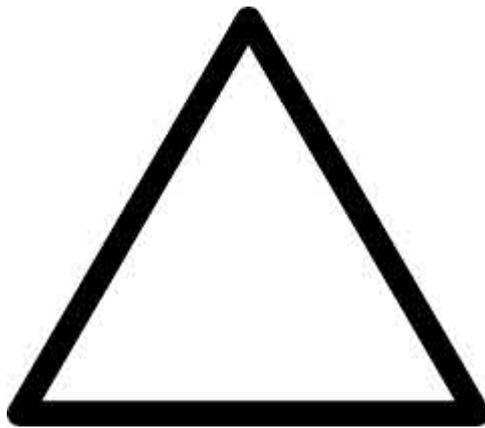


O-781-18

TRADE MARKS ACT 1994

IN THE MATTER OF:

**TRADE MARK APPLICATION No. 3254444
BY JOSHUA JOSEPH
TO REGISTER THE FOLLOWING TRADE MARK
IN CLASS 25**

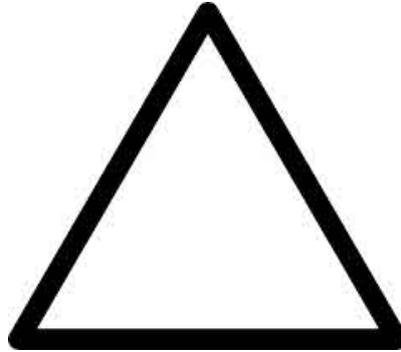


AND

**OPPOSITION THERETO (NO. 411088)
BY NUMERO 8 S.R.L.**

Background and pleadings

1) On 4 September 2017 Joshua Joseph ('the applicant') applied to register the following trade mark:

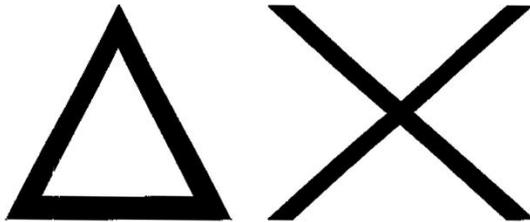


2) It was accepted and published in the Trade Marks Journal on 27 October 2017 in respect of the following goods:

Class 25: Clothing and Apparel; Adhesive bras; After ski boots; Aikido suits; Aikido uniforms; Albs; Aloha shirts; American football bibs; American football pants; American football shirts; American football shorts; American football socks; Anglers' shoes; Ankle boots; Ankle socks; Anklets [socks]; Anoraks; Anoraks [parkas]; Anti-perspirant socks; Anti-sweat underclothing; Anti-sweat underwear; Après-ski boots; Apres-ski shoes; Aprons; Aprons [clothing]; Aqua shoes; Arm warmers [clothing]; Army boots ;Articles of clothing; Articles of clothing for theatrical use; Articles of clothing made of hides; Articles of clothing made of leather; Articles of outer clothing; Articles of sports clothing; Articles of underclothing; Ascots; Ascots (ties); Athletic clothing; Athletic footwear ;Athletic shoes; Athletic tights; Athletic uniforms; Athletics footwear; Athletics hose; Athletics shoes; Athletics vests; Babies' clothing; Babies' outerclothing; Babies' pants [clothing]; Babies' pants [underwear]; Babies' undergarments; Babushkas; Baby bodysuits; Baby boots; Baby bottoms; Baby clothes; Baby doll pyjamas; Baby layettes for clothing; Baby pants; Baby sandals; Baby tops; Balaclavas; Ball gowns; Ballet shoes; Ballet slippers; Ballet suits; Ballroom dancing shoes; Bandanas; Bandanas [neckerchiefs]; Bandeaux [clothing]; Barber smocks; Baseball caps; Baseball caps and hats; Baseball hats; Baseball shoes; Baseball uniforms; Baselayer bottoms;

Baselayer tops ;Basic upper garment of Korean traditional clothes [Jeogori]; Basketball shoes; Basketball sneakers; Bath robes; Bath sandals; Bath shoes; Bath slippers; Bathing caps; Bathing costumes; Bathing costumes for women; Bathing drawers; Bathing suit cover-ups; Bathing suits; Bathing suits for men; Bathing trunks; Bathrobes; Bathwraps; Beach clothes; Beach clothing; Beach cover-ups; Beach footwear; Beach hats; Beach robes.

