O/0020/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003607100
BY BROOKS ENGLAND LIMITED
TO REGISTER THE FOLLOWING TRADE MARK:

IN CLASSES 18 AND 25

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 425519
BY BROOKS SPORTS INC

Background and pleadings

1. On 09 March 2021, BROOKS ENGLAND LIMITED ("the applicant") applied to register the trade mark shown on the cover page of this decision in the UK. The specification for which the mark seeks registration has been subject to various amendments and now stands as follows:[1]

> **Class 18:** *Bags including tool bags of leather, leather shopping bags, leather rucksacks, holdalls, messenger bags, commuter bags, tote bags, saddle bags, shoulder bags, knapsacks, briefcases, satchels, handbags, rucksacks, small rucksacks, bumbags, all for cyclists*.
>
> **Class 25:** *Jackets including cycling jackets, gilets; shorts including cycling shorts, Bib shorts; trousers; jerseys; dungarees; tops; bodysuits; all for cyclists; clothing accessories for cyclists including gloves, socks, shoes, caps.*

2. The application claims a priority date of **09 September 2003** from the European Union Intellectual Property Office ("EUIPO") having been filed pursuant to Article 59 of the Withdrawal Agreement between the UK and the EU.

3. Following publication on 14 May 2021, the application was opposed by Brooks Sports Inc. ("the opponent") under Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act").

4. Initially, the opposition was directed against some of the applied-for goods only, namely those in classes 18 and 25, with the specification being, at the time when the notice of opposition was filed, that shown below:

> **Class 18:** *Bags, handbags, rucksacks, small rucksacks, bumbags, all for cyclists.*

[1] The specification initially covered goods in classes 9, 12, 18, 25 and 28.

Class 25: *Jackets, shorts, trousers, jerseys, dungarees, tops, bodysuits, all for cyclists; clothing accessories for cyclists including gloves, socks, shoes, caps.*

5. The reason why the opposition was initially partial is because when the opponent filed its notice of opposition on 13 July 2021, the application included goods in classes 9, 12 and 28. Those goods were not opposed and have now been deleted from the present application. Further, as can be seen, the goods originally objected are not exactly the same as those for which the application now seeks registration; this is because the specifications in classes 18 and 25 have been subject to two further amendments on 28 March 2022 and 28 February 2023. Consequently, the opposition is now directed against all of the applied-for goods in class 18 and 25 which are those set out at paragraph 1 above.

6. Under Sections 5(2)(b) and 5(3) the opponent relies upon the following three trade marks ("the earlier marks") and the goods covered by the same as shown below:

UK00001500324 BROOKS Filing date: 13 May 1992 Registration date: 27 August 1993 **Class 25:** *Shoes for athletics; all included in Class 25.*
UK00001494051 BROOKS Filing date: 12 March 1992 Registration date: 17 March 1995 **Class 25:** *Shoes for athletes; all included in Class 25; but not including golf shoes.*
UK00900162313 BROOKS Filing date: 01 April 1996 Registration date: 25 January 1999

Seniority details: Application date: 13 May 1992; Country: UK; Application number: 1500324 **Class 25:** *Athletically-related footwear.*

7. The opponent's marks qualify as "earlier trade marks" in accordance with Section 6 of the Act because they were applied for at an earlier date than the priority date of the applied-for mark. Since all of the earlier marks had been registered for five years or more at the priority date of the applied-for mark, they are subject to the use conditions under Section 6A(3) of the Act.

8. Under Section 5(2)(b), the opponent claims that the marks are highly similar and that the goods and services are identical or highly similar, leading to a likelihood of confusion.

9. Under Section 5(3), the opponent claims to have accrued reputation in relation to athletic footwear as a result of decades of use. The only head of damage that is pleaded is that of unfair advantage.

10. Under Section 5(4)(a) the opponent claims to have used the sign 'BROOKS' throughout the UK since January 1980 acquiring goodwill under the sign. The opponent claims that use of the applied-for mark would cause a misrepresentation to consumers which could lead to damage, such that use of the applied-for mark would be contrary to the law of passing-off.

11. The applicant filed a defence and counterstatement in which it denied the claims made and put the opponent to proof of use of the earlier marks in the 5-year period leading up to the priority date of the application. In addition, the applicant claims that it has used the marks 'BROOKS' and 'BROOKS ENGLAND' in relation to bicycle saddles and bicycle accessories including bags for cyclists since as early as 1898, and in relation to clothing since as early as the 1930s and argues that if the opponent has used its marks in the UK in the same time period, the opponent would be expected to provide some evidence of confusion.

12. Both parties filed evidence in chief, with the opponent also filing submissions in reply dated 6 March 2023. A hearing took place before me on 9 October 2024 by video conference, with the applicant represented by Stephanie Wickenden of counsel, instructed by Cleveland Scott York and the opponent represented by Thomas St Quintin of counsel, instructed by Shoosmiths LLP.

EU Law

13. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

The evidence

14. The opponent's evidence consists of a witness statement from Thomas J. Ross, dated 15 August 2022 and accompanied by 11 exhibits. Mr Ross is Vice President, Chief Financial Officer, Secretary, and Controller for the opponent and has worked at the opponent since March 2003. His evidence goes to showing use of the earlier marks.

15. The applicant's evidence consists of two witness statements, one from Stefano Zorzi and another from Leon Bedward, dated 22 November 2022 and 23 November 2022 respectively. Mr Zorzi is the Director of the applicant, a position he has held since 2 September 2022. His witness statement goes to showing use by the applicant of the applied-for mark and is accompanied by 16 exhibits (SZ1-SZ16). Mr Bedward is a Trade Mark Attorney employed by the applicant's representative in these proceedings. His witness statement goes to supporting the claim that athletic footwear and goods for cyclists are different and is accompanied by 6 exhibits (LB1-LB6).

16. I do not intend to summarise the parties' evidence in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

DECISION

PROOF OF USE

17. Section 6A of the Act states:

> "(1) This section applies where
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> (a) an application for registration of a trade mark has been published,
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> (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
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> (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.
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> (1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.
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> (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.
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> (3) The use conditions are met if –
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> (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(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."

18. Section 100 is also relevant, which reads:

"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."

19. The relevant period in which genuine use must be established is the five-year period ending with the priority date of the application for registration: **10 September 1998 to 9 September 2003**. One of the earlier marks is a comparable mark – the plain word 'Brooks' registered for *"Athletically-related footwear".* For that earlier mark proof of use within the EU (including the UK) is relevant for the whole relevant period which

fall entirely before IP Completion Day.[2] The UK is the relevant territory for the other two earlier marks.

20. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

> "105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], 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], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].
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> 106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:
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> (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] See paragraph 7 of Part 1, Schedule 2A of the Act.

(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]; *Ferrari* at [32].

(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]; *Gözze* at [37], [40]; *Ferrari* at [32].

(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]; *Ferrari* at [33].

(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]."

21. With regard to assessing use within the EU (for the purpose of the earlier comparable mark), I also bear in mind that in *Leno Merken BV v Hagelkruis Beheer BV,* Case C-149/11, the CJEU found that while use of a Community trade mark in one member state could suffice to establish genuine use in the Community, *"all facts and circumstances"* should be considered including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.[3]

Genuine use

22. In her skeleton argument, Ms Wickenden conceded for the applicant that use has been proven in respect of *"running shoes".* She stated:

[3] See also *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52 (paragraphs 228-230) and Case T-398/13, TVR Automotive Ltd v OHIM (paragraph 57)

"Accordingly, it is doubtful that the Opponent's evidence is sufficient to establish genuine use in respect of any of the Registered Goods. However, for the purpose of this Opposition, the Applicant is prepared to accept that use has been proven in respect of running shoes", but "running shoes" only."

23. The same concession was reiterated at the hearing with Ms Wickenden stating as follows:

"We accept, given in particular the Runners World adverts and reviews, that there has been market penetration in relation to running shoes but there is certainly no evidence of anything additional. I think that is probably all I can say then in respect of genuine use."

24. The remaining live point at the hearing was what would be a fair specification of goods having regard to the use that the opponent had in fact made of the marks.

25. Mr St Quintin submitted that the correct fair specification is the full range of the registrations that the opponent has, all of which amount to athletic footwear, namely "*Shoes for athletics; all included in Class* 25"; "*Shoes for athletes; all included in Class 25; but not including golf shoes"* and *"Athletically-related footwear".* In support of that specification, Mr St Quintin relied on the decision of the General Court ("GC") in T-63/22 *Brooks England Limited v EUIPO* at paragraph [71] where the court upheld the Board of Appeal's finding that there had been genuine use by the opponent in these proceedings of both the earlier word mark 'BROOKS' and the figurative mark  in the UK in connection with 'athletically-related footwear' in Class 25. The relevant time period in that case was 16 August 1999 to 15 August 2004, which substantially overlaps with the relevant five-year period to prove genuine use of the same earlier marks in these proceedings.[4]

26. Mr St Quintin also relied on invoices and purchase orders showing the sales of a particular model of shoes called Addiction (for men and for women) to dealers in the

[4] Mr St Quintin also relied upon the decision itself which was upheld *Brooks Sports Inc v Brooks England Ltd* R 2432/2020-4 at [54] and [56].

UK for a total of around £44,000[5] and 90 pairs (on various dates between 1999 and 2001 falling within the relevant period).[6] The reason why Mr St Quintin had focused on that evidence was that the Addiction model was described as a walking shoe in some of the exhibits, however, at the hearing it became apparent that the exhibits Mr St Quintin wished to rely upon did not form part of the evidence which had been admitted because they had been removed from the documents initially filed following a Tribunal's request to shorten the evidence. In addition, Mr St Quintin drew my attention to the finding of the GC in *Brooks England Limited* in relation to a fair specification, where it was stated:

> "53. In the present case, it must be borne in mind that the earlier mark has been registered in respect of 'athletically-related footwear' in Class 25 and that the evidence of use of that mark concerns running shoes and racing shoes (see paragraph 46 above). It is therefore necessary to examine whether running and racing shoes constitute a coherent subcategory which is capable of being viewed independently in relation to 'athletically-related footwear' or whether those goods are part of the same group of goods designated by the term 'athletically-related footwear', the division of which into subcategories would be arbitrary.
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> 54. In that regard, according to the definition in the online dictionary Oxford Learners Dictionaries provided by the applicant, the adverb 'athletically' means 'in a way that is connected with sports such as running, jumping and throwing'. It is thus clear from that definition that the term 'athletic' refers to sport in general, given that the specific sports mentioned in that definition are introduced by the words 'such as', thus indicating that that definition is not limited to the sports which are expressly mentioned, as EUIPO correctly submits. It must therefore be concluded that 'athletically-related footwear' corresponds to footwear which is designed for engaging in sport in general. Furthermore, it is common knowledge that running shoes or racing shoes can be used not only for running, which is, moreover, an athletic activity according

[5] TR4
[6] TR5

to the definition provided by the applicant, but also for any other activity, in particular other sports activities, as EUIPO has also correctly pointed out.

55. It follows that running shoes and racing shoes have the same intended use and purpose as 'athletically- related footwear'. Consequently, contrary to what the applicant claims, it cannot be held that running or racing shoes constitute an independent subcategory, for the purposes of the case-law cited in paragraph 49 above, in relation to 'athletically-related footwear', since such a division of the latter category would be arbitrary.

56. In those circumstances and in the light of the case-law referred to in paragraphs 51 and 52 above, the Board of Appeal did not err in finding that use of the earlier mark had to be acknowledged in connection with 'athletically-related footwear' in Class 25, which constitutes a sufficiently narrowly defined category."

27. In line with the above reasonings, Mr St Quintin argued that athletically-related footwear is footwear for multiple purposes and that the particular characteristics that might make a pair of shoes most suitable for running should not be taken into account. Accordingly, he argued that it would be very unusual to find that, contrary to the Board of Appeal and the GC's conclusions, a narrower specification would not be justifiable.

