provided a few instances of use of the word by third parties. However, in a number of instances it would appear to be used descriptively as being the type of shirt or jumper to be worn in a club, rather than suggesting a group of wearers of that particular brand. **In my opinion, whilst the marks have a minor link of horse racing, conceptually they are very different.**

43) In *The Picasso Estate v OHIM*, Case C-361/04 P, the Court of Justice of the European Union found that:

"20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law."

#### **Distinctive character of the earlier trade mark**

44) 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).”

45) Whilst in *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.’

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out”.

46) However the independent and distinctive element does not need to be identical. In *Bimbo SA v OHIM*, Case T-569/10, the General Court held that:

“96. According to the case-law, where goods or services are identical there may be a likelihood of confusion on the part of the public where the contested sign is composed by juxtaposing the company name of another party and a registered mark which has normal distinctiveness and which, without alone determining the overall impression conveyed by the composite sign, still has an independent distinctive role therein (Case C-120/04 *Medion* [2005] ECR I-8551, paragraph 37). There may also be a likelihood of confusion in a case in which the earlier mark is not reproduced identically in the later mark (see, to that effect, Joined Cases T-5/08 to T-7/08 *Nestlé v OHIM – Master Beverage Industries (Golden Eagle and Golden Eagle Deluxe)* [2010] ECR II-1177, paragraph 60).”

47) In *Aveda Corp v Dabur India Ltd* [2013] EWHC 589 (Ch), Arnold J. stated that:

“47. In my view the principle which I have attempted to articulate in [45] above is capable of applying where the consumer perceives one of the constituent parts to have significance independently of the whole, but is mistaken as to that significance. Thus in *Bulova Accutron* the earlier trade mark was ACCURIST and the composite sign was BULOVA ACCUTRON. Stamp J. held that consumers familiar with the trade mark would be likely to be confused by the composite sign because they would perceive ACCUTRON to have significance independently of the whole and would confuse it with ACCURIST.

48. On that basis, I consider that the hearing officer failed correctly to apply *Medion v Thomson*. He failed to ask himself whether the average consumer would perceive UVEDA to have significance independently of DABUR UVEDA as a whole and whether that would lead to a likelihood of confusion.”

48) Further in *Ancco, Inc. V OHIM*, Case T-385/09, the General Court considered an appeal against OHIM’s decision that there was no likelihood of confusion between ANN TAYLOR LOFT and LOFT (both for clothing and leather goods) and found that:

“48. In the present case, in the light of the global impression created by the signs at issue, their similarity was considered to be weak. Notwithstanding the identity of the goods at issue, the Court finds that, having regard to the existence of a weak similarity between the signs at issue, the target public, accustomed to the same clothing company using sub-brands that derive from the principal mark, will not be able to establish a connection between the signs ANN TAYLOR LOFT and LOFT, since the earlier mark does not include the ‘ann taylor’ element, which is, as noted in paragraph 37 above (see also paragraph 43 above), the most distinctive element in the mark applied for.

49 Moreover, even if it were accepted that the ‘loft’ element retained an independent, distinctive role in the mark applied for, the existence of a likelihood of confusion between the signs at issue could not for that reason be automatically deduced from that independent, distinctive role in that mark.

50 Indeed, the likelihood of confusion cannot be determined in the abstract, but must be assessed in the context of an overall analysis that takes into consideration, in particular, all of the relevant factors of the particular case (*SABEL*, paragraph 18 above, paragraph 22; see, also, Case C-120/04 *Medion* [2005] ECR I-8551, paragraph 37), such as the nature of the goods and services at issue, marketing methods, whether the public's level of attention is higher or lower and the habits of that public in the sector concerned. The examination of the factors relevant to this case, set out in paragraphs 45 to 48 above, do not reveal, *prima facie*, the existence of a likelihood of confusion between the signs at issue."

49) The opponent's mark consists of a single word which has little meaning in regard to clothing, footwear or headgear. The opponent's earlier trade mark is possessed of a reasonable to high degree of inherent distinctive character. The opponent has filed evidence of the use it has made of its earlier trade mark in the UK. The evidence is not put into context in terms of market share, nor is the UK market for any of the sub-categories described. However, I am willing to accept that the opponent's use in respect of underwear and nightwear is enough for the opponent to benefit from enhanced distinctiveness through use in respect of its mark in respect of the UK. I note that the applicant accepted that the opponent had reputation under *JOCKEY* and *JOCKEY* plus swirl device in respect of underwear and nightwear. In respect of its CTM 191494 (*JOCKEY*) its evidence of use in Germany is sufficient for the opponent to benefit from enhanced distinctiveness through use in respect of leisurewear; sportswear; swimwear; underwear; nightwear; pants; jerseys; sweaters; pullovers; shirts; sweatshirts; sports shirts and T-shirts; shorts and jackets.