3) On 19 December 2017, Numero 8 S.R.L. ('the opponent') filed a notice of opposition against the application under Section 5(2) (b) of the Trade Marks Act 1994 ('the Act'). This is on the basis of, amongst others, its earlier European Union Trade Mark registration (EUTM). Pertinent details of the registration are as follows:



Mark:

Mark description: 'The symbol delta followed by the letter X.'

EUTM no: 4213906

Date of filing: 23 December 2004

Publication date: 25 July 2005

Date of entry in register: 20 January 2006

Goods: Class 25 *Rainproof clothing; Clothing of imitations of leather; Leather clothing; Motorists' clothing; Cyclists' clothing; Clothing for gymnastics; Gowns; Suits; Pinafore dresses; Bathrobes; Non-slipping devices for footwear; Clothing; Bandanas [neckerchiefs]; Bibs, not of paper; Caps [headwear]; Berets; Underwear; Sweat-absorbent underwear; Boas [necklets]; Teddies [undergarments]; Stocking suspenders; Corsets; Goloshes; Skull caps; Footwear; Training shoes; Stockings; Sweat-absorbent stockings; Socks; Sweat-absorbent socks; Breeches; Swimming trunks; Albs; Shirts; Short-sleeve shirts; Bodices [lingerie]; Sports singlets; Hats; Top hats; Hats (Paper -) [clothing]; Coats; Hoods [clothing]; Frames (Hat -) [skeletons]; Chasubles; Belts [clothing]; Belts (Money -) [clothing]; Tights; Shoulder wraps; Detachable collars; Camisoles; Headgear; Layettees [clothing]; Corselets; Swimming*

costumes; Masquerade costumes; Beachwear; Neckties; Ascots; Swimming caps; Shower caps; Knickers; Headbands [clothing]; Pocket squares; Fittings of metal for footwear; Linings (Ready-made -) [parts of clothing]; Scarves; Gabardines [clothing]; Boot uppers; Gaiters; Jackets [clothing]; Stocking suspenders; Fishing vests; Stuff jackets [clothing]; Skirts; Aprons [clothing]; Aprons [clothing]; Girdles; Gloves [clothing]; Mittens; Ski gloves; Welts for footwear; Ready-to-wear clothing; Paper clothing; Knitwear [clothing]; Jumpers; Leg warmers; Leggings [trousers]; Liveries; Hosiery; Maillots; Sweaters; Muffs [clothing]; Maniples; Pelerines; Mantillas; Sleep masks; Skorts; Miters [hats]; Boxer shorts; Babies' pants [clothing]; Briefs; Wetsuits for water-skiing; Waistcoats; Trousers; Mules; Ear muffs [clothing]; Parkas; Pelisses; Furs [clothing]; Shirt yokes; Pyjamas; Cuffs; Ponchos; Tips for footwear; Stocking suspenders; Sock suspenders; Brassieres; Heelpieces for stockings; Sandals; Bath sandals; Saris; Sarongs; Neck scarfs [mufflers]; Footmuffs, not electrically heated; Footwear; Espadrilles; Bath slippers; Gymnastic shoes; Beach shoes; Football boots; Training shoes; Ski boots; Shawls; Sashes for wear; Wimples; Insoles; Topcoats; Outerclotthing; Dress shields; Petticoats; Knee-high stockings; Slips [undergarments]; Shirt fronts; Ankle boots; Lace boots; Boots; Fur stoles; Footwear soles; Studs for football boots; Heels; Heelpieces for footwear; Pockets for clothing; Tee-shirts; Togas; Footwear uppers; Ankle boots; Turbans; Combinations [clothing]; Uniforms; Veils [clothing]; Robes; Visors [headwear]; Cap peaks; Wooden shoes; All of the aforesaid goods being other than valenki (felt boots).