28. Ms Wickenden, for her part, argued that *"running shoes"* would be the appropriate fair specification because running shoes have a different intended purpose and use from other kinds of athletic shoes. She identified the disagreement with Mr St Quintin as being about what constitutes the *"intended use and purpose of the goods"* as opposed to a *"characteristic*". She said that Mr St Quintin's argument that the intended use and purpose is for the shoes to be worn on the feet and cover the body is overly simplistic because there are clearly other purposes for running shoes, including technical performance, stability and protection from injury, which Ms Wickenden submitted are important features to consumers when choosing a pair of shoes. Further, she drew my attention to a review of the model BROOKS ADDICTION 5,[7]

[7] Exhibit 8D

which contains various references to runners, including "*the Addiction series has built up a loyal following among runners"* and "*the Addiction is lighter than some shoes in its category and is a good choice for moderate to severe overpronators and big runners seeking a wide supportive base, durability and cushioning*". Nevertheless, she also conceded that the Addiction shoes can be used for both running and walking, stating as follows (emphasis added):

> *"To the extent that you have any material that refers to an Addiction Walker, that is a different model of shoe; it is not the Addiction range.* ***All Addiction shoes can be used for both running and walking"****.*

29. Lastly, Ms Wickenden relied upon the evidence showing the opponent's history from the website www.brooksrunning.com, pointing out that from 1972 onwards the opponent focused on running shoes and relying in particular on the following statement:

> *"1972 Things change in Munich in 1972*
> *It could be said that Brooks' focus on running shoes actually began in 1972 when Yale graduate Frank Shorter won the Olympic marathon. Running suddenly captivated the world's attention. Instead of making anything - from athletic shoes to combat boots – that would keep the factory turning, Brooks starts to think about limiting its focus."*

30. This, Ms Wickenden said, shows both the focus on running shoes and also the significance of running shoes as a particular subcategory with a particular innovation, purpose and technology aimed specifically at running.

31. In response to the points made by Ms Wickenden, Mr St Quintin referred to the judgment of the CJEU in C-714/18 P, *ACTC v EUIPO,* cited in Ms Wickenden's skeleton argument as an authority for the preposition that the intended use for the goods is an essential criterion for defining an independent subcategory. Mr St Quintin argued that the *ACTC* case is illustrative of what the law is when setting a fair specification and on how to draw the line between the purpose of the goods and the

mere characteristics of the goods, arguing that the way in which the court approached the issue in that case goes to the opponent's advantage.

32. I have read the judgment. In that case the Board of Appeal found that the use of the earlier mark had been proved for certain goods in Class 25, namely *clothing; outer clothing; underwear; headgear for wear and headwear; working overalls; gloves; belts and socks*. Before the GC, the appellant claimed that the evidence filed did not prove genuine use of the earlier mark for 'clothing' as a whole and criticised the Board of Appeal for not having found that there was genuine use for an independent subcategory of goods covered by the earlier mark, which was identified as *special weather protective outdoor clothing*. Both the GC and CJEU upheld the Board of Appeal's findings. In rejecting the appeal, the GC examined whether the evidence filed made it possible to discern an independent subcategory of goods consisting of *special weather-protective outdoor clothing* different from the generic category of clothing in Class 25, but concluded that the articles referred to in the evidence of use have the same purpose as clothing, since they are intended to cover the human body, to conceal, adorn and protect it against the elements and cannot be regarded as in essence different within the meaning of the case-law. It also pointed out that the particular characteristics of the goods shown in evidence are irrelevant since they are not relevant to the definition of a subcategory of goods.

33. I find that the evidence clearly points towards the earlier marks having been used in relation to running shoes, and note that Mr St Quintin did not pursue claimed use in relation to walking shoes (or, indeed, any other type of shoes). The only question really disputed between the parties is whether running shoes represent an independent subcategory of the athletic shoes for which the earlier marks are registered. Ms Wickenden says that I should take into account the different purposes of those goods and the use for which they are intended, i.e. running, and that there is a niche market of running shoes.

34. As regards the purpose of the goods, I note that in her opinion in *ACTC,* Advocate General Sharpston stated:

> “71. A product has purposes which progress and know-how tend to multiply. Cleansing products, for example, are no longer intended only to clean the skin, but also to care for it, whether in a medical sense or not. In the same way, clothing goods fulfil, as well as their primary function, that is, to cover, conceal or protect the human body against adverse weather conditions, a common aesthetic function, by contributing to the consumer’s external image. Although consumers look for clothes to protect themselves against the rain, be that outer clothing or a hat, or to protect themselves against the cold, such as underwear or gloves and socks, they may also look for the most aesthetically pleasing garment. Clearly, each of those purposes cannot be considered in isolation in determining whether there is a distinct sub-category of goods. If that were the case, it would limit once again the rights of the proprietor of the earlier mark to expand and enhance his range of goods. Moreover, it would obviously discourage research and development which trade mark law specifically aims to encourage.
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> 72. In the judgment under appeal, the General Court was therefore right, in my view, not to distinguish between the uses consisting of ‘protecting' the human body, ‘adorning' it, or ‘concealing' it and ‘covering' it, which are intended uses of clothing goods. Far from being mutually exclusive, those different uses are combined for the purpose of putting those goods on the market.”

35. The CJEU agreed with the Advocate General’s opinion, stating at [52] that the GC was right not to take into account each of the uses of the goods at issue — to cover, conceal, adorn or protect the human body — in isolation. The CJEU also agreed with a further point made by the Advocate General in her opinion that the breadth of the categories of goods or services for which the earlier mark was registered is a key element of the assessment. It stated:

> “42. It follows, first, as the Advocate General noted in point 50 of her Opinion, that a consumer who wishes to purchase a product or service in a category that has been defined particularly precisely and narrowly, but within which it is not possible to make any significant sub-divisions, will associate all the goods or services belonging to that category with the earlier mark, such that that trade

mark will fulfil its essential function of guaranteeing the origin of those goods or services. In those circumstances, it is sufficient to require the proprietor of the earlier mark to adduce proof of genuine use of that trade mark in relation to part of the goods or services in that homogeneous category.

43. Second, as the Advocate General noted in point 52 of her Opinion, with regard to goods or services in a broad category of goods, which may be sub-divided into several independent subcategories, it is necessary to require the proprietor of the earlier mark to adduce proof of genuine use of that mark for each of those autonomous subcategories. Indeed, if the proprietor of the earlier mark has registered his trade mark for a wide range of goods or services which he may potentially market, but which he has not done during the period of five years preceding the date of publication of the trade mark application against which it has filed an opposition, his interest in enjoying the protection of the earlier mark for those goods or services cannot prevail over his competitors' interest in registering their trade mark for those goods or services."