50) The opponent also contended that it has a family of trade marks. In *Il Ponte Finanziaria SpA v OHIM*, Case C-234/06, the Court of Justice of the European Union stated 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 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 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.

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.

65 Thus, contrary to what the appellant maintains, the Court of First Instance did not require proof of use as such of the earlier trade marks but only of use of a sufficient number of them as to be capable of constituting a family or series of trade marks and therefore of demonstrating that such a family or series exists for the purposes of the assessment of the likelihood of confusion.

66 It follows that, having found that there was no such use, the Court of First Instance was properly able to conclude that the Board of Appeal was entitled to disregard the arguments by which the appellant claimed the protection that could be due to 'marks in a series'."

51) The opponent here seems to want its cake and also eat it. Earlier it contended that the three registered marks would all be seen as use of the mark JOCKEY and its evidence was also predicated upon this basis. The swirl device was taken as being a nondescript addition and the positioning of the swirl and indeed the number of swirls used on a garment in relation to the word JOCKEY seemed to vary. I will factor in the family of marks issue into my overall determination but I do not believe that it adds greatly to the opponent's case.

### **Likelihood of confusion**

52) In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer is likely to pay a reasonable degree of attention to the selection of items of clothing, footwear or headgear.

- Formal shirts; collared shirts; tailored shirts; fitted shirts; buttoned shirts; chinos; twill trousers; cord trousers; waxed trousers; fitted trousers; tailored trousers; formal trousers; tweed trousers; canvas jeans; headgear; formal hats; panama hats; sun hats and sun caps; fedora hats; trilby hats; wool hats; cashmere hats; formal jackets; tailored jackets; blazers; morning jackets” are wholly encompassed by the opponent’s specifications for JOCKEY.
- Waxed jackets; quilted jackets; waterproof jackets; tweed jackets; wind jackets; waistcoats, gilets; body warmers; coats; trench coats; overcoats; tweed coats; duffle coats; morning suits; tweed suits; footwear; shoes; boots & gloves are very similar to the opponent’s specifications for JOCKEY.
- The following items in the applicant’s specification: “belts [clothing]; braces [suspenders]; ties; pocket squares; scarves” are dissimilar to the opponent’s specifications.
- there is only a low level of visual and aural similarity between the marks, whilst conceptually they are very different.
- the opponent’s earlier trade mark is possessed of a reasonable to high degree of inherent distinctive character, and can benefit from enhanced distinctiveness in respect of underwear; nightwear; leisurewear; sportswear; swimwear; underwear; nightwear; pants; jerseys; sweaters; pullovers; shirts; sweatshirts; sports shirts and T-shirts; shorts and jackets.
- the opponent has a family of JOCKEY marks, albeit only ones where any addition to the word JOCKEY is a swirl device.

53) I also take into account the comments of Mr Iain Purvis Q.C, acting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc* (BL-O/375/10), where he commented on the difference between direct and indirect confusion in the following terms:

“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.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

54) In my opinion, taking all the factors above into account, even where the goods are identical, the visual, aural and conceptual differences between the marks is such that there is no likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. **The opposition under Section 5(2) (b) therefore fails in respect of both applications.**

55) I now turn to the ground of opposition under Section 5(3) which reads:

“(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 Community trade mark or international trade mark (EC), in the European Community) 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.”

56) The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and Case C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

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

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

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

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

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

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

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

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

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

coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

57) In *China Construction Bank Corporation v Groupement Des Cartes Bancaires*, Case BL O/281/14, Mr Ian Purvis Q.C. as the Appointed Person noted that the reputation of a CTM outside the UK will not normally be sufficient for the UK public to link the CTM with a later UK mark and therefore for the use of that mark to cause detriment or take unfair advantage of the CTM. Mr Purvis stated:

“41. If the reputation of the earlier mark does not extend to the United Kingdom, it is difficult to see how (at least in the usual case) it could be damaged by use of a mark in the United Kingdom, or that such use could be said to take unfair advantage of the earlier mark. For one thing, the necessary ‘link’ between the marks in the mind of the average consumer which must be established in any case which relies on the extended protection (see *Adidas-Salomon v Fitnessworld* [2004] ETMR 10) would not exist. There is certainly no evidence in the present case which explains how any ‘link’ could be made in the UK absent a reputation here.”