4) The opponent argues that the respective goods are identical and 'The opposed mark consists solely of the device of an outline of a triangle, the proportions of which are very similar to those of the triangle device of the Opponent's earlier mark. The triangle device is one of two elements making up the earlier mark and appears at the beginning of the mark followed by a letter or sign 'X'.'

5) The applicant filed a counterstatement denying the claims made, stating that 'The logos are completely separate logos.' and refers to how the earlier mark has been used. The applicant also requested that the opponent provides proof of use of its earlier trade mark relied upon.

6) Only the opponent filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate/necessary. Neither side filed written submissions. No hearing was requested and so this decision is taken following careful consideration of the papers.

Relevant period

7) The application was published on 27 October 2017. Therefore, the relevant five-year period which the opponent must demonstrate use of its earlier mark is 28 October 2012 - 27 October 2017.

Evidence

8) The opponent's evidence consists of three witness statements. The first is from Mr Spinazze who is the legal representative of Numero 8 S.R.L., a position he has held since 31 January 2005. He states that his company designs and sells clothing, footwear and headgear for men and women using the $\Delta \times$ mark.

9) Exhibit ES2 consists of a number of historic extracts from the opponent's website; sun68.com. They show use of the mark as registered, appearing on: a men's jumper (dated 21/08/13, 02/07/13), various beachwear items such as a hat, a ladies jacket (dated 03/02/14), men's polo shirt (dated 17/03/14), on the cuff of a ladies top (dated 15/10/2015), a man's jacket (dated 19/01/2015) and cardigan (dated 08/04/16). The text on the websites is in Italian. Using data obtained from Google analytics, Mr Spinazze provides various website visitor data throughout the EU. It shows that the vast majority of visitors come from Italy, followed by Belgium, Netherlands, France, and other European countries. The report filed by Mr Spinazze is in Italian and so a further witness statement has been filed by Ms Rosemary Anne Cardas who is a trade mark attorney for the opponent's representatives. Exhibit RAC 1 to the witness statement is a translation of the Google analytics report filed under exhibit ES2.

10) Mr Spinazze states that sales of goods are sold through its website and through physical stores in Italy, Spain, Austria, Germany, Holland, Belgium and

Luxembourg¹. He also lists the countries whereby sales have been made via its website. These generally cover all of the EU.

11) With regard to turnover, Mr Spinazze has submitted a table² detailing the sales figures. He states that the tables show that in Italy alone it made sales in 2012 amounting to €27,918,919.52 and €36,331,042.35 in 2013. He states that the rest of the table includes figures for other EU member states, but the table is difficult to decipher.