36. In other words, if the earlier mark is registered for a homogeneous, precisely and narrowly defined category of goods, proof of genuine use of the mark in relation to part of the registered goods should suffice to establish genuine use for all of the registered goods. Conversely, if the earlier mark has been registered for a broad heterogeneous category of goods, proof of genuine use of the mark in relation to part of the goods should afford protection, in opposition proceedings, only for the subcategory or subcategories to which the goods for which the mark has been used belong. This is because goods in a heterogeneous category in the same class may include subcategories of goods that are 'sufficiently distinct' from those for which the proprietor has been able to prove genuine use as to result, firstly, in a lower risk of confusion on the part of the relevant public, and, secondly, in less justification for protecting the commercial interests of the proprietor of the earlier mark.[8]

[8] Opinion of Advocate General in Case C-714/18 P, paragraph 52

37. Lastly, in a recent decision on an appeal against one of my decisions (*PLANET TURKISH AIRLINES Trade mark*, BL O/1151/24) Dr Brian Whitehead sitting as the Appointed Person stated (emphasis added):

> "The cases of *ACTC* and *Ferrari*, relied upon by the Appellant, advance matters little further. The CJEU said in *ACTC* at §31 (but citing the General Court's decision in the same case at §32):
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> "27. As regards the question whether goods are part of a coherent subcategory which is capable of being viewed independently, it is apparent from the case-law that, since consumers are searching primarily for goods or services which can meet their specific needs, the purpose or intended use of the goods or services in question is vital in directing their choices. Consequently, since consumers do employ the criterion of the purpose or intended use before making any purchase, it is of fundamental importance in the definition of a subcategory of goods or services. In contrast, the nature of the goods at issue and their characteristics are not, as such, relevant to the definition of subcategories of goods or services (see judgment of 18 October 2016, August *Storck v EUIPO — Chiquita Brands (Fruitfuls),* T-367/14, not published, EU:T:2016:615, paragraph 32 and the caselaw cited)."
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> 28. The CJEU further said in *Ferrari* at §§40-42:
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> "40. With regard to the relevant criterion or criteria to apply for the purposes of identifying a coherent subcategory of goods or services capable of being viewed independently, the criterion of the purpose and intended use of the goods or services at issue is the essential criterion for defining an independent subcategory of goods (see, by analogy, judgment of 16 July 2020, *ACTC v EUIPO* (C-714/18 P) EU:C:2020:573 at [44]).
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> 41. It is important therefore to assess in a concrete manner - principally in relation to the goods or services for which the proprietor of a mark has furnished proof of use of his mark - whether those goods or services constitute an independent subcategory in relation to the goods and services falling within the

class of goods or services concerned, so as to link the goods or services for which genuine use of the mark has been proved to the category of goods or services covered by the registration of that trade mark (judgment of 16 July 2020, *ACTC v EUIPO* (C-714/18 P) EU:C:2020:573 at [46]).

42. It follows from the considerations set out in [37]-[41] of this judgment that **the concept of "particular market segment", referred to by the referring court, is not, as such, relevant to the assessment of whether the goods or services in respect of which the proprietor of a trade mark has used it fall within an independent subcategory of the category of goods or services in respect of which that mark was registered.**"

29. However, neither authority provides any further guidance as to how to distinguish between "purpose and intended use of the goods or services" on the one hand, and "the nature of the goods at issue and their characteristics" or "particular market segment" on the other.

30. Overall, I respectfully agree with the following summary of the law as provided by the editors of Kerly at 7-031:

"Restriction of the specification by reference to the exclusion of goods or services which have a "specific characteristic" is not permissible. The precise scope of this principle is difficult to define and has led to apparently conflicting and inconsistent decisions as to whether exclusions are of categories (allowable) or characteristics (not allowable) of goods or services".

38. Finally, I bear in mind the case-law on framing a fair specification. 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."

39. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 the Court of Appeal set out the proper approach to partial revocation, as follows:

"245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.

246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. […] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those

which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered."

40. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch) at [47], the late Carr J pointed out that 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.

41. First, applying what the court said in *Ferrari*, the fact that there is a niche market for running shoes is not relevant to the assessment of whether they constitute an independent subcategory of the registered specifications "*shoes for athletics", "shoes for athletes"* and "*athletically-related footwear"*. Second, applying the approach adopted by the CJEU in *ACTC,* the primary purpose of running shoes is the same as that of the registered "*shoes for athletics", "shoes for athletes"* and "*athletically-related footwear".* As the GC found in *Brooks England Limited*, the dictionary definition of 'athlete' is of *"a person who is very good at sports or physical exercise, especially one who competes in organized events"*. Likewise, Collins online dictionary defines athlete as *"a person who does a sport, especially athletics, or track and field events"* meaning that running shoes are a type of athletic shoes and have the same intended use and purpose. Hence, it would not be correct to hold that use consisting of covering the feet for the purpose of running is sufficiently different in purpose and function from use consisting of covering the feet for the purpose of playing another athletic sport. This is especially so given Ms Wickenden's concession that all Addiction shoes can be used for both running and walking – a fact which proves that running shoes can have multiple purposes - and the fact that running shoes and other athletic shoes are sold in the same shops. Third, the registered specifications "*shoes for athletics", "shoes for athletes"* and "*athletically-related footwear"* cover an homogeneous category of goods which is already narrowly defined. Lastly, what Ms Wickenden referred to as "*the other purposes*" of running shoes, namely technical performance, stability and protection

from injury, are specific qualities, attributes or traits relating to technical aspects of running shoes which would be a characteristic rather than a subcategory.

42. Taking all of the above into account, I agree with Mr St Quintin that 'running shoes' does not constitute an independent subcategory of the registered "*shoes for athletics", "shoes for athletes" and "athletically-related footwear"* and that the use shown in relation to running shoes is sufficient for the opponent to rely on the registered specifications.

Section 5(2)(b) of the Act

43. Section 5(2)(b) states:

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

44. Section 5A states:

> "Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."[9]

[9] This section also applies to the grounds raised under sections 5(3) and 5(4)(a) of the Act.

45. The following principles for determining whether there is a likelihood of confusion under section 5(2)(b) of the Act are taken from the decisions of the Court of Justice of the European Union ("CJEU") in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P.

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive

role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

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

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public 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

46. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union ("CJEU") stated that:

> "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 complementary."

47. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited ("Treat")* [1996] RPC 281. At [296], he identified the following relevant factors:

(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.

48. The General Court ("GC") confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa.

49. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of "complementary" goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

> "[…] 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."