58) It is clear that the opponent's strongest case is under the mark *JOCKEY solus*. The onus is upon the opponent to prove that its earlier trade mark enjoys a reputation or public recognition and it needs to furnish the evidence to support this claim. To my mind the opponent has provided evidence of use of its mark *JOCKEY* in respect of underwear and nightwear in the UK. I accept that its mark does enjoy such a reputation in the UK in respect of these goods and so it clears the first hurdle.

59) Once the matter of reputation is settled an opponent must then show that the relevant customers would make a link between the two trade marks and how its trade mark would be affected by the registration of the later trade mark. 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).”

60) There is some debate as to whether the judgment of the CJEU in *L’Oreal v Bellure* means that an advantage gained by the user of a junior mark is only unfair if there is an intention to take advantage of the senior mark, or some other factor is present which makes the advantage unfair. The English Court of Appeal has considered this matter three times. Firstly, in *L’Oreal v Bellure* [2010] RPC 23 when that case returned to the national court for determination. Secondly, in *Whirlpool v Kenwood* [2010] RPC 2: see paragraph 136. Thirdly, in *Specsavers v Asda Stores Limited*<sup>1</sup> [2012] EWCA Civ 24: see paragraph 127. On each occasion the court appears to have interpreted *L’Oreal v Bellure* as meaning that unfair advantage requires something more than an advantage gained without due cause. However, the absence of due cause appears to be closely linked to the existence of unfair advantage. See paragraph 36 of the opinion of Advocate General Kokott in Case C-65/12 *Leidseplein Beheer and Vries v Red Bull*.

61) In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

62) In *Aktieselskabet af 21. November 2001 v OHIM*, Case C-197/07P, the CJEU stated that:

“22. With regard to the appellant's argument concerning the standard of proof required of the existence of unfair advantage taken of the repute of the earlier mark, it must be noted that it is not necessary to demonstrate actual and present injury to an earlier mark; it is sufficient that evidence be produced enabling it to be concluded prima facie that there is a risk, which is not hypothetical, of unfair advantage or detriment in the future (see, by analogy, concerning the provisions of Article 4(4)(a) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), Case C-252/07 *Intel Corporation* [2008] ECR I-0000, paragraph 38).

23. In the present case, it is clear that the Court of First Instance, in paragraph 67 of the judgment under appeal, properly established the existence of an unfair

advantage within the meaning of Article 8(5) of Regulation No 40/94 in correctly considering that it had available to it evidence enabling it to conclude prima facie that there was a risk, which was not hypothetical, of unfair advantage in the future.”

## **DUE CAUSE**

63) In *Leidseplein Beheer BV v Red Bull*, Case C-65/12, the CJEU held that:

“43. In a system for the protection of marks such as that adopted, on the basis of Directive 89/104, by the Benelux Convention, however, the interests of a third party in using, in the course of trade, a sign similar to a mark with a reputation must be considered, in the context of Article 5(2) of that directive, in the light of the possibility for the user of that sign to claim ‘due cause’.

44. Where the proprietor of the mark with a reputation has demonstrated the existence of one of the forms of injury referred to in Article 5(2) of Directive 89/104 and, in particular, has shown that unfair advantage has been taken of the distinctive character or the repute of that mark, the onus is on the third party using a sign similar to the mark with a reputation to establish that he has due cause for using such a sign (see, by analogy, Case C-252/07 *Intel Corporation* [2008] ECR I-8823, paragraph 39).

45. It follows that the concept of ‘due cause’ may not only include objectively overriding reasons but may also relate to the subjective interests of a third party using a sign which is identical or similar to the mark with a reputation.

46. Thus, the concept of ‘due cause’ is intended, not to resolve a conflict between a mark with a reputation and a similar sign which was being used before that trade mark was filed or to restrict the rights which the proprietor of that mark is recognised as having, but to strike a balance between the interests in question by taking account, in the specific context of Article 5(2) of Directive 89/104 and in the light of the enhanced protection enjoyed by that mark, of the interests of the third party using that sign. In so doing, the claim by a third party that there is due cause for using a sign which is similar to a mark with a reputation cannot lead to the recognition, for the benefit of that third party, of the rights connected with a registered mark, but rather obliges the proprietor of the mark with a reputation to tolerate the use of the similar sign.