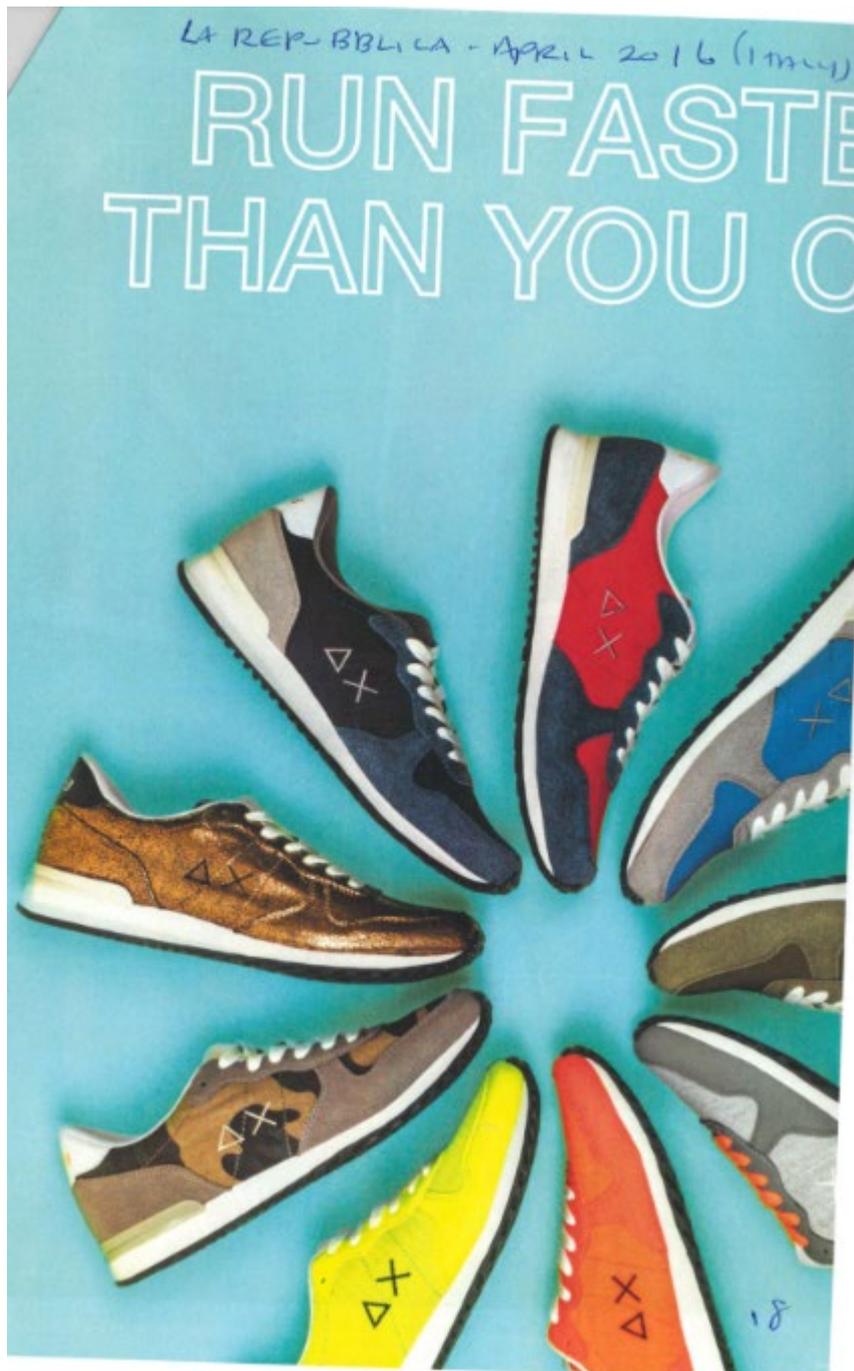
12) Exhibit ES6 to the witness statement comprises over 150 invoices. The majority include the mark as registered and in the following form . The invoices cover an array of clothing including t-shirts, polo shirts, jumpers, bermuda shorts, cardigans, jackets, scarves, etc. The invoices also refer to sailor caps, caps, baseball caps and twill running shoes (two separate sales to UK customers). They are dated between 15 February 2012 through to 4 May 2017.

13) In terms of advertising Mr Spinazze states that the opponent invests significantly in advertising. Exhibits ES9(i) and 9(ii) consist of lists of advertising expenditure. Total expenditure is not provided but it is clear that the expenditure was consistent over the relevant period and ran into the tens of thousands of euros. This funded a number of advertisements placed in magazines³ in the EU dated between 2012 and 2017. It is noted that the majority are Italian publications. The evidence includes extracts from magazines which show the mark used on footwear. For example:

¹ List provided under exhibit ES4

² Exhibit ES5

³ Examples submitted under exhibit ES 7



14) Further magazine extracts include more pictures of footwear as above with the handwritten indication of where and when they were published, i.e. Sportsweek (Italy) 2015, Onstage (international magazine) October 2015, Vanity Fair (Italy) May 2016 and GQ magazine July 2017.

15) It is also noted that the mark often appears as follows: . Further advertising material which was placed on websites such as Grazia.it and Onstage.web are submitted under exhibit ES8.

16) Exhibit ES10 consists of extracts from the opponent's catalogues for the years 2012-2017. The extracts show various women's and men's clothing, all of which bear the mark. Further brochure and catalogue extracts have been submitted under exhibits ES11 and ES12.

17) The third witness statement is from Ms Skelding who is a trade mark assistant at Keltie LLP, the opponent's representatives. The purpose of Ms Skelding's witness statement is to supplement exhibit ES2 to Mr Spinazze's witness statement by providing Google maps street views of the various shops referred to. Exhibit AS1 to the witness statement includes images of the shop fronts and the addresses in Italy. They all bear the mark at the front of the shop. I shall not provide any further details but confirm that I have reviewed the exhibit.