50. The competing goods of the parties are as follows:

The applied-for goods	**The opponent's goods**
Class 18: *Bags including tool bags of leather, leather shopping bags, leather rucksacks, holdalls, messenger bags, commuter bags, tote bags, saddle bags, shoulder bags, knapsacks, briefcases, satchels, handbags, rucksacks, small rucksacks, bumbags, all for cyclists*.	
Class 25: *Jackets including cycling jackets, gilets; shorts including cycling shorts, Bib shorts; trousers; jerseys; dungarees; tops; bodysuits; all for cyclists; clothing accessories for cyclists including gloves, socks, shoes, caps.*	**Class 25:** *Shoes for athletics; all included in Class 25.* **Class 25:** *Shoes for athletes; all included in Class 25; but not including golf shoes.* **Class 25:** *Athletically-related footwear.*

51. Before I turn to the comparison of goods, as a preliminary point, I need to determine whether the limitation *"all for cyclists*" should be taken into account. Mr St Quintin argued that it should be ignored for the following reasons:

(i) Notwithstanding the limitation *"all for cyclists",* the applied-for goods are not limited to goods that are specialist products for cyclists as it was the case, for example, in *Maier v ASOS,* [2015] ETMR 26 where the addition of *"specialist"* to the specification *"Specialist clothing for racing cyclists"* limited the goods in an acceptable way. With the exception of *"saddle bags"* which are the only goods that are inherently for fitment to a saddle, the goods are not even limited to goods that are for use by people while cycling. The limitation is therefore not one that limits the goods to any special characteristics because *"cyclists"* are a

group of people identified only by the fact that they use bicycles and there is no other common feature uniting them. They are a large and varied group which encompass, for example, those who cycle competitively as well as those who cycle short distances in their business suit on a hired bike, and children. In this connection, Mr St Quintin referred, in his oral submissions, to the evidence given by Mr Zorzi (on behalf of the applicant) showing that goods for cyclists are just normal goods, drawing my attention to images from the applicant's marketing material showing cyclists wearing normal clothes and Chelsea boots:[10]

[10] SZ13

between
The 900-mile
s of all ages,

Brooks has launched a new website to collect and share
LeJog and other bicycle travel stories: www.**enjoyeverymile.com**

Our first documentary features Adam and Andrew's End to End trip in support of Operation Smile and other charities. Learn more at www.miles4smiles.com

(ii) Due to the unlimited scope of what *"for cyclists"* means, it is not a qualifier that can identify any inherent characteristic of the goods with sufficient certainty: one cannot say how, for example, *"small rucksacks"* when qualified by the words *"for cyclists"* would differ from any other small rucksacks. The limitation refers to characteristics that may be present or absent without changing the nature, function, or purpose of the relevant goods.

52. In addition, Mr St Quintin submitted that a further point arises from the amendments to the class 18 specification of the application. When originally filed, the class 18 specification was for *"Bags, handbags, rucksacks, small rucksacks, bumbags, all for cyclists"* - the *"all for cyclists"* limitation applying to all the goods of the application. The amended specification now reads *Bags including tool bags of leather, leather shopping bags, leather rucksacks, holdalls, messenger bags, commuter bags, tote bags, saddle bags, shoulder bags, knapsacks, briefcases, satchels, handbags, rucksacks, small rucksacks, bumbags, all for cyclists.*" The current wording could be read in a way that extends it to all bags, with the "*all for cyclists"* limitation applying only to the particular examples set out after the word *"including*". Mr St Quintin submitted that if, contrary to the opponent's case, that limitation has any relevance, it should be treated as reading "*Bags, all for cyclists, including…".*

53. Ms Wickenden stated that (a) the limitation "*all for cyclists*" was included in the specification initially filed, namely *Bags, handbags, rucksacks, small rucksacks, bumbags, all for cyclists*, (b) that the specification has been accepted into the Register

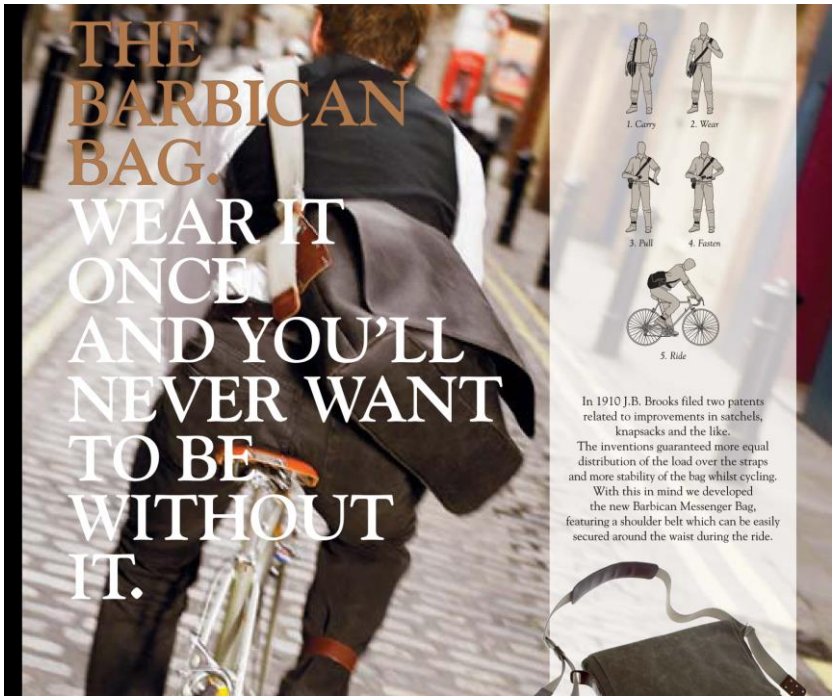
and that (c) the opponent acknowledged in its notice of opposition that the applied-for goods are aimed at cyclists, all of these points making Mr St Quintin's argument late and unfair, which would prevent him from arguing the point now. In addition, Ms Wickenden argued that if I am with Mr St Quintin on the limitation being meaningless, it would only be fair to allow the applicant to amend the specification to read *"whilst cycling"* or "*specialist cycling"* and that the logical construction is effectively that *"all for cyclists"* means goods to be used for cycling. Lastly, Ms Wickenden referred to the points made at paragraph 42 of her skeleton argument where she stated:

> "40. If the Opposed Goods in Class 18, are compared with "running shoes" there is no similarity: bags addressed specifically to cyclists will not be seen to coordinate with, complement or compete with goods addressed to runners.
>
> 41. If the Opposed Goods in Class 18 are compared to the Registered Goods, they remain dissimilar. For the reasons given at §24.2 above, the average consumer is not likely to consider that bags designed for cyclists will coordinate with or complement shoes designed for "athletics".
>
> 42. Either way, the Registered Goods are different in nature and purpose, and addressed to different users. Not all "cyclists" are engaged in cycling for sport. Many of them commute, or otherwise use cycles for transport. In such a context there is no overlap with "athlete" consumers. If there is similarity of goods then it is only a very low degree of similarity, and no similarity for the types of bags clearly aimed at "non-sporting" cyclists: "tool bags of leather, leather shopping bags, leather rucksacks, holdalls, messenger bags, commuter bags, tote bags, knapsacks, briefcases, satchels, handbags."