47. The Court thus held in paragraph 91 of the judgment in *Interflora and Interflora British Unit* (a case concerning the use of keywords for internet referencing) that where the advertisement displayed on the internet on the basis of a keyword corresponding to a trade mark with a reputation puts forward – without offering a mere imitation of the goods or services of the proprietor of that trade mark, without being detrimental to the repute or the distinctive character of that mark and without, moreover, adversely affecting the functions of the trade mark concerned –

an alternative to the goods or services of the proprietor of the trade mark with a reputation, it must be concluded that such a use falls, as a rule, within the ambit of fair competition in the sector for the goods or services concerned and is thus not without 'due cause'.

48. Consequently, the concept of 'due cause' cannot be interpreted as being restricted to objectively overriding reasons.

64) Clearly the applicant has due cause in applying for the mark as it has been in existence for over 250 years, albeit as the ultimate authority in respect of horse racing in the UK and is now simply seeking to use its well established name in an offshoot commercial enterprise, just as so many other organisations and charities have done.

65) Earlier in this case I found that a number of the goods of the two parties were identical (see paragraph 52). However, there is a difference between underwear and nightwear and the opponent's revised specification. I also found that the opponent's mark has a high level of inherent distinctiveness for "clothing footwear and headgear" and has an enhanced reputation through its use in respect of underwear and nightwear in the UK. I also found that the competing trade marks have only a low level of visual and aural similarity between the marks, whilst conceptually they are very different. Thus, in my opinion a link will not be established. Adopting the composite approach advocated, the conclusions that I have set out above naturally lead me to the view that there is no advantage for the applicant to derive. As far as detriment is concerned, the opponent suggested that this would subsist in a reduction in the distinctiveness of their mark. I consider that registration of the mark in suit would not have such an impact, either to the distinctiveness of the earlier mark or the reputation it enjoys. **The opposition under Section 5(3) therefore fails.**

66) I next turn to consider the ground of opposition under section 5(4)(a) which reads:

"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, or

(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."

67) In deciding whether the marks in question offend against this section, I intend to adopt the guidance set out in Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 which provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.”

68) Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 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.”

69) The earlier use by the opponent must relate to the use of the sign for the purposes of distinguishing goods or services. For example, merely decorative use of a sign on a T-shirt cannot found a passing off claim: *Wild Child Trade Mark* [1998] RPC 455 (AP)

70) First I must determine the date at which the opponent’s claim is to be assessed; this is known as the relevant or material date. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC as the Appointed Person considered the relevant date for the purposes of s.5(4)(a) of the Act and concluded as follows:

“39. In *Last Minute*, the General Court....said:

‘50. First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51. However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non-registered national mark before the date of filing, in this case 11 March 2000.’

40. Paragraph 51 of that judgment and the context in which the decision was made on the facts could therefore be interpreted as saying that events prior to the filing date were irrelevant to whether, at that date, the use of the mark applied

for was liable to be prevented for the purpose of Article 8(4) of the CTM Regulation. Indeed, in a recent case before the Registrar, *J Sainsbury plc v. Active: 4Life Ltd* O-393-10 [2011] ETMR 36 it was argued that *Last Minute* had effected a fundamental change in the approach required before the Registrar to the date for assessment in a s.5(4)(a) case. In my view, that would be to read too much into paragraph [51] of *Last Minute* and neither party has advanced that radical argument in this case. If the General Court had meant to say that the relevant authority should take no account of well-established principles of English law in deciding whether use of a mark could be prevented at the application date, it would have said so in clear terms. It is unlikely that this is what the General Court can have meant in the light of its observation a few paragraphs earlier at [49] that account had to be taken of national case law and judicial authorities. In my judgment, the better interpretation of *Last Minute*, is that the General Court was doing no more than emphasising that, in an Article 8(4) case, the *prima facie* date for determination of the opponent's goodwill was the date of the application. Thus interpreted, the approach of the General Court is no different from that of Floyd J in *Minimax*. However, given the consensus between the parties in this case, which I believe to be correct, that a date prior to the application date is relevant, it is not necessary to express a concluded view on that issue here.

41. There are at least three ways in which such use may have an impact. The underlying principles were summarised by Geoffrey Hobbs QC sitting as the Appointed Person in *Croom's TM* [2005] RPC 2 at [46] (omitting case references):

- (a) The right to protection conferred upon senior users at common law;
- (b) The common law rule that the legitimacy of the junior user's mark in issue must normally be determined as of the date of its inception;
- (c) The potential for co-existence to be permitted in accordance with equitable principles.