PROOF OF USE

Legislation

18) Section 6A of the Act states:

"Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

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

(c) the registration procedure for the earlier trade mark was completed before the start of the 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 European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(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.”

19) Section 100 of the Act states that:

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

Case law

20) In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“217. *The law with respect to genuine use* . In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439 , Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I added references to Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

218. An important preliminary point to which Prof Annand draws attention in her decision is that, whereas the English versions of Articles 10(1) and 12(1) of the Directive and Articles 15(1) and 51(1)(a) of the Regulation use the word “genuine”, other language versions use words which convey a somewhat different connotation: for example, “ernsthaft” (German), “efectivo” (Spanish), “sérieux” (French), “effettivo” (Italian), “normaal” (Dutch) and “sério/séria” (Portuguese). As the Court of Justice noted in *Ansul* at [35], there is a similar difference in language in what is now recital (9) of the Directive.

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetzky-Orden v Bundesvereinigung Kameradschaft 'Feldmarschall Radetzky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

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

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

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice:

Ansul at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

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

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

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

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

DECISION

Use in a differing form

21) In *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)

22) In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was) as the Appointed Person summarised the test under s.46(2) of the Act as follows:

"33. The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

23) Although this case was decided before the judgment of the Court of Justice of the European Union ("CJEU") in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered. The later judgment of the CJEU must also be taken into account where the mark is used as registered, but as part of a composite mark.

24) Where the mark has been used in the same form as it is registered (such as in numerous invoices and applied to the various goods) this will be use upon which the opponent may rely upon. The mark does appear exactly how registered but it also appears in a variant as follows:



25) This variant form is simply the mark as registered placed above the word SUN and numerals 68. It is clear from the case law in *Colloseum*, cited above, that use in conjunction with other matter falls within the ambit of genuine use. That is clearly the case here. Therefore, I find that the use of the mark in the variant shown above is use upon which the opponent may rely.

Sufficient use

26) In *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, 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).”

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.

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.”

27) In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion

of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use."

28) The General Court restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

29) Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant five-year period. In making the required assessment I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown
- ii) The nature of the use shown
- iii) The goods and services for which use has been shown
- iv) The nature of those goods/services and the market(s) for them
- iv) The geographical extent of the use shown

30) In *Jumpman* BL O/222/16, Mr Daniel Alexander QC, as the Appointed Person, upheld the registrar's decision to reject the sale of 55k pairs of training shoes through one shop in Bulgaria over 16 months as insufficient to show genuine use of the EU trade mark in the European Union within the relevant 5 year period.

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

32) An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself⁴.

33) The evidence clearly shows that the mark has predominantly been used in Italy but there are sales to the UK. The evidence includes examples of how the mark is used, details of how it is promoted and invoices demonstrating sales. Moreover, the turnover figures of nearly €28m in 2012 and just over €36m in 2013 are impressive. Further, the marketing spend is in the tens of thousands.

34) In view of the above, it is without doubt that the opponent has demonstrated genuine use of the mark during the relevant period.

⁴ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

Fair specification

35) I must now consider whether, or to the extent to which, the evidence shows use for all the goods it relies upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

36) In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme

Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

37) The opponent's evidence demonstrates that its mark has been used in relation to a large variety of clothing, for example polo shirts, cardigans, jumpers, dresses, t-shirts, jackets, etc. The opponent's list of goods includes *clothing at large*. Therefore, given the broad and numerous examples of various articles of clothing I consider this term to be a fair term. The evidence does show use of the mark for caps, sailor caps and baseball caps. These goods fall within the opponent's *Caps [headwear]* and I find this to be a fair term.

38) The evidence also includes examples of the mark being used on trainers and there are invoices including twill running shoes. The opponent's earlier mark covers *training shoes* which I find to be a fair term to reflect the use made of the mark.