54. Having conceded in her skeleton argument that there are different kinds of cyclists, Ms Wickenden confirmed at the hearing that there is nothing in the evidence to suggest that only sport-related cyclists should be taken into account, and that the fact that a cyclist might be someone who commutes does not mean that they do not need goods designed for cycling. She then concluded that the types of bags that are clearly aimed at non-athletic, non-running, non-sporty cyclists are too far away from running shoes or athletic shoes, to give rise to any similarity and any likelihood of confusion.

55. The first conclusion I draw is that since the originally filed specification was for *Bags, handbags, rucksacks, small rucksacks, bumbags, all for cyclists*, with the limitation applying to all of the goods listed (including bags), the new amended specification cannot expand the scope of the term *bags* by applying the limitation only to the various types of bags listed after the word *bags* (i.e. *tool bags of leather, leather shopping bags, leather rucksacks, holdalls, messenger bags, commuter bags, tote bags, saddle bags, shoulder bags, knapsacks, briefcases, satchels, handbags, rucksacks, small rucksacks, bumbags*). Consequently, I agree with Mr St Quintin that the amended specification should be treated as reading "*Bags, all for cyclists, including…".*

56. My next consideration is that it is clear from the parties' submissions that the limitation "*all for cyclists"* was intended by the applicant to encompass non-athletic, non-sporty (including non-running) cyclists. This is borne out by the evidence of the applicant's marketing material and explains why, as Mr St Quintin correctly pointed out, with the exception of saddle bags, the applied-for goods in classes 18 and 25 are not limited to goods that are specialist products for racing or road cyclists. As Ms Wickenden suggested, a more accurate limitation would be *"whilst cycling*" to indicate that the goods can be used whilst cycling as shown by the example below which shows a messenger bag promoted by the applicant as a bag to be worn whilst cycling:



57. However, the problem with the *"whilst cycling*" intention is that whilst the applicant's goods might target those who ride a bike, without being racing or road cyclists (i.e. using Ms Wickenden's terminology, those who are non-athletic, non-running, non-sporty cyclists) that does not make the goods specialist goods for cyclists in a way that is sufficiently clear to avoid uncertainty as to the nature of the goods concerned. The fact that the specification was accepted does not mean that it is sufficiently clear and precise, and meets the requirements set out in the case law.[11] Further, whilst the limitation was accepted, when it was put forward to the UKIPO it was not apparent that the applicant intended to refer to non-athletic, non-running, non-sporty cyclists (though, I think, the fact that some the goods listed, such as handbags, are evidently not specialist goods for cyclists could have potentially flagged the issue), the absence of such information contributing to the examiner not spotting that the restriction was intended to describe the intended recipients of the goods rather than a subcategory.

58. In *Omega SA (Omega AG) (Omega Ltd) v Omega Engineering Incorporated* [2012] EWHC 3440 (Ch), Arnold J. (as he then was) provided the following guidance on the application of the *POSTKANTOOR* principle.

> "43. *The POSTKANTOOR principle.* In *POSTKANTOOR* the applicant applied to register the word POSTKANTOOR (Dutch for POST OFFICE) in respect of goods and services in Classes 16, 35–39, 41 and 42. The Benelux Trade Mark Office refused registration on the grounds that the sign was descriptive. On appeal, the *Gerechtshof te s'-Gravenhage* (District Court of The Hague) referred nine questions of interpretation of the Directive to the Court of Justice, of which the eighth was as follows:
>
> > "Is it consistent with the scheme of the Directive and the Paris Convention for a sign to be registered for specific goods or services subject to the limitation that the registration applies only to those goods and services in so far as they do not possess a specific quality or specific qualities (for example, registration of the sign 'Postkantoor' for the

[11] Tribunal Practice Notice 1/2024: Restricting specifications of applications and registrations subject to Tribunal proceedings

services of direct-mail campaigns and the issue of postage stamps, provided they are not connected with a post office')?"

44. The Court of Justice answered this question as follows:

> "113. … when registration of a mark is sought in respect of an entire class within the Nice Agreement, the competent authority may, pursuant to Article 13 of the Directive, register the mark only in respect of some of the goods or services belonging to that class, if, for example, the mark is devoid of any distinctive character in relation to other goods or services mentioned in the application.
>
> 114. By contrast, where registration is applied for in respect of particular goods or services, it cannot be permitted that the competent authority registers the mark only in so far as the goods or services concerned do not possess a particular characteristic.
>
> 115. Such a practice would lead to legal uncertainty as to the extent of the protection afforded by the mark. Third parties — particularly competitors — would not, as a general rule, be aware that for given goods or services the protection conferred by the mark did not extend to those products or services having a particular characteristic, and they might thus be led to refrain from using the signs or indications of which the mark consists and which are descriptive of that characteristic for the purpose of describing their own goods."

45. The guidance given by the Court of Justice must be seen in the context of the question to which it was addressed, namely whether it was acceptable to restrict the goods or services by reference to the absence of "a specific quality". What the District Court of The Hague meant by this can be seen from the example it gave, viz. "the services of direct mail campaigns and the issue of postage stamps provided that they are not connected with a post office". When the Court of Justice referred in its answer to "a particular characteristic", it must have meant the same thing as the District Court meant by "a specific quality".

46. The application of this guidance has caused some difficulty in subsequent cases. In *Croom's Trade Mark Application [2005] R.P.C. 2* at [28]–[29] Geoffrey Hobbs QC sitting as the Appointed Person held that the *POSTKANTOOR* principle precluded the applicant from limiting a specification of goods in Classes 18 and 25 by adding the words "none being items of haute couture" or "not including items of haute couture". He went on at [30] to refer to "characteristics that may be present or absent without changing the nature, function or purpose of the specified goods". Mr Hobbs QC made the same distinction in *WISI Trade Mark [2007] E.T.M.R. 5; [2006] R.P.C. 22* at [16].