42. As to (b), it is well-established in English law in cases going back 30 years that the date for assessing whether a claimant has sufficient goodwill to maintain an action for passing off is the time of the first actual or threatened act of passing off: *J.C. Penney Inc. v. Penneys Ltd.* [1975] FSR 367; *Cadbury-Schweppes Pty Ltd v. The Pub Squash Co. Ltd* [1981] RPC 429 (PC); *Barnsley Brewery Company Ltd. v. RBNB* [1997] FSR 462; *Inter Lotto (UK) Ltd. v. Camelot Group plc* [2003] EWCA Civ 1132 [2004] 1 WLR 955: "date of commencement of the conduct complained of". If there was no right to prevent passing off at that date, ordinarily there will be no right to do so at the later date of application.

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.’ ”

71) The applications were both filed on 17 May 2012. The applicant does not claim to have used its mark prior to the application date. I therefore turn to consider whether as of 17 May 2012, the opponent had any goodwill and if so in what goods or services this goodwill existed. It is clear from the evidence at exhibit KH1 that the opponent had goodwill in relation to underwear and nightwear in the UK. The opponent **therefore overcomes the first obstacle under this ground of opposition.**

72) I found earlier in this decision that the opponent’s mark has a reasonable to high degree of inherent distinctiveness and also benefits from enhanced distinctiveness through use.

73) I now turn to consider the issue of misrepresentation. In *Neutrogena Corporation and Another v Golden Limited and Another*, 1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341 at page 407* the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants’ [product] in the belief that it is the respondents’[product]”

The same proposition is stated in Halsbury’s Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden’s Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“.... for my part, I think that references, in this context, to “more than *de minimis* ” and “above a trivial level” are best avoided notwithstanding this court’s reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

74) There is one possible difference between the position under trade mark law and the position under passing off law. In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewinson L.J. cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “a *substantial number*” of the relevant public are deceived, which might not mean that the average consumer is confused. As both tests are intended to be normative measures intended to exclude those who are unusually careful or careless (per Jacob L.J. in *Reed Executive Plc v Reed Business Information Ltd* [2004] RPC 40), it is doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes.

75) In *Neutrogena Corporation and Another v Golden Limited and Another*, 1996] RPC 473, Morritt L.J. stated that:

“The role of the court, including this court, was emphasised by *Lord Diplock in GE Trade Mark* [1973] R.P.C. 297 at page 321 where he said:

‘where the 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 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.”

76) It is the plaintiff’s customers or potential customers that must be deceived. In *Neutrogena Corporation and Another v Golden Limited and Another*, 1996] RPC 473, Morritt L.J. stated that:

“This is the proposition clearly expressed by the judge in the first passage from his judgment which I quoted earlier. There he explained that the test was whether a substantial number of the plaintiff's customers or potential customers had been deceived for there to be a real effect on the plaintiff's trade or goodwill.”

77) In the instant case both parties are, broadly speaking, in the same field of activity, namely clothing. However, the differences in the marks of the two parties are such that I have no doubt in my mind that there is no possibility of a substantial number of the relevant public being deceived. **To my mind, it is clear that misrepresentation will not occur.**

78) A consequence of there being no misrepresentation is that there will be no damage. **The ground of opposition under section 5(4)(a) therefore fails.**

## **CONCLUSION**

79) The grounds of opposition under sections 5(2)(b), 5(3) and 5(4)(a) have all failed in respect of both marks.

## **COSTS**

80) The applicant did not assist the smooth running of the opposition when it failed to initially acknowledge that the opponent had a reputation and goodwill in the UK in respect of the word JOCKEY with regard to men's underwear. This was surely obvious to all concerned prior to any evidence being filed. Thus was the die set. The opponent then used a swamping ploy of filing thousands of pages of exhibits without any explanation as to what they were being relied upon to show. Even after I instructed at a Case Management Conference that they produce a table listing which exhibits were being relied upon for which part of each specification the opponent did not list what mark each exhibit was being used to defend, merely the type of goods involved. Given that the evidence of use of the exact mark registered was, in some cases, almost non-existent the opponent should have been clear that it was relying upon variations to defend its registered marks. It continued to rely upon UK 2133883 even though this is only registered for class 18 goods.

81) At the hearing it was agreed that the parties would have the opportunity to comment on the issue of costs after the interim decision was issued. As such the parties are given fourteen working days from the date of this interim decision to provide such submissions. The appeal period will not commence until the supplementary decision on costs is issued.

**Dated this 22nd day of December 2014**

**George W Salthouse  
For the Registrar,  
the Comptroller-General**