39) In view of the above, I consider a fair specification to be: *Clothing; caps; training shoes.*

DECISION - Section 5(2)(b)

40) Section 5(2)(b) of the Act is as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

Case-law

41) The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

- The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- 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;

- the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- 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;
- nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- 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;
- 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;

Comparison of goods and services

42) In the judgment of the Court of Justice of the European Union 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”.

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

44) The respective goods are as follows:

Opponent's class 25 goods	Applicant's Class 25 goods
<i>Clothing; caps; training shoes</i>	<i>Clothing and Apparel; Adhesive bras; After ski boots; Aikido suits; Aikido uniforms; Albs; Aloha shirts; American football bibs; American football pants; American football shirts; American football shorts; American football socks; Anglers' shoes; Ankle boots; Ankle socks; Anklets [socks];Anoraks; Anoraks</i>

	<p><i>[parkas];Anti-perspirant socks; Anti-sweat underclothing; Anti-sweat underwear; Après-ski boots; Apres-ski shoes; Aprons; Aprons [clothing]; Aqua shoes; Arm warmers [clothing];Army boots ;Articles of clothing; Articles of clothing for theatrical use; Articles of clothing made of hides; Articles of clothing made of leather; Articles of outer clothing; Articles of sports clothing; Articles of underclothing; Ascots; Ascots (ties);Athletic clothing; Athletic footwear ;Athletic shoes; Athletic tights; Athletic uniforms; Athletics footwear; Athletics hose; Athletics shoes; Athletics vests; Babies' clothing; Babies' outerclothing; Babies' pants [clothing];Babies' pants [underwear]; Babies' undergarments; Babushkas; Baby bodysuits; Baby boots; Baby bottoms; Baby clothes; Baby doll pyjamas; Baby layettes for clothing; Baby pants; Baby sandals; Baby tops; Balaclavas; Ball gowns; Ballet shoes; Ballet slippers; Ballet suits; Ballroom dancing shoes; Bandanas; Bandanas [neckerchiefs]; Bandeaux [clothing]; Barber smocks; Baseball caps; Baseball caps and hats; Baseball hats; Baseball shoes; Baseball uniforms; Baselayer bottoms; Baselayer tops; Basic upper garment of Korean traditional clothes [Jeogori]; Basketball shoes; Basketball sneakers; Bath robes; Bath sandals; Bath shoes; Bath slippers; Bathing caps; Bathing costumes; Bathing costumes for women; Bathing drawers; Bathing suit cover-ups; Bathing suits; Bathing suits for men; Bathing trunks; Bathrobes; Bathwraps; Beach clothes; Beach clothing; Beach cover-ups; Beach footwear; Beach hats; Beach robes.</i></p>
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45) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or

where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

46) Applying the principle set out in *Merix*, I consider all of the following goods to be covered by the term *clothing*. Therefore, they are identical:

Clothing and Apparel; Adhesive bras; Aikido suits; Aikido uniforms; Albs; Aloha shirts; American football bibs; American football pants; American football shirts; American football shorts; American football socks; Ankle socks; Anklets [socks]; Anoraks; Anoraks [parkas]; Anti-perspirant socks; Anti-sweat underclothing; Anti-sweat underwear; Aprons; Aprons [clothing]; Arm warmers [clothing]; Articles of clothing; Articles of clothing for theatrical use; Articles of clothing made of hides; Articles of clothing made of leather; Articles of outer clothing; Articles of sports clothing; Articles of underclothing; Ascots; Ascots (ties); Athletic clothing; Athletic tights; Athletic uniforms; Athletics hose; Athletics vests; Babies' clothing; Babies' outerclothing; Babies' pants [clothing]; Babies' pants [underwear]; Babies' undergarments; Babushkas; Baby bodysuits; Baby bottoms; Baby clothes; Baby doll pyjamas; Baby layettes for clothing; Baby pants; Baby sandals; Baby tops; Balaclavas; Ball gowns; Ballet suits; Bandanas; Bandanas [neckerchiefs]; Bandeaux [clothing]; Barber smocks; Baseball uniforms; Baselayer bottoms; Baselayer tops ;Basic upper garment of Korean traditional clothes [Jeogori]; Bath robes; Bathing costumes; Bathing costumes for women; Bathing drawers; Bathing suit cover-ups; Bathing suits; Bathing suits for men; Bathing trunks; Bathrobes; Bathwraps; Beach clothes; Beach clothing; Beach cover-ups; Beach robes.