47. In *Oska's Ltd's Trade Mark Application [2005] R.P.C. 20* at [56] I observed *en passant* when sitting as the Appointed Person that I did not consider that it would be permissible to limit the specification by reference to the applicant's intended target market.

48. In *MERLIN Trade Mark (BL O/043/05) [1997] R.P.C. 871* at [27]–[28] I held when sitting as the Appointed Person held that the disclaimer "but not including the provision of venture capital" was acceptable, because it was not framed by reference to the absence of particular characteristics of the services, but rather it was a restriction on the scope of the services embraced by the specification. Accordingly, "the effect of [the disclaimer] is simply to excise a particular service from the specification. The mere fact that it is more convenient to express it in negative than positive terms does not make it objectionable."

49. I also allowed a second disclaimer "and not including the provision of any such services to the pharmaceutical biotechnological [or] bioscientific sectors" for reasons which I expressed at [29] as follows:

> "The position with regard to the second disclaimer is more debatable, but in my judgment the disclaimer does not relate to a characteristic of the services. I consider that there is a distinction between goods and services here. An article of clothing is an article of clothing regardless of whether it is of a particular style or quality and regardless of the identity and proclivities of the intended purchaser. By contrast, services can be

defined in part by the recipient of the service. The opponent's registration is an example of this, since both the Class 35 and the Class 36 specification are limited to services provided to the pharmaceutical biotechnological and bioscientific sectors. In my view *POSTKANTOOR* does not make it impermissible to define services in this way. That being so, I consider that it makes no difference if the definition is expressed negatively rather than positively."

50. In *Patak (Spices) Ltd's Community Trade Mark Application (R746/2005-4) [2007] E.T.M.R. 3* at [28] the Fourth Board of Appeal at OHIM refused to allow a proposed limitation *"none of the aforesaid being dart games or darts"* to a class 28 specification as offending the *POSTKANTOOR* principle. I find this decision difficult to follow, since the exclusion related to categories of goods, rather than the characteristics of goods. It appears that the objection may have been down to the fact that the exclusion was negatively worded, but as I explained in *MERLIN [1997] R.P.C. 871* that is a matter of form, not substance, and so should not have been determinative."

And

"56. Against this background, counsel for Swiss submitted that the limitation "intended for a scientific or industrial application in measuring, signalling, checking, displaying or recording heat or temperature (including such having provision to record heat or temperature over a period of time and/or to display the time of day)" contravened the *POSTKANTOOR* principle because it purported to restrict the specification of goods by reference to whether the goods possessed particular characteristics.

57. I do not accept that submission for the following reasons. First, if and insofar as the *POSTKANTOOR* principle depends on the limitation being expressed in negative terms, the limitation in the present case is expressed in positive terms. Secondly, and more importantly, I do not consider that the limitation refers to whether the goods possess particular characteristics in the sense in which the Court of Justice used that term in *POSTKANTOOR*. Rather, the limitation refers

to the functions of the goods. To revert to the analogy discussed above, it is comparable to a limitation of "clocks" to "clocks incorporating radios". Accordingly, in my judgment it falls on the right side of the line drawn by Mr Hobbs QC in *Croom's Trade Mark Application [2005] R.P.C. 2* and *WISI Trade Mark [2007] E.T.M.R. 5; [2006] R.P.C. 22*."

59. I find that the way in which the limitation has been clarified by Ms Wickenden means that the goods listed in the specification can be said to be "*for cyclists*" only because of the way in which the applicant intends to market them, the limitation referring, effectively, to the applicant's intended target market. This is not a sub-category of goods. Further, for goods, restrictions describing the intended recipient (i.e. in this case, those who ride a bike) are unlikely to be acceptable.[12] Using the example given by Mr St Quintin, a rucksack is a rucksack regardless of whether it is worn whilst walking or cycling and regardless of the inclinations of the intended purchaser, i.e. whether he travels by bike or other means of transport. Lastly, with the exception of *saddle bags*, an ordinary consumer would not describe *tool bags of leather, leather shopping bags, leather rucksacks, holdalls, messenger bags, commuter bags, tote bags, shoulder bags, knapsacks, briefcases, satchels, handbags, rucksacks, small rucksacks, bumbags* as being bags *"for cyclists".* Hence, I will disregard the limitation.

Class 18: Bags including tool bags of leather, leather shopping bags, leather rucksacks, holdalls, messenger bags, commuter bags, tote bags, saddle bags, shoulder bags, knapsacks, briefcases, satchels, handbags, rucksacks, small rucksacks, bumbags.

60. The word "*including"* means that the terms listed after it are only examples of bags covered by the specification. Collins online dictionary defines including as follows: *"You use including to introduce examples of people or things that are part of the group of people or things that you are talking about."* Hence, the specification should not be interpreted as only covering the named goods, but as covering all sorts of bags, including those specifically listed.

[12] TPN 1/2024

61. On that basis, I find that the term *“bags”* - not being limited to the goods that follows the word “including” - covers any type of bags, including athletic or sports bags. I bear in mind too that according to Section 60A of the Act, goods are not regarded as being similar to or dissimilar from each other on the ground that they appear in the same or different classes under the Nice Classification.

62. The opponent’s goods are all athletic shoes in class 25. The contested bags are bags at large; as well as including the different sorts of bags listed after the word *“including”*, the term *“bags”* covers athletic or sports bags in Class 18 (based on my approach that the limitation *“all for cyclists”* should be disregarded). The respective goods are sufficiently related to be regarded as similar in a trade mark sense because although their nature, purpose and method of use are different, it is not unusual for sports (or athletic) footwear manufacturers to directly produce and market sports (or athletic) bags. Moreover, the goods are used at the same time[13] and might be sold side by side in specialised sport outlets where the general public would often perceive there to be a connection. Therefore, **I consider these goods to be similar to a low degree**.[14]

63. For the sake of completeness, I should mention that I have not overlooked Ms Wickenden’s submissions (see paragraph 53 above) that the average consumer is not likely to consider that bags designed for cyclists will coordinate with or complement shoes designed for *"athletics",* that the goods are different because not all *"cyclists"* are engaged in cycling for sport, and there is no similarity for the types of bags clearly aimed at *"non-sporting"* cyclists such as “*tool bags of leather, leather shopping bags, leather rucksacks, holdalls, messenger bags, commuter bags, tote bags, knapsacks, briefcases, satchels, handbags."*

