

O-790-18

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS BETWEEN

BVG AIRFLO GROUP LTD AND BRIAN W DICKSON & JULIE M DICKSON

CONCERNING:

1) BVG AIRFLO GROUP LTD'S APPLICATIONS (3231309 & 3162557) FOR THE
TRADE MARKS

aerobike

AND

aeroboard

AND

BRIAN W DICKSON & JULIE M DICKSON'S OPPOSITIONS (410178 & 407760)
THERETO

AND

2) BVG AIRFLO GROUP LTD'S APPLICATIONS TO REVOKE FOR NON-USE
(501713) AND TO INVALIDATE (501712)
TRADE MARK REGISTRATION (2432331)
OWNED BY BRIAN W DICKSON & JULIE M DICKSON'S
IN RESPECT OF THE SERIES OF FOUR MARKS:

Aero Sport

AERO SPORT

aero sport

aERO sPORT

Background and pleadings

1. These consolidated proceedings concerns (i) two oppositions filed by Brian W Dickson & Julie M Dickson (hereafter “BJ Dickson”) against two trade mark applications made by The BVG Airflo Group Ltd (hereafter “BVG”); (ii) an application for revocation for non-use and an application for a declaration of invalidity, both filed by BVG against BJ Dickson’s earlier relied upon registration (no. 2432331) for the mark Aero Sport, AERO SPORT, aero sport, aERO sPORT (series of four).

Opposition pleadings

2. BVG’s trade mark applications which are opposed by BJ Dickson are as follows:

- i. **Application no. 3231309¹** (“first applied for mark”) (opposition no. 410178 filed on 4 September 2017) for the mark:

The logo for 'aerobike' features the word 'aero' in a light green, lowercase sans-serif font, followed by 'bike' in a grey, lowercase sans-serif font. The letter 'i' in 'bike' is replaced by a green battery icon with three white segments.

Filing date: 16 May 2017

Publication date: 02 June 2017

List of goods:

Class 9: *Protective safety clothing including helmets, gloves, footwear and body armour, rechargeable batteries and battery chargers.*

Class 12: *Bicycles and parts, fittings and accessories therefor included in this class.*

¹ This is the second application filed by BVG for the same mark. BVG was the registered proprietor of trade mark registration no. 3162954 for a mark that is the same subject of application no. 3231309. The mark had a filing date of 5 May 2016 and a registration date of 05 August 2016. On 14 December 2016 BJ Dickson made an application for a declaration of invalidity of BVG’s registered mark. BVG failed to file a defence within the relevant timescale and the registration was cancelled and removed from the Register with decision of 9 May 2017.

- ii. **Application no. 3162557** (“second applied for mark”) (opposition no. 407760 filed on 28 October 2016) for the mark:

aeroboard

Filing date: 3 May 2016

Publication date: 29 July 2016

List of goods:

Class 9: *Protective safety clothing including helmets, gloves, footwear, and body armour; rechargeable batteries and battery charges.*

Class 12: *Self propelled, wheeled personal mobility and transportation devices; parts and fittings for all aforesaid included in this class.*

3. BJ Dickson opposes the registration of the above marks in full.

4. Each opposition is based on Section 5(2)(b) of the Trade Mark Act (“the Act”). This is on the basis of BJ Dickson’s earlier UK trade mark registration no. 2432331, the subject of the revocation and invalidity actions detailed below. Pertinent details of the earlier registration are detailed below:

UK Registration no. 2432331 (“first earlier mark”) for the marks (series of four):

Aero Sport

AERO SPORT

aero sport

aERO sPORT

Filing date: 12 September 2006

Registration date: 04 July 2008

List of goods:

Class 9: *Body protection against sports injury, including guards, padding and pads but not including headgear, eyewear or mouthguards; telescopes, electronic heart rate monitors, gum shields.*

Class 12: *Cycles, all components and accessories, parts, attachments therefore.*

Class 18: *All equestrian articles and accessories, holdalls for sports articles, trunks and bags, walking sticks.*

Class 25: *Martial arts clothing, sports clothing, headwear, ski hardware, protective clothing, wet suits, headgear, (not footwear); non of the aforesaid clothing being leather clothing; sports bags and holdalls in this class.*

Class 28: *Sporting articles, but not including fishing equipment or cricket equipment and accessories; gymnastic articles and fitness machines; games; accessories for all the aforesaid goods; golf equipment*

5. In addition, in the opposition against the second applied for mark, BJ Dickson relies on the following grounds:

- i. Under Section 5(2)(b) of the Act, BJ Dickson relies on another earlier mark, the relevant details of which are shown below:

UK registration no. 2432333 (“second earlier mark”) for the mark:



Filing date: 12 September 2006

Registration date: 04 July 2008

List of goods: The mark covers the same goods in classes 9, 12, 18, 25 and 28 as the registration no. 2432331 set out above.

- ii. Under Section 5(4)(a) of the Act, BJ Dickson relies on the use of unregistered signs corresponding to its earlier marks as well as the unregistered sign AEROLITE, all of which are claimed to have been used since 2006 in relation to: *body protection against sport injury, including guards, padding and pads; protective helmets; electronic heart rate monitors, gum shields; bicycle component and accessories, parts, attachments therefore; holdalls for sports articles, trunks and bags, martial arts clothing, headwear, ski hardware, protective clothing, headgear, sports bags and accessories.*

6. BVG filed counterstatements in the opposition proceedings denying the claims made and requesting that BJ Dickson provides proof of use of its earlier marks relied upon. Given the interplay between the date that BJ Dickson's earlier marks were registered and the date that BVG's applications were published, the proof of use requirements are in effect and BVG has put BJ Dickson to such proof. The same issue is in play in the revocation proceedings and, consequently, I will consider the issue of genuine use first.

Revocation and invalidity pleadings

7. On 4 July 2017, BVG filed two applications to cancel BJ Dickson's first earlier mark. These consist of:

- i. Application no. 501713 to have the mark revoked for non-use under Section 46(1)(b) of the Act. Eventually, BVG's claim was that the mark was not put to genuine use in relation to *bicycles, all components and accessories, parts, attachments therfor except bicycle tyre inner-tubes to the extent that a highly stylised version of the trade mark has been used in respect of such inner tubes* in the 5-year time period starting on 3 July 2012 and ending on 2 July 2017. Revocation is therefore sought from 3 July 2017;
- ii. Application no. 501712 to invalidate the mark. The grounds of invalidation are that: (a) the mark "AERO SPORT" without stylization does not satisfy the requirement of Section 3(1) and is not registrable because it is directly descriptive of goods and services relating to 'aereosports' and it is therefore; (b) devoid of any distinctive character; (c) descriptive, and (d) customary in the trade. Registration of the mark was therefore contrary to Section 3(1)(a), (b), (c) and/or (d) of the Act and it should now be declared invalid under Section 47(1).

8. BJ Dickson filed counterstatements denying the grounds for revocation and invalidation of its trade mark.

Representation

9. The proceedings were consolidated. Both sides filed evidence. They also filed evidence in reply. Neither party asked to be heard but they both filed submissions in lieu of a hearing. Both sides are professionally represented, BJ Dickson by Virtuoso Legal Limited and BVG by Richard R Halstead & Co Ltd.

The approach

10. I will first determine the invalidation claim made against BJ Dickson's first earlier mark as the scope for which this mark is validly registered has been put into question. I will then assess BJ Dickson's evidence of use, since the question of whether BJ Dickson has used its earlier marks for the goods that they are registered for is a key factor in the opposition proceedings (to the extent that both earlier marks are subject to proof of use) and in the revocation proceedings against one of the earlier marks and might also have a direct impact on the invalidity proceedings. I will deal with the revocation proceedings and the proof of use issue in the opposition proceedings together.