47) I consider the applied for *Athletic footwear; Athletic shoes; Athletics footwear; Athletics shoes* to be synonyms of the opponent's earlier *training shoes* and, therefore, they are identical.

48) I understand the term *training shoes* to be shoes worn for wear whilst participating in sport or carrying out some form of physical training. They are likely to be suitable for wear whilst playing baseball and basketball, i.e. *Baseball shoes; Basketball shoes; Basketball sneakers*. Such goods are likely to be sold in the same

outlets and through the same channels as the opponent's *training shoes*. Further there is a degree of competition between the respective goods. They are highly similar.

49) Applying the principle set out in *Meric*, I consider the applied for *Baseball caps; Bathing caps* to be included, and therefore identical, to the opponent's *caps*.

50) I find the contested *Baseball hats; Beach hats* to be highly similar to the opponent's caps. They are identical in nature, i.e. articles to wear on one's head. They are likely to be sold through similar trade channels, and there is a degree of competition between them since one may have to decide whether to purchase a baseball cap or hat or buy a cap to wear on the beach rather than a beach hat to protect it from the sun. They are highly similar.

51) I now turn to the contested *After ski boots; Anglers' shoes; Ankle boots; Après-ski boots; Apres-ski shoes; Aqua shoes; Army boots; Baby boots; Ballet shoes; Ballet slippers; Ballroom dancing shoes; Bath sandals; Bath shoes; Bath slippers; Beach footwear*. Each of the aforementioned items are effectively footwear which have in some way been adapted for wear in the sun, snow, water or used for, or after, specific activities. The opponent's earlier goods contains the broad term *clothing*. This term would cover clothing which may be used for skiing, angling, ballet, ballroom dancing and general wear. In other words, for the footwear which are adapted or used for a specific purpose, the term *clothing* covers such clothing which can also be adapted for the same specific purpose. Footwear per se and clothing per se are generally similar in nature since they are used to cover and protect the body, or in the case of footwear, one's feet. They are often produced by the same undertaking and have the same end user/relevant public and distribution channels. Therefore, I find all of the above-mentioned goods to be similar to the earlier *clothing* to an average degree.

Comparison of marks

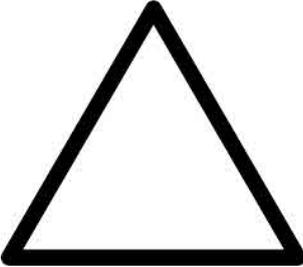
52) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to

analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

54) The respective trade marks are shown below:

Opponent's mark	Applicant's mark
 The image shows two symbols side-by-side. On the left is a solid black triangle. On the right is a solid black cross (an 'X' shape).	 The image shows a single solid black triangle.

55) The earlier mark consists of a delta or triangle device beside a cross or 'X', with both being roughly the same size. The overall impression of the mark resides in two separate symbols with neither being dominant.

56) The applied for mark consists solely of a triangle/delta device. There are no other elements to contribute to the overall impression, which is contained in the device itself.

57) The only submissions filed by the parties concerning similarity of the marks (or not) are included in the statement of grounds and counterstatement. In the applicant's counterstatement it stated:

"The logos are completely separate logos. VIVERE uses just an isosceles triangle, whereas NUMERO 8 S.R.L. uses a slightly difference isosceles triangle followed by an X therefore making the logos completely separate logos."

58) In the opponent's statement of grounds it stated:

"The opposed mark consists solely of the device of an outline of a triangle, the proportions of which are very similar to those of the triangle device of the Opponent's earlier mark. The triangle device is one of two elements making up the earlier mark and appears at the beginning of the mark followed by a letter or sign 'X'."

59) Visually, the signs coincide by having the device of a triangle which is the sole element of the applicant's mark and one of two elements in the earlier mark. I do acknowledge that the triangle in the earlier mark has slightly thicker outline, though the difference is so insignificant that it is likely to go unnoticed by the average consumer. I consider the marks to be visually similar to a medium degree.