64. Ms Wickenden also argued that shoes for cyclists are not contained within the broader category of *"shoes for athletes*" relying on the evidence that the Cycling Vitality magazine states that *"Athletic shoes are okay for the gym and other athletic activities, except cycling".*[15]

[13] See *Athleta (ITM) Inc. v Sports Group Denmark A/S and another (2024)* at paragraph 123 where the judge took into account, inter alia, that bags and clothing are used at the same time and are similar.
[14] *Giordano Enterprises Ltd v EUIPO,* Case T-483/08 at paragraph 22-29
[15] Exhibit LB4

65. Unfortunately for the applicant, whichever way the matter is looked at, it does not overcome the difficulty with how the specification has been framed. Firstly, some of the goods specified as being for cyclists are not, by nature, really goods for road/racing cyclists (e.g. handbags, tool bags, shopping bags, briefcases). Indeed, it is not entirely clear to me what bags specifically for road or racing cyclists would be. However, even if the term *"for cyclists"* were interpreted as referring only to road / racing cyclists and were an effective limitation of some of the specified goods, there would still be similarity between bags specifically for road or racing cyclists and athletic shoes, which term I find includes shoes specifically for road or racing cyclists. In this connection, contrary to Ms Wickenden's submission, in *Brooks England Ltd*, the GC upheld the Board of Appeal's finding that *"athletically-related footwear' may be used to engage in all kinds of sports activities and includes sports shoes in general, including shoes for cyclists".* Whilst I note Mr Bedward's evidence that the Olympics official website features athletics and cycling in different categories and defines athletics as including *a "wide range of running, throwing and walking in track and field events"* (but not cycling), I do not think that the same dividing line can be applied rigidly to the description of goods for the purpose of trade mark registrations. I am fortified in this conclusion by the fact that the EUIPO classification tool contains translations of the term "*Athletic footwear"* which means *"sports shoes*" in English, including *Scarpe per lo sport* in Italian, *Zapatillas deportivas* in Spanish and *Chaussures de sport* in French.

66. Conversely, if the limitation *"for cyclists*" is considered and interpreted as meaning for *"non-sporting"* cyclists, then it effectively means *"casual",* whilst the opponent's athletic footwear would also cover trainers which are soft sports shoes suitable for walking and casual wear. In those circumstances, I would still find the opponent's athletic shoes and the applied-for bags to be similar to a low degree based on the same origin, use and trade channels (as both set of goods could be produced by the same manufacturers, distributed through the same trade channels and used at the same time) and on the goods being aesthetic complementarity.

Jackets including cycling jackets, gilets; shorts including cycling shorts, Bib shorts; trousers; jerseys; dungarees; tops; bodysuits; all for cyclists; clothing accessories for cyclists including gloves, socks, shoes, caps.

67. In her skeleton argument, Ms Wickenden conceded that that there is a low to medium level of similarity between the applied-for goods in Class 25 and the opponent's goods in the same class. I will proceed on that basis, with the exception of *clothing accessories for cyclists including shoes,* which are identical.

Average consumer

68. As the case law above indicates, it is necessary for me to determine who the average consumer is for the parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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. (as he then was) 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."

69. The average consumer of the parties' goods in classes 18 and 25 is the public at large.

70. The cost of purchase is likely to vary, and the goods will be purchased periodically, as shoes wear out or the need for a bag arises. Factors taken into consideration during the purchasing process include the suitability of the goods for the consumer's purpose, materials used, cut, aesthetic appearance and durability. Consequently, I consider that a medium degree of attention will be paid by the average consumer when selecting the goods.

71. The goods are likely to be obtained by self-selection from the shelves of a retail outlet, online or catalogue equivalent. This means that the mark will be seen and so

the visual element of the mark will be the most significant. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there will also be an aural component to the purchase, as advice may be sought from a sales assistant or representative.

Comparison of marks

72. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The 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."

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

The application	The opponent's marks
BROOKS ENGLAND	BROOKS
	BROOKS

74. Before I turn to the overall impression and the comparison of the marks, it is relevant to see what the parties' submissions are on those matters.

75. Ms Wickenden, on behalf of the applicant, admitted that there is a low degree of similarity between the marks owing to the common word element "BROOKS". However, she argued that visually, the eye is drawn to the figurative interlocking 'OO' at the centre of the applied-for mark, that the verbal element 'ENGLAND' in the application has no counterpart in the opponent's mark and that the level of similarity between the application and the earlier figurative mark is even lower, owing to the presence of the device at the beginning of the mark.

76. Mr St Quintin, on behalf of the opponent, argued that that the competing marks are similar to the highest possible level without being identical because they share the identical word 'BROOKS' whilst the word 'ENGLAND' in the application is descriptive and will be understood as indicating that the goods are made in England. He also argued that the minimal stylisation of the two letters "OO" in the application is banal and that normal and fair use of the earlier word mark includes its presentation in any font and, in particular, in a font identical to that of the applied-for mark.

Overall impression

77. The applicant's mark consists of the word BROOKS written in capital letters in a slightly stylised typeface. Although the letters OO are overlapping, it does not prevent the word from being read as BROOKS and Ms Wickenden conceded that the respective marks share the common word element BROOKS. Underneath the word BROOKS is the word ENGLAND presented in capital letters, but in a significantly smaller size. Given its geographical connotation, I agree with Mr St Quintin, that the

word ENGLAND will have very little or no distinctiveness and will be perceived as describing the origin of the goods resulting in the word BROOKS being the dominant and most distinctive element of the mark.

78. The earlier word mark consists of the word BROOKS. This comprises the whole of the mark and it is within this element that the overall impression of the mark resides.

79. The earlier figurative mark consists of the word BROOKS presented in capital letters in a slightly stylised typeface with a swish device placed at the beginning of the word. Whilst the swish device is not negligible, it will be perceived as ornamental and will play a lesser role in the overall impression which is dominated by the word BROOKS.

The application and the earlier word mark

80. For the purposes of visual, aural and conceptual comparison, the first verbal element of the application is recognisable as the word BROOKS. Consequently, although the two overlapping OO have a visual impact, they do not neutralise the high level of visual similarity between the marks. The same goes for the word 'ENGLAND' and the slight stylisation of the letters in the application, which must be taken into account.[16] Aurally, most average consumers are unlikely to articulate the word ENGLAND as they will not attribute any trade mark significance to it, resulting in the competing marks being aurally identical. Conceptually, Mr St Quintin argued that the word BROOKS is the plural version of the word "brook", which is defined as small stream. However, Brooks is also