11. Both sides' evidence contains a mixture of fact and submission. The submissions will be borne in mind and referred to as and when appropriate during this decision, but will not form part of the evidence summary.

Decision

BJ Dickson's evidence in chief

12. This consists of a witness statement from Brian Dickson, dated 8 May 2017 ("BD's first witness statement). Mr Dickson is one of the joint owners of BJ Dickson's first and second earlier marks; he is also Managing Director of Sport Direct Limited, which is said to be the exclusive licensee of those marks. The following facts emerge from Mr Dickson's evidence:

- since 2006 Mr Dickson has created and continuously developed a comprehensive range of sports clothing bearing BJ Dickson's marks. To further complement this range, he has successfully established a full range of hardware, in particular cycle accessories, including tyres, tubes and saddles;
- the products have been sold through Sport Direct Limited to a variety of UK retailers, both on-line and in-store;
- the opponent has made extensive use of its marks throughout the UK in respect of a large range of goods covered by the specifications over a period of 11 years.

13. Mr Dickson provides a non-exhaustive list of 28 retailers which, he says, stock products bearing BJ Dickson's marks, including Amazon, Sport Direct, Very, Littlewood and eBay. In an exhibit (BD01) to his witness statement, Mr Dickson provides:

- prints from the website enbeecycling.co.uk showing the first earlier mark in use on a range of goods, including bicycle components and accessories such as saddles, pumps, gloves and tyres. The pages are undated, save from the printing date of 21 April 2017, and refer to AERO SPORT as an established brand for bike accessories²;
- prints from various UK online retailers' websites, including eBay, Amazon, Littlewoods, Very and Bikes Outlet Store UK, showing both the first earlier mark (sometimes followed by the ® symbol) and the second earlier mark in use on a range of bicycle components, clothing and accessories. The pages are undated, save from the printing date of 21 April 2017, but some of the descriptions indicate that the products were available on various dates in 2013³ and 2010⁴;

² "Aero Sport Bike Accessories offers one of the most comprehensive range of bike accessories available today. With a strong high street brand presence, it has become a sought-after brand in the cycling market [...]"

³ Aero Sport cycling gloves, page 22

⁴ Aero Sport Bike Inner Tube, page 38

- a print from the Internet Archive Way Back machine showing the home page of the website Bike-x.co.uk on 29 January 2009. The second earlier mark is listed as one the brands stocked;

BVG's evidence in chief

14. This consists of a witness statement from Daniel Price dated 4 July 2017 (“DP’s first witness statement”), the Managing Director of BVG. Mr Price’s statement is, in large measure, a commentary on BJ Dickson’s evidence. In particular, he seems to make the following criticisms:

- the term AERO SPORT is often use in the material filed without the ® symbol, in which case it is not clear whether use of the words AERO SPORT is used as a trade mark;
- the limitation contained in BJ Dickson’s specification of goods is indicative of third party having some rights to use BJ Dickson’s marks in respect of the excluded goods, from which Mr Price infers that BJ Dickson does not enjoy exclusive rights in its marks for such goods;
- BJ Dickson did not adduce evidence of confusion and passing off despite the fact that BVG’s products, which consist of self-balancing electrical scooters, have been on the market since November 2016.

15. Mr Price also concedes that the “aero sport logo has been used as a trade mark consistently by the opponent[s] in respect of a certain, limited, range of goods, which do not include bicycles but do include e.g. inner tubes and bicycle tyres.” However, he does not accept “that the opponent[s] have used the term “aero” simpliciter, either on its own as a trade mark or even with the term “sport” [...]” (my emphasis).

BJ Dickson's evidence in reply

16. In his second witness statement of 15 September 2017 ("BD's second witness statement"), Brian Dickson provides a list of over 80 AERO SPORT products which, he said, were available on Amazon in the relevant period. These include bicycle components, clothing and accessories, such as tyres, inner tubes, saddles, saddle covers, pumps and gauges, reflective helmets and rucksack covers, mudguards, cycling tops, shorts, gloves, mitts and caps. It should be noted that although Mr Dickson refers to the period between 29 July 2011 and 29 July 2016 as "the relevant period", there are two actual proof of use periods under Section 6A of the Act, which run from 28 July 2011 to 29 July 2016 (in the opposition against the second applied for mark) and from 03 June 2012 to 02 June 2017 (in the opposition against the first applied for mark), respectively, and one proof of use period under Section 46(1)(b), which runs from 3 July 2012 to 2 July 2017. The period specified by Mr Dickson virtually mirrors the relevant period in the opposition against the second applied for mark and overlaps the relevant periods in the other opposition and in the revocation.

17. Mr Dickson states that Sport Direct Limited's turnover was between £5 to £10 million in the relevant period. Of this, between £1 and £2 million accounted for sales from products bearing the AERO SPORT brand and the majority of this relates to the UK. He also states that the AERO SPORT mark has been promoted during the relevant period mainly by way of advertising through Bike Biz, which is said to be "the largest trade magazine for the cycle industry" with 87,000 visitors and pages viewed per month and a total circulation figure of 4,000 copies (via mail and digital). The adverts on Bike Biz are said to have ran for several years from 2011. In support of this, he exhibits the following, which I regard as the key exhibits:

- **Exhibit BD2.1** - further prints from the website Amazon.co.uk showing AERO SPORT branded items available for sale. The products are identified as AERO SPORT (sometimes followed by the ® symbol) and feature the second earlier mark. This evidence corroborates Mr Dickson's claim regarding the range of products available and it is relevant, in relation to a number of products, because it shows that goods had been available on various dates in 2011, 2012, 2013, 2014, 2015;

- **Exhibit BD2.5** - extracts from the Internet archive called “WayBack Machine” showing a number of AERO SPORT branded products available on the website very.co.uk on 25 March 2014 and 19 July 2015. The goods, which include bicycle clothing, saddles and tyres, are identified by the words AERO SPORT (sometimes followed by the ® symbol) and also feature the second earlier mark;
- **Exhibit BD2.6** - extracts from a UK catalogue⁵ dated October 2013. As Mr Price point out, the second earlier mark can just about be made out on a packaging of reflective bike clips;
- **Exhibit BD2.7** - photocopies of three invoices dated 7 and 25 September 2012. The invoices are issued by Sport Direct Limited but there is no indication of whom they have been issued to, though Mr Dickson claims that they relate to deliveries made to a UK chain of department stores. The products sold seem to relate to bicycle components and accessories, some of which have been marked as AERO SPORT in handwriting;
- **Exhibit BD.8-11** - screenshots from Bike Biz’s website corroborating Mr Dickson’s evidence about the magazine’s reach as well as the promotion of the AERO SPORT brand. The adverts feature both the second earlier mark and the words aero sport. The pages are all undated but seem to have been posted on 26 June 2011 and on 8-9 June 2011, respectively;
- **Exhibit BD2.12** - photographs of product packaging bearing the second earlier mark, some of which are dated April and May 2012. The products are all bicycles accessories and components.

⁵ The prices are in UK pounds

18. In his third statement dated 6 April 2018, Brian Dickson concedes that, on the basis of the evidence filed, BJ Dickson has proven genuine use of the first earlier mark⁶ in relation to the goods specified in the classes 12 and 25, which, he states, are “the most relevant classes to the Aerobike opposition”.

19. The remainder of the witness statement consists of evidence about the invalidity proceedings at issue. Rather than detail it here, I will refer to this evidence as and when appropriate during this decision.

BVG’s evidence in reply

20. BVG’s filed two sets of evidence in reply in the form of two witness statements from Daniel Price dated 9 April 2018 and 8 June 2018, respectively (“DP’s second and third witness statements”). In his second witness statement, Mr Price concedes that Mr Dickson’s evidence is sufficient to infer that BJ Dickson has used the second earlier mark “on a variety of accessories for cycles including inner tubes, saddles, reflective clips and mudguards, as well as a variety of clothing for cyclists including caps, vests, shorts and gloves”. However, he challenges the evidence to the extent that a) it does not show use of the mark in relation to bicycles *per se* and b) is not sufficient to infer the level of sales of the products.

21. I do not propose to summarise Mr Price’s third witness statement most of which reiterates Mr Price’s earlier submissions.

Application for invalidation of BJ Dickson’s first earlier mark

22. I shall deal first of all with the ground of the application for the declaration of invalidity of BJ Dickson’s first earlier mark based upon Section 47(1) and Sections 3(1)(a), (b), (c) and/or (d) of the Act. Section 47 reads:

⁶ Paragraphs 17-21

“47. - (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.”

23. Section 3 reads:

“3(1) The following shall not be registered –

- (a) signs which do not satisfy the requirements of section 1(1),
- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

24. Section (1)(1) in turn reads:

1.-(1) In this Act a “trade mark” means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.”

25. Section 72 of the Act is also relevant. It reads:

“72. In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register) the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmission of it.”

26. As Section 72 states that registered marks should be treated as *prima facie* valid, the onus is on BVG to demonstrate that BJ Dickson’s mark is not valid.

27. The factual content of Mr Price’s evidence is, essentially, that the sign “AERO is in common use particularly as a descriptive prefix” and has frequently been adopted by other traders. In support of his claim, he exhibits:

- a) a list of trade marks incorporating the word AERO which are said to cover goods in class 12 and 25;
- b) screenshots of the website Amazon.co.uk which are said to show use of the sign AERO by other traders. These are all undated, saved for the printing date of 8 April 2018;
- c) a list of links to the website Amazon.co.uk which are said to show that the goods listed at b) were available on various dates between 2009 and 2018;
- d) four screenshots from various websites that are said to show that the term ‘aero bike’ is a particular type of bike.

28. I shall return to this evidence later in this decision.

29. Mr Dickson also filed evidence in the invalidation proceedings. This was included in his statement of 6 April 2018, where he stated that he coined the term 'AEROSPORT' in 2005 and that he never heard of a sport called 'AEROSPORT'. He also filed screenshots from the websites oxforddictionaries.com, merriam-webster.com and oxfordreference.com showing that Internet searches of the term 'AEROSPORT' were performed and showed no returns (exhibit BD3.2).

Section 3(1)(a)

30. BVG put their objection on the basis of Section 3(1)(a) as follows:

“The sign does not qualify as a trade mark capable of being registered under Section 1(1) of the Act because, although it can be represented graphically, [...] the sign as registered in its various forms is simply the term “aero sport” which is directly descriptive of goods or services relating to aerosports, such that the sign is not capable of distinguishing goods and services of one undertaking from those of other undertakings unless it is sufficiently stylised so as to qualify for a registrable sign within the meaning of Section 1(1) of the Act”.

31. It is conceded that the mark is represented graphically so the objection relates to the inherent capacity of the mark to distinguishing BJ Dickson's goods from those of other undertakings. As Mr Geoffrey Hobbs Q.C., as the Appointed Person pointed out in *AD2000 Trade Mark*, Section 3(1)(a) permits registration provided that the mark is 'capable' to the limited extent of “not being incapable” of distinguishing⁷.

32. The proviso to Section 1(1) specifically states that a trade mark may consist of words. BVG has not shown why the words AERO SPORT are incapable of distinguishing. **Consequently, the ground of invalidity based upon Sections 1(1) and 3(1)(a) fails.**

⁷ See also *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418(Ch), paragraphs 44-47

Sections 3(1)(d)

33. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*, Case T-322/03, the General Court (GC) summarised the case law of the Court of Justice of the European Union (CJEU) under the equivalent of Section 3(1)(d) of the Act, as follows:

“49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma* (BSS) [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public’s perception of the mark (*BSS*, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices

of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and *BSS*, paragraph 40).”

34. See also: *Merz & Krell GmbH & Co* [2002] ETMR 21 (CJEU) and *Stash Trade Mark* – BL O/281/04 (AP)

35. In his evidence⁸, Mr Price refers to the question of validity of BJ Dickson’s registration as “something of a side issue” which is “of no particular interest to [BVG] save to the extent that it unfairly prejudices the legitimate use of the term “aero” or trade marks incorporating that term.”

36. In its submissions in lieu, BVG states:

“[...] even if, which is not admitted, the term “Aero Sport” was inherently distinctive when it was registered [...] in 2006 because other parties dealing in relevant goods such as bicycles and skateboards were not using the term “aero”, this position overlooks the fact that there is an ongoing obligation on the part of trade mark owners by virtue of Section 46(1)(c) of the Trade Mark Act which effectively requires them to constantly monitor and police the use of similar trade marks so that all or part of a trade mark does not become generic. In short, it is now far too late to retrieve a situation deemed to have existed when the Aero Sport trade mark was originally registered.”

37. BVG’s approach is misconceived. The assessment of whether BJ Dickson’s mark was registered in contravention of Section 3 of the Act must be carried out at the date the mark was applied for, not after grant. I note that in *DUAL*, BL-O-094-15 the Hearing Officer considered the specific issue of the relevant date in invalidation proceedings. He said:

⁸ Witness statement of 8 June 2018

“Invalidation is about the incorrect registration of a trade mark, the act of registration. A registration cannot become invalid because numerous years afterwards the trade mark becomes a sign or indication which has become customary in the current language or in the bona fide and established practices of the trade. Future events may limit the penumbra of protection, they may leave a trade mark open to attack as having become the name in trade of a product or service (Article 12.2(a) of the Directive), they do not make the act of registration invalid.”

38. *DUAL* is directly on the point. Whilst I am not bound to follow that decision, I come to the same view as the Hearing Officer in that case and for the same reasons that he gave. Invalidation is tied to the date of the application and is about the incorrect registration of a trade mark. Conversely, Section 46(1)(c) of the Act, to which BVG looked at, enables marks to be removed from the register if they have, subsequently to their registration, become generic due to the owner’s inaction. However, BVG did not make any claim pursuant to Section 46(1)(c), so the position after the date of application is not pertinent.

39. Accordingly, the relevant date in these proceedings is the date of application for registration of the mark in suit, i.e. 12 September 2006. The burden is on BVG to prove that BJ Dickson’s mark was invalidly registered at that date.

40. All of the evidence filed by BVG appears to relate to searches conducted 12 years after the relevant date. The screenshots of the websites are undated save from the printing date of 8 April 2018. As to the evidence regarding the websites links, if BVG had wished to rely on that evidence it should have provided, at least, paper copies. In any case, this evidence is totally insufficient to discharge the onus required by Section 3(1)(d), namely that, at the 12 September 2006, the words AERO SPORT had become customary in trade. **The ground of invalidation based upon Section 3(1)(d) fails.**

41. I next consider the grounds of invalidation under Sections 3(1)(b) and (c). I find convenient to start with Section 3(1)(c).

Sections 3(1)(b) and (c)

42. The case law under Section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 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), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94. Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia, *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44, paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley*, paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for

the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94 , the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily

recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56).”

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].”

43. BVG contends that the term ‘AERO SPORT’ is an ordinary descriptive term. However, as demonstrated by BJ Dickson, ‘aero sport’ is invented and has no dictionary definition. Whilst BVG says that the absence of a dictionary definition is not material, it cannot pin down exactly why the term ‘AERO SPORT’, as a whole, is descriptive. It states:

“[...] I consider that the mere absence of the term ‘aerosport’ in any of the three references referred by Mr Dickson does not alter the fact that each component of the mark has a well-known meaning that directly relates to the air, to lightweight products and/or to sports and sport activities, including sport goods and sport wear”.

44. It also seems to refer to the “lightweight goods capable of being used in the field of aero sport” and talks about “aero sports of various kind including aerial sports such as flying and ground based sports such as cycling where e.g. the term “aerobike is descriptive of a particular genre of lightweight but sturdy cycle [...]”.

45. The argument put forward by BVG’s must be dismissed.

46. Firstly, whilst the word 'SPORT' is clearly descriptive in relation to the goods covered by the registration -which are sport-related articles - the mark is 'AERO SPORT', not 'SPORT' alone. Secondly, there is no evidence that there is a sport (or a field of sports) called 'AERO SPORT'. Thirdly, the word 'AERO' is a prefix that is used at the beginning of words, especially nouns, to denote something relating to air or movement⁹ through the air and is not directly descriptive in the context of the goods covered by the registration in a manner which the consumer is able to understand directly. I will return to the question of the meaning of 'AERO' in the respective marks later in the decision. For now, suffice it to say that the Oxford Online Dictionary defines the word 'AERO' as follows:

AERO

2 [attributive] Aerodynamic.

'we softened the lines for a more aero look'

47. I consider that 'AERO' when used as a prefix as part of the composite term 'AERO SPORT' would not be taken to be descriptive by the average consumer. This is because when the two terms 'AERO' and 'SPORT' are combined together, the prefix 'AERO' does not modify the noun 'SPORT' in any clear, unambiguous way. The most that can be said is, in my view, that the combination will be understood as referring to two linked concepts, namely that of 'aerodynamic' and that of 'sport', with the prefix 'aero' being seen as somehow laudatory and allusive. However, the overall significance of the mark is still more than ambiguous for the consumer¹⁰. Trade marks are often constructed to convey an image that says something about the goods/services or a characteristic of them, but are nonetheless, not directly descriptive. I consider that to be the case here. The semantic content of the mark is too vague and indeterminate to render it descriptive of the goods in question (which, in turn, explains, why BVG's pleadings on the point were not particularly focused).

⁹ Collins online English Dictionary: AERO-: 1. Prefix - Aero- is used at the beginning of words, especially nouns, that refer to things or activities connected with air or movement through the air.

¹⁰ See also BJ Dickson statement of grounds against the first applied for mark, paragraph 10 which states: [...] this "AERO" element, which is present in both marks, creates a high level of conceptual identity between the two marks. In particular the first element "aero" when used in conjunction with certain other words denotes "air" or aerodynamic."

48. The ground under Section 3(1)(c) is rejected.

49. Whilst the ground of objection based on Section 3(1)(b) is independent of the grounds already considered¹¹, there is no material difference in the way that it is pleaded. The claim is that the mark is devoid of distinctiveness because it is descriptive/generic. Given my findings, above, the ground under Section 3(1)(b) must also be dismissed.

50. The grounds of invalidation based upon Section 3(1)(b) and (c) also fail.

51. The application for a declaration of invalidity is therefore rejected.

Legislation and leading case-law relating to non-use revocation

52. Section 46(1) of the Act states that:

“The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not 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, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c) [...]

(d) [...]

¹¹ *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P

(2) For the purpose of subsection (1) 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 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.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made: Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation may be made by any person, and may be made to the registrar or to the court, except that –

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from –

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existed

at an earlier date, that date.”

Relevant statutory provisions: Section 6A

53. As commented earlier, I would also consider the proof of use analysis under Section 6A as they can be dealt with together. 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.”

54. 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.”

55. In view of the above, when I come to consider the oppositions against BVG’s applications, BJ Dickson must demonstrate use of the earlier marks for all of the goods that they are registered for. Such use must be evidenced for the five-year period prior to and ending on the date of publication of BVG’s applications. Therefore, the relevant periods for the proof of use are 03 June 2012 to 02 June 2017 (in the opposition against the first applied for mark) and 28 July 2011 to 29 July 2016 (in the opposition against the second applied for mark).

56. 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].”

The relevant periods

57. I begin by reminding myself what the relevant periods for opposition and revocation assessments are. The three periods largely overlap:

- 1) For the opposition proof of use, the relevant periods are:
 - 28 July 2011 to 29 July 2016 (in the opposition against the second applied for mark);
 - 03 June 2012 to 02 June 2017 (in the opposition against the first applied for mark);

2) For the revocation, which is based on section 46(1)(b) of the Act only, the relevant period is: 3 July 2012 to 2 July 2017.

58. Whilst these are three different relevant periods, they overlap to the extent that nothing hangs on the individual start and end dates.

Have the marks been used for any or all of the relevant periods?

59. Before considering the evidence submitted by both parties to these proceedings, I should note that both parties made a number of concessions.

60. In his statement of 6 April 2018, Mr Dickson conceded that BJ Dickson's evidence shows use in relation to the goods specified in the classes 12 and 25. I will come on, in what follows, to whether BJ Dickson's evidence is sufficient to discharge the burden of proof in relation to any of the goods for the which the earlier marks are registered in these classes, however, I can say that Mr Dickson's admission concurs with my own conclusion that none of the evidence filed relates to BJ Dickson's goods in classes 9, 18 and 28. Further, it is clear from BJ Dickson's evidence that it does not trade in cycles and they have not shown any use of the earlier marks in relation to cycles.

61. BVG's comments as regard to what the evidence shows are as follows:

1) Dealing firstly with the application to revoke registration number UK00002432331 – Aero Sport (series of four) on the grounds of non-use, Party A relies upon the evidence it has submitted against the application by my company to register the trademark Aero Board and reserves the right to file further evidence. The evidence submitted by Party A appears to show use of the trademark AERO SPORT on a variety of accessories for cycles including inner tubes, saddles, reflective clips and mudguards, as well as a variety of clothing for cyclists including caps, vests, shorts and gloves. In all cases the goods are sold with a highly stylised version of the trademark Aero Sport in the form as registered under number 00002432333. No copies of end-user customer invoices are provided but it can be reasonably inferred that Party A has used the trademark on or in connection with these various goods, but not in connection with bicycles *per se*. However, what cannot be reasonably inferred is the level of sales of these products that have been offered for sale (allegedly). No indication is given by Party A as to whether these sales were substantial and are ongoing, or whether they were trial sales in the form of "tasters" to determine if there is a market for such additional cycling products. Given that searches we carried out prior to commencing the invalidity action based upon grounds of non-use failed to disclose use of the registered trademark in respect of goods other than bicycle inner tubes it is also reasonable to infer that these other goods are not currently sold by Party A. Nevertheless, it is conceded that if these goods have been sold during the last five years then the application to revoke the registration based upon non-use for these goods must fall away, although copies of invoices for each item of goods have not been supplied by way of verification of such sales.

62. BVG appears to accept, at least, that the second earlier mark has been used by BJ Dickson in connection with a range of cycling accessories and cycling clothes. BVG's main criticisms is that the evidence does not show the level of sales in relation to the goods which appear to have been offered for sale.

63. The mere fact that there are some gaps in the evidence does not mean that a finding of non-use must follow. It is important to bear in mind the picture built up by the evidence as a whole.

64. In my view, the evidence is sufficient to establish that BJ Dickson has been actively trading under the name AERO SPORT and has used both earlier marks since at least 2009-2010 demonstrating continuous trade up to 2017. This can be seen from the prints which show a large number of goods designated by the AERO SPORT marks offered commercially to the public through a number of UK retailers' websites and catalogues¹². They comprise cycling accessories, components and clothing. Despite this evidence having been printed after the relevant periods, a number of prints contain information about the products being available within the relevant periods. Further, the excerpt from enbeecycling.co.uk (dated 21 April 2017), which appears to be an independent website, refers to AERO SPORT as an established brand for cycling accessories.

65. All of this corroborates the claim that the marks were used during the relevant period and is complemented by evidence of marketing and sales figures.

66. In terms of marketing, whilst there is no indication of marketing spend, some of the evidence supports Mr Dickson's claim that the AERO SPORT mark was used in relation to the relevant goods and advertised in the period 2011-2016 in the UK. I refer, in particular to i) the evidence of packaging and the photographs depicting AERO SPORT branded products (some of which is within the relevant period) and iii) the evidence of advertising on websites specialising in cycling¹³. As regards the level of

¹² For the sake of completeness, I should say that use of the sign AERO SPORT in relation to goods sold through third parties' websites and/or catalogues is use with the consent of the owner, i.e. BJ Dickson, since, as it emerges from the evidence, is part of its distribution system.

¹³ Bike-x.co.uk and Bike Biz.

sale, Mr Dickson said that the total sales figures for the period 29 July 2011 to 29 July 2016 are between £1 and £2 million and that the majority of this relates to the UK. It is true that BJ Dickson fails to identify any customer and that the sale figures given are not broken down in any way. Customer information would have assisted in substantiating the basic claims and this could have been supplemented if the sales figures had been broken down by product. All that being said, throughout the documents exhibited by BJ Dickson there are multiple examples of products such as tyres, inner tubes, saddles, pumps, gauges and clothes for cycling. Overall, my conclusion is that for these goods the nature of use shown supports a finding of genuine use in respect of both earlier marks.

67. As I said earlier, BVG accepts that the second earlier mark has been genuinely used in the relevant period(s) in relation to bicycle tyre inner-tubes. This is apparent from the limitation contained in the revocation pleadings. It also seems to accept that the second earlier mark has been used in relation to other cycling accessories as well as cycling clothes. As regards the first earlier mark, BVG argues that the AERO SPORT mark (without stylization) has not been used as a trade mark. I will deal with this point very briefly. The evidence shows pictures and textual description of the goods as AERO SPORT. The Internet prints exhibited show the mark sufficiently near the goods such that consumers would associate the mark with the goods. I therefore conclude that both the first and the second earlier mark have been put to genuine use during the relevant periods.

68. The fact that I have found that BJ Dickson have shown use of the earlier marks is not an end to the matter. BVG's second line of argument is that BJ Dickson have not shown use of the earlier marks in respect of the full range of goods for which they are registered. Although set out in the introduction to this decision, I reproduce the goods for which the earlier marks are registered below:

Class 9: *Body protection against sports injury, including guards, padding and pads but not including headgear, eyewear or mouthguards; telescopes, electronic heart rate monitors, gum shields.*

Class 12: *Cycles, all components and accessories, parts, attachments therefore.*

Class 18: *All equestrian articles and accessories, holdalls for sports articles, trunks and bags, walking sticks.*

Class 25: *Martial arts clothing, sports clothing, headwear, ski hardware, protective clothing, wet suits, headgear, (not footwear); non of the aforesaid clothing being leather clothing; sports bags and holdalls in this class.*

Class 28: *Sporting articles, but not including fishing equipment or cricket equipment and accessories; gymnastic articles and fitness machines; games; accessories for all the aforesaid goods; golf equipment*

69. My next task is, therefore, to decide what is a fair specification for the goods in relation to which BJ Dickson's earlier marks have been used.

Fair specification (case-law)

70. 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.”

71. 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.”

72. I also remind myself that in the two oppositions at issue BVG has put BJ Dickson to proof of use in relation to all of the goods for which the first and the second earlier marks are registered but revocation of the first earlier mark is sought only for *bicycles, all components and accessories, parts, attachments therfor (sic) except bicycle tyre inner-tubes*.

73. From the evidence submitted by BJ Dickson, I conclude that the use made of the earlier marks covers goods which could be described as bicycle accessories and components and clothes for cycling. This accords with Mr Dickson's own statement that the evidence demonstrates genuine use of the earlier mark(s) in classes 12 and 25. Such use would in my view, come within the registered terms *cycles, all components and accessories, parts, attachments therefore* in class 12 (since the term "cycle" is short for "bicycle") and *sports clothing* in class 25.

74. Given the variety of items in relation to which use has been shown, I do not see a case for restricting the specification in class 12 to any specific type of cycle components, accessories, parts or attachments. However, BJ Dickson has failed to show use in relation to *cycles per se*. This raises the question whether *cycles* and *all (cycles) components and accessories, parts, attachments* are a single category. In my view they are not. Having regard to the purpose and use of the products and the perceptions of the average consumer, I find that *cycles* and *all (cycles) components and accessories, parts, attachments* are sufficiently distinct to constitute two independent subcategories in relation to the goods in Class 12. It follows that the earlier mark cannot be regarded as having been used for *cycles*. Consequently, the mark will be revoked in respect of *cycles*¹⁴ and BJ Dickson will not be able to rely on those goods in the oppositions at issue.

75. As regards the goods in class 25, the earlier marks have been used in relation to clothes for cycling; this falls within the general category *sport clothing*. In my view restricting the specification to clothes for cycling would be too pernickety¹⁵ and I

¹⁴ For the sake of completeness, I should say that whilst I note that the revocation action was directed at bicycles and the mark is registered for cycles, cycles and bicycles are one and the same thing (and BJ Dickson has not made any argument to the contrary). See for example, the TM Class, the EUIPO search tool that is available in all the official EU languages; this translates the term cycles as Bicyclettes (French), Bicicletta (Italian) and Bicyclettes (Spanish) all being the equivalent of the English word bicycles.

¹⁵ *Animal Trade Mark* [2004] FSR 19

consider *sport clothing (not footwear)* to be fair as a description. Finally, there is no use in relation to any of the registered goods in classes 18 and 28. Likewise, there is no use in relation to any goods in class 9.

76. I therefore conclude that:

- 1) BJ Dickson is only able to rely upon the following goods in the opposition proceedings:

Class 12: *all cycles components and accessories, parts and attachments.*

Class 25: *sport clothing (not footwear).*

- 2) **The application for revocation under section 46(1)(b) of the Act is partially successful in relation to *cycles* and, therefore, the first earlier mark shall be revoked in relation to these goods. As BVG sought revocation under Section 46(1)(b) the effective date of the order for revocation will be the date of the application for revocation. Therefore, the trade mark is revoked in respect of *cycles* with effect from 4 July 2017.**

Oppositions

Section 5(2)(b)

77. Section 5(2)(b) of the Act reads:

“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.”

78. 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:

- (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 greater 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

79. In comparing the respective specifications, all the relevant factors should be taken into account. In the judgment of the CJEU in *Canon*, (Case C-39/97), the Court stated at paragraph 23:

“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”.

80. 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.

81. In *YouView TV Ltd v Total Ltd* ,[2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

82. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

83. In *Kurt Hesse v OHIM* (Case C-50/15 P), the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, (Case T-325/06), the General Court (GC) stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

84. In *Gérard Meric v OHIM*, Case T- 133/05, the General Court (GC) stated:

“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 fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

85. The goods to be compared are:

First applied for mark	Earlier goods
<p>Class 9: Protective safety clothing including helmets, gloves, footwear and body armour, rechargeable batteries and battery chargers.</p> <p>Class 12: Bicycles and parts, fittings and accessories therefor included in this class.</p>	<p>Class 12: all cycles components and accessories, parts and attachments</p> <p>Class 25: sport clothing (not footwear)</p>
Second applied for mark	
<p>Class 9: Protective safety clothing including helmets, gloves, footwear, and body armour; rechargeable batteries and battery charges.</p> <p>Class 12: Self propelled, wheeled personal mobility and transportation devices; parts and fittings for all aforesaid included in this class</p>	

86. As a preliminary remark, with the exception of a general statement that the respective goods are identical or similar, BJ Dickson has not adduced any evidence and presented any argument to support its claim that the goods are identical or similar.

First applied for mark

Class 9

Protective safety clothing including helmets, gloves

87. Taking first the contested *protective safety clothing including helmets, gloves*, I note that this is a broad term which covers all types of protective clothing, helmets and gloves including those for use in sport. Further, the evidence about the BVG's goods and the nature of the marks support such interpretation. On that basis, I would say that the users of BVG's protective safety helmets and gloves includes the same as

those users of BJ Dickson's *sport clothing*. Further, the nature of the contested goods is that of something worn for participation in sport and the trade channels through which the goods reach the market are the same. It is not uncommon for companies to provide both the sportswear (being the garments) and the kit (being the equipment) required to participate in sports. Taking these factors into account, I find these goods are highly similar.

Protective safety clothing including footwear

88. Though the earlier specification covers *sport clothing* it does not cover *footwear*. On the other hand, the term *protective safety footwear* does not cover sport footwear. In the absence of evidence to the contrary, I find that there is no overlap between the nature, intended purpose or method of use between the applied for *protective safety footwear* and any of the earlier goods in class 12 and 25. In particular, in relation to the closest goods, which are the earlier *sport clothing*, I find that they are worn for participation in sport, while *protective safety footwear* are designed to protect the user's physical integrity in case of an accident. There is also no competition or complementarity between the goods, the trade channels do not coincide and the users are different. As some degree of similarity is required for there to be a likelihood of confusion¹⁶, the registration can proceed in respect of these goods.

Protective safety clothing including body armour

89. The contested *body armours* are protective clothing. In my experience *body armours* are commonly used by mountain bikers. Consequently, the goods have the same end users and method of use as the earlier *sport clothing*, are likely to be found in the same sporting goods stores and are complementary to a certain degree. In my view the goods are similar to a high degree.

¹⁶ *eSure Insurance v Direct Line Insurance* [2008] ETMR 77 CA

Rechargeable batteries and battery chargers

90. It is no obvious to me why the contested *rechargeable batteries and battery chargers* are similar to the earlier goods in classes 12 and 25. The users, uses, nature, intended purpose, method of use and trade channels are different and there is no competition or complementarity between the goods. As some degree of similarity is required for there to be a likelihood of confusion¹⁷, the registration can proceed in respect of these goods.

Class 12

Bicycles

91. The earlier *all cycles components and accessories, parts and attachments* are complementary to the contested *bicycles* in the *Boston Scientific* sense. Though the nature, purpose and method of use of the respective goods differ and they cannot be said to be in competition with one another, the channels of trade may converge since cycles parts and accessories are often sold in the same retail establishments as bicycles, whether online or traditional bricks and mortar. I find that these goods are similar to a medium degree.

Bicycles parts, fittings and accessories therefor included in this class

92. Although they are worded differently, the contested *bicycles parts, fittings and accessories therefor included in this class* and the earlier *all cycles components and accessories, parts and attachments* are the same thing. The goods are identical.

¹⁷ *eSure Insurance v Direct Line Insurance* [2008] ETMR 77 CA

Second applied for mark

Class 9

93. As the class 9 specification of the second earlier mark is identical to that of the first earlier mark, I reach the same conclusions as those outlined in the paragraphs 87-90 above.

Class 12

Self propelled, wheeled personal mobility and transportation devices; parts and fittings for all aforesaid included in this class

94. Although it has emerged from BVG's evidence that their products consist of self-balancing electrical scooters, they are seeking rights in the broad term.

95. In my view, the term *self propelled, wheeled personal mobility and transportation devices* would cover mobility and transportation devices for use of one person only that runs on wheels and are self-propelled. It would include, for example, self-balancing scooters as well as other mobility devices such as mobility scooters, skateboards and, I would say, bicycles. Consequently, the same findings outlined at paragraphs 91-92 apply here, namely that the contested *self propelled, wheeled personal mobility and transportation devices* are similar to a medium degree to the earlier *all cycles components and accessories, parts and attachments* and that the contested and *parts and fittings for all aforesaid included in this class* are identical.

The average consumer and the nature of the purchasing act

96. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue; I must then determine the manner in which these goods will be selected 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.”

97. The parties’ goods are bicycles, bicycle accessories and components, self-propelled, wheeled personal mobility and transportation devices (and parts and fittings), protective clothing and sport clothing. The average consumers for such goods are likely to be cyclists or those driving the contested mobility and transportation devices as well as manufacturers and those in the repair and maintenance businesses (in relation to the goods in class 12). In the latter two cases the commercial significance of choosing the right product is likely to mean that an above average degree of attention will be given to the selection of the goods at issue. Similarly, where the goods are purchased by individuals (rather than businesses) they are likely to have very specific performance and durability requirements in mind and are likely to pay an above average degree of attention during the selection process.

98. The goods will be selected visually from specialist establishments and websites, and although the mark will be spoken when advice is being sought from salespersons, I consider the purchase to be more visual than aural.

Comparison of marks

99. 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 them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

100. It would be wrong therefore artificially to dissect the marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features, (which are not negligible) and therefore contribute to the overall impressions created by them. The marks to be compared are:

<p>First applied for mark</p> 	<p>Earlier Mark</p>
<p>Second applied for mark</p> 	<p>aero sport</p>

101. I intend to limit my consideration to the first earlier mark since the stylisation of the other mark introduces a further difference between the competing marks. If BJ Dickson cannot succeed in relation to this mark, it will be in no better position in relation to the other mark. Further, as there are no material differences between the versions of the trade marks in BJ Dickson’s series of four, I will, for the sake of convenience, compare the Dickson’s ‘aero sport’ mark with BVG’s marks.

Overall impression

Earlier mark

102. The earlier mark consists of the words 'aero' and 'sport' presented in lower case. Whilst I bear in mind:

- i. that the average consumer will perceive the earlier mark as made up of two parts, namely 'aero' and 'sport', and
- ii. that the word 'sport' is descriptive in the context of the goods at issue in these proceedings, i.e. parts and accessories for bicycles and sport clothing;

103. I concord with BJ Dickson's own submission¹⁸ that the overall impression of the mark would be of 'aero sport' viewed as a whole. As I already mentioned, the word 'aero' is a recognised prefix susceptible of being used in combination with other words, which it modifies. Since the average consumer will view the element 'aero' as a prefix, he/she will see it as intrinsically connected to the word that follows, namely 'sport'. Consequently, despite 'aero' being the first term in the mark and 'sport' being descriptive, 'sport' will have a weight equal to that of the word 'aero', because the mark is likely to be perceived as an association of the prefix 'aero' with the word 'sport' irrespective of the (vague) meaning of the term 'aero sport'.

First applied for mark

104. The first applied for mark consists of the word 'aero' written in lower case in green and conjoined with the letters 'b', 'k' and 'e' written in grey. Between the letter 'b' and 'k' there is a cylindric device. This is decorated with green and white diagonal stripes, and has a small horizontal slash in green, which is barely visible. BVG says that the device replaces the letter 'i' and is meant to represent a stylised electric battery "so as to reinforce the point that the mark is intended for use on goods which are battery powered, and ancillary goods". Both parties refer to the first applied for mark as the

¹⁸ Paragraph 15 of submission in lieu

'aerobike'¹⁹ mark and I have no doubt that this is how the verbal element of the mark will be perceived by the average consumer. The mark as a whole is likely to be perceived as the conjunction of the prefix 'aero' and the word 'bike' which form a unit; consequently, both elements, i.e. 'aero' and 'bike', have an equal weight. Given the significance of the term 'aerobike' in the context of the goods in class 12 (see below), I think that the battery device and the stylisation make an equal contribution to the overall impression the mark conveys, though the verbal element 'aerobike' may be more distinctive in relation to the goods in class 25.

105. Visually and aurally, the marks are similar to the extent that they share the word 'aero' at the beginning. However, the second word, namely 'sport' and 'bike' bear no resemblance. Further, the device element in the first applied for mark creates a visual difference. In my view the marks are visually similar to a low to medium degree and aurally similar to a medium degree.

106. Conceptually, I have already found that consumer will perceived the earlier mark as composed of a combination of two linked concepts, namely the concept of 'aerodynamic' and the concept of 'sport' although the semantic content of the mark, as a whole, is ambiguous.

107. Turning to first applied for mark, BVG claims that the term 'aerobike' is descriptive of a type of bike called 'aerobike'. The evidence it filed in support of its claim are five screenshots. These are as follows:

- a screenshot google.co.uk showing the results of an Internet search for 'aero bikes 2016'. It displays the words 'shop for aero bikes 2016' and 5 bikes identified as 'Giant Propel Advance 2 ...';
- a screenshot from the website bdc-mag.com containing the following text: BDG-MAG AWARDS 2016: BEST AERO BIKE. However, the article also contains Italian texts and is not clearly directed to the UK public;

¹⁹ This also concurs with how the mark was taken to be by the UKIPO in its registration process

- two screenshots which contains the following text: “CANNONDALE AERO BIKE SPOTTED” and “HOW MUCH FASTER IS AN AERO BIKE?”. These appear to be from websites which cannot be clearly identified;
- a screenshot from the website cyclingweekly.com containing the following text: “LIGHTWEIGHT VS AERO, WHICH IS BEST?”. Whilst BVG refer to the article being published in the UK the claim is unsupported;

108. BJ Dickson has not challenge the registrability of the mark under absolute grounds so I must proceed on the basis that the contested ‘aerobike’ mark complies with the requirement of Section 3.

109. There is no dictionary definition of ‘aerobike’, however, the references in the material filed by BVG suggest that the term ‘aero bike’ is in use. In this connection, whilst BVG’s evidence is far from overwhelming, it confirms my understanding of the natural meaning of the words when used together. Even if it is not possible to draw firm conclusions as to whether the term ‘aerobike’ is known in the UK, bearing in mind the definition of ‘aero’ as ‘aerodynamic’, my conclusion is that ‘aerobike’ would be taken as denoting a bike where the frame is designed to make it aerodynamic. In this connection the following dictionary definition²⁰ of ‘aerodynamic’ become relevant:

Adjective: relating to aerodynamics: *aerodynamic forces*
of or having a shape which reduces the drag from air moving past: *the plane has a more aerodynamic shape*

110. In my view, whilst the meaning of ‘aero sport’ in the earlier mark is ambiguous, ‘aerobike’ conveys a much clearer concept (especially if one considers that the registration covers bicycles and goods which could be used when cycling). This means that the word ‘aero’ does not have an independent distinctive role in ‘aerobike’. However, to the extent that the average consumer will still perceive the concept of ‘aero’ in both marks, the marks are conceptually similar to a low degree.

²⁰ Oxford English Dictionary

Second applied for mark

111. The second applied for mark consists of the word 'aero' written in lower case in green and conjoined with the letters 'board' written in grey. The mark is likely to be perceived as a unit and both elements, i.e. the prefix 'aero' and the word 'board', are likely to contribute in equal measure to the overall impression the mark conveys.

112. Visually the marks are similar to a medium degree. Aurally, the 'aero' part of each mark sounds the same and the endings of the marks are also similar, i.e. 'rd' vs 'rt' which make for a finding of a medium to high degree of aural similarity.

113. Conceptually, whilst the term 'aeroboard' is invented, the mark will be perceived as the conjunction of the prefix 'aero' and the word 'board'. The word 'board' has a clear meaning, i.e. the piece of equipment on which a person stands in surfing, skateboarding, snowboarding, and certain other sports, and the word 'aero' will be understood as referring to a quality of the board. In my view, attributing the words 'aero' and 'board' their natural meaning, the average consumer will understand 'aeroboard' as referring to the concept of a board, such as a skateboard, which is aerodynamic. This would be true in relation to all of the goods, but in particular for the goods in class 12 which would include skateboards. Again, the word 'aero' does not have an independent distinctive role in 'aeroboard' and the marks are conceptually similar to a low degree.

Distinctive character of earlier mark

114. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*²⁶, 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).”

115. Whilst BJ Dickson has filed evidence of use, it has provided no information about market share or marketing spent, which means that the earlier mark has no enhanced distinctive character.

116. In support of its argument that the marks are unlikely to be confused because the common element, i.e. the prefix AERO-, is in common use, BVG relied on a UK mark in its own name and on a large number of trade mark registrations owned by third parties employing the prefix ‘aero-’, including aerotek (UK3194715), Aerobody (IR1050114), AEROTRONIC (IR551558), AeroSwing (IR1386834) , Aeromov (IR1336053), AeroGT (IR1306119), AEROMOBIL (EU12353207), Aerobox (IR995318), AEROBLADE (UK3168538), Aerocyclodynamic (UK3104657), AEROFLITE (UK2470752), AeroRide (EU16967929), aeroflex (EU16898082), AEROFRAME (EU14396436), Aero Racing (EU9139726) AERO-GO (EU8508707), AEROMESH (EU8476723), AERO AirSpring (EU8229627), Aero Deck (EU6561757), AEROVISION (EU6561757), AEROBLADE (EU2101780), Aero8 (EU1530237), AEROSPORT (EU1436245) and AEROSOLE (EU725168)²¹. Most of these registrations are for vehicles in class 12 (as well as parts and fittings) and goods in class 25.

²¹ Annex A

117. BVG also provides screenshots from www.amazon.co.uk disclosing the following uses:

1. A company called Merrell sells Merrell Men's All Out Blaze Aero Sport Low Rise Hiking Shoes;
2. A company called Bakers of Kensington sells Bakers of Kensington Aero Sport Watches;
3. A company called Pro-Lite Sports sells Pro-Lite Sports Aero-D Graphite Pickleball Paddle;
4. A company called Aero sells Aero P2 Stripper (Cricket Thigh Pads Set) and Aero Groin Protector Shorts;
5. A company called Topeak sells Topeak Aero Wedges QR Saddlebag;
6. A company called SISU sells SISU 1.6 Aero Mouth Guard;
7. A company called AeroCover sells Free Arm Parasol Cover;
8. A company called AeroVU sells Aero VU Wiper blades;
9. A company called Stihl sells Stihl Aero Light Chainsaw Safety Protective Helmet;

118. I am aware that without more, state-of-the-register evidence is rarely likely to be determinative. In *Henkel KGaA v Deutsches Patent- und Markenamt*, Case C-218/01, the CJEU found that:

“65... The fact that an identical trade mark has been registered in one Member State as a mark for identical goods or services may be taken into consideration by the competent authority of another Member State among all the circumstances which that authority must take into account in assessing the distinctive character of a trade mark, but it is not decisive regarding the latter's decision to grant or refuse registration of a trade mark.

On the other hand, the fact that a trade mark has been registered in one Member State for certain goods or services can have no bearing on the examination by the competent trade mark registration authority of another Member State of the distinctive character of a similar trade mark for goods or services similar to those for which the first trade mark was registered.”

119. In *Zero Industry Srl v OHIM*, Case T-400/06, the General Court stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71). “

120. Whilst I do not find BVG’s material compelling, it provides support for the proposition that the prefix ‘aero’ is susceptible of being used in composite marks in combination with other words and that it is the totality that distinguish one word/sign from another.

121. Consequently, the distinctiveness of both parties’ marks is more likely to lie in the totalities they create rather than the individual elements of which they are made up.

122. As I have already mentioned in the preceding paragraphs, the term ‘aero sport’ is likely to be seen as a combination of two linked concepts, namely the concept of ‘aerodynamic’ and the concept of ‘sport’. The word ‘aero’ has an allusive and laudatory meaning and the word ‘sport’ is descriptive in the context of BJ Dickson’s goods – which are sport-related goods - however, the significance of the mark as a whole is ambiguous. In my opinion, neither concept (nor the overall significance that will be attributed to the mark as a whole) is particularly distinctive and I find that the mark has a low degree of distinctive character.

Likelihood of confusion

123. 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 marks may be offset by a greater degree of similarity between the respective goods and vice versa. 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 marks and must instead rely upon the imperfect picture of them he has retained in his mind.

124. There are two types of relevant confusion to consider: direct confusion (where one mark is mistaken for the other) and indirect confusion (where the respective similarities lead the consumer to believe that the respective goods and services come from the same or a related trade source). This distinction was summed up by Mr Iain Purvis Q.C. sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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.”

125. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

First applied for mark

126. Earlier in my decision, I found that some of the parties' goods are identical and that some are similar to various degree. The goods will be selected mainly visually with an above average degree of attention. In terms of marks, I found that they are visually similar to a degree between low and medium. Aurally, they are similar to a medium degree. I found that each mark will be perceived as a whole and that the average consumer is likely to recognise that each mark is made up of an association of the prefix 'aero' with a common noun, namely, 'sport' and 'bike'. Conceptually, the marks are similar to a low degree. The earlier mark is distinctive to a low degree. Since the average consumer will pay an above average degree of attention and the marks will be selected mainly by the eye, the difference between the marks are such that, even where identical goods are involved, there is no likelihood of direct confusion.

There is no likelihood of direct confusion.

127. As to whether there is a likelihood of indirect confusion, I found that the element 'aero' in 'aerobike' does not play an independent distinctive role and that the mark will be understood as referring to a bike with an aerodynamic frame. I think that given the natural meaning that will be attributed to the verbal element 'aerobike' in the context of the contested sign (and the low degree of distinctive character that the earlier mark has), the public is unlikely to regard the prefix AERO in 'aerobike' as an indication of origin and will not assume that the respective goods came from the same (or an economically connected) undertaking. **There is no likelihood of indirect confusion. Consequently, the opposition against the first applied for mark fails.**

Second applied for mark

128. Here I found that the marks are visually similar to a medium degree, that the degree of aural similarity is between medium and high and that the conceptual similarity is low. Again, given that the goods will be selected visually with an above average degree of attention, I find that the average consumer will not directly confuse the two marks. In any event, even if one considers the marks as spoken, the conceptual differences created by the words 'sport' and 'board' are sufficient to counterbalance the higher degree of aural similarity between the marks. **There is no likelihood of direct confusion.**

129. The next question is whether the average consumer, who is familiar with the earlier 'aero sport' mark, in seeing the later 'aeroboard' mark will believe that the goods come from the same source or from an undertaking linked to the provider of the earlier goods. Whilst I consider that the natural meaning of 'aeroboard' is less striking than that of 'aerobike', I have come to the conclusion that the significance that the average consumers will ascribe to it, will still preclude them from perceiving the 'aero' element of 'aeroboard' as denoting trade origin. **There is no likelihood of direct confusion.**

130. **The opposition against the second applied for mark fails.**

Section 5(4)(a)

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

"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.”

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

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

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

133. In the opposition against the second applied for mark, BJ Dickson relies on an additional ground under Section 5(4)(a). This is on the basis of the goodwill attached to signs corresponding to a) its earlier marks and b) the sign AEROLITE. As regard the claim based on use of the sign AEROLITE, none of the evidence filed by BJ Dickson relate to that sign. Consequently, insofar as BJ Dickson’s claim under Section 5(4)(a) is based on use of the sign AEROLITE, I find that it is totally unsubstantiated and must be rejected.

134. Turning to the claim based on the use of signs corresponding to BJ Dickson’s earlier marks, BJ Dickson does not appear to me to be in any better a position than in respect of the Section 5(2)(b) ground. BJ Dickson’s signs cannot be said, on the evidence, to enjoy such a level of goodwill and reputation that the distance between the marks matters less. I recognise that the test for misrepresentation is different to that for likelihood of confusion, namely, that misrepresentation requires “a substantial

number of members of the public are deceived” rather than whether the “average consumer are confused”. However, as recognised by Lewinson L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes.

135. Even accepting that BJ Dickson has a sufficient goodwill in its signs in relation to the relevant goods - which are identical or highly similar to those relied upon under Section 5(2)(b) - at the date of the application, which is the relevant date (there being no use by BVG) for the reasons set out earlier, the application would not cause a substantial number of the BJ Dickson’s customers to be misled into purchasing BVG’s goods, believing that they are provided by BJ Dickson. **The Section 5(4)(a) fails.**

Overall conclusion

136. BVG’s invalidity action 501712 failed and therefore the mark registration no. 2432331 will remain on the register.

137. BVG’s revocation action 501713 was partially successful and, therefore, the mark registration no. 2432331 is revoked under Section 46(1)(b) of the Act in relation to *cycles* with effect from 4 July 2017.

138. BJ Dickson’s oppositions failed and both trade mark applications, no. 3231309 and no. 3162557, will proceed to registration.

Costs

139. In its submissions in lieu BJ Dickson requested costs off the scale in the amount of £20,000. This is based on the fact that their costs have been significantly increased by [BVG]’s conduct of the consolidated actions. In this connection, it argues that:

1. the parties had already been in proceedings for invalidation of a mark that is the same subject of application no. 3231309 (under cancellation no. 501495). BVG then failed to meet the deadline to file a Form TM8 and the mark was removed from the Register. BVG then simply re-applied for the same mark

under a new application, causing BJ Dickson to file an opposition incurring further costs;

2. in revocation action 501713 BVG made a number of errors and made subsequent amendments submitting three separate TM26(N). This caused BJ Dickson significant unnecessary costs and delay;
3. in invalidity action 501712 BVG was requested to particularise its statement of grounds twice. This was because it was difficult to decipher its arguments. Again, this caused BJ Dickson unnecessary costs and delay;
4. the revocation action was filed by BVG on 4 July 2017 after BJ Dickson had filed evidence of use, i.e. on 8 May 2017, in the oppositions. According to BJ Dickson, BVG was using the Tribunal process to frustrate and delay matters.

140. Both parties have been professionally represented throughout the proceedings. Whilst BVG's conduct of the case could have been more efficient, I do not consider that it warrants an increased award of costs in BJ Dickson's favour.

141. BVG has partially succeeded in the revocation action and in the two oppositions. BJ Dickson successfully defended the invalidation against its registration and the revocation claim against most of its goods, but was unsuccessful in both oppositions. Whilst, BVG has been slightly more successful, on balance, I find that BJ Dickson success cancel out BVG's success.

142. As regard to BJ Dickson's arguments at points 1 and 4, the removal from the register of BVG's mark would not have prevented it from re-applying for the same mark (and BJ Dickson would have been entitled to costs in the earlier proceedings) and although BVG brought the revocation claim late, they were entitled to follow that course of action if they believed that the evidence of use filed by BJ Dickson was not sufficient to maintain the registration. As regard to BJ Dickson's arguments at points 2 and 3, if BJ Dickson felt that BVG's pleadings were not sufficiently particularised it should have raised the issue with the Tribunal; as to the alleged costs resulting from

the delay, the Tribunal does not award costs attached to delays and, in any event, BJ Dickson has not explained what unnecessary costs has incurred.

143. I therefore order that each party bear their own costs.

Dated this 11th day of December 2018

Teresa Perks

For the Registrar

The Comptroller – General