60) Turning to the aural comparison, in *Dosenbach-Ochsner AG Schuhe und Sport v OHIM*, T- 424/10, the GC stated:

"46. A figurative mark without word elements cannot, by definition, be pronounced. At the very most, its visual or conceptual content can be described orally. Such a description, however, necessarily coincides with either the visual perception or the conceptual perception of the mark in

question. Consequently, it is not necessary to examine separately the phonetic perception of a figurative mark lacking word elements and to compare it with the phonetic perception of other marks.”

61) In view of the above, it is not necessary for me to consider any aural similarity between the marks.

62) Conceptually, I have no submissions from either the applicant or opponent. For a conceptual message to be relevant, it must be capable of immediate grasp by the average consumer⁵. The earlier mark includes the description ‘The symbol delta followed by the letter X’. Whilst the trade mark registration includes this description, I must assess the position from the perspective of the average consumer who is likely to either view it as a delta symbol or simply as a triangle. For the goods in question I consider that it will simply be viewed as a delta/triangle. Since the application is a delta/triangle and the first symbol in the earlier mark is virtually identical, I consider there to be an average degree of conceptual similarity.

Average consumer and the purchasing act

63) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

64) 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

⁵ See Case C-361/04 P *Ruiz-Picasso and Others v OHIM* [2006] ECR I-00643; [2006] E.T.M.R. 29

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.”

65) In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the GC stated that:

“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”.

66) In the opponent’s statement of grounds it states that the ‘average consumer is the average member of the public who will not pay a particularly high attention to the marks.’ I agree. The average consumer of the goods at issue, which are general consumer goods, is a member of the general public. The cost of the goods can vary considerably. However, the average consumer will wish to ensure that the goods are, for example, the desired fit, colour or style. Consequently, at least an average degree of attention will be paid to their selection.

67) The goods at issue are generally sold through bricks and mortar retail premises (such as shops on the high street, or in supermarkets) and online. The goods will normally be chosen via self-selection from a shelf or a website, or perhaps from a catalogue. Whilst I do not rule out that there may be an aural component (advice may, for example, be sought from a shop assistant), when considered overall, the selection process will be mainly visual.

Distinctive character of the earlier trade mark

68) 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).”

69) The opponent has filed evidence in support of its proof of use claim but has not claimed an enhanced degree of distinctive character by virtue of the use made of it. Therefore, I shall only consider the inherent distinctive character in the mark.

70) The earlier mark consists of two separate symbols, one being a triangle and the other a cross or letter 'X'. Neither party has filed submissions or evidence to assist me in determining the degree of distinctive character of the earlier mark. As a whole, it is not descriptive, allusive or suggestive of the goods or a characteristic thereof. On this basis, I consider it to have a normal degree of distinctive character.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

71) 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 it 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.

72) Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

73) In the opponent's statement of grounds the opponent states that 'There is an inevitable likelihood of confusion resulting from customers assuming that a connection exists between the marks'. The applicant disagrees.

74) In reaching a conclusion, I shall consider the matter which mostly favours the applicant, i.e. from the perspective of consumers who pay a high degree of attention during the selection process (thus making them much less prone to the effects of imperfect recollection).

75) As outlined above, I have found the marks to be visually and conceptually similar to a medium degree. I have also found that most of the applied for goods are identical with the rest being either highly or averagely similar. I have also found that the earlier mark has a medium degree of distinctive character and that the purchasing process usually follows a visual inspection of the goods. Taking all of

these factors into consideration, I find that there is a likelihood of confusion between the respective marks. It is likely that the average consumer would mistake one trade mark for the other, i.e. direct confusion. Such confusion is even more likely when considered from the perspective of the average consumer who pays a lower degree of care and attention during the selection process.

OUTCOME

76) The opposition has been successful and, subject to appeal, the application shall be refused in its entirety.

COSTS

77) The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances, I award the opponent the sum of £900 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing the notice of opposition and reviewing the counterstatement	£300
Preparing evidence	£500
Official fee	£100
Total	£900

78) I therefore order Joshua Joseph to pay Numero 8 S.R.L. the sum of £900. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

Dated this 6th day of December 2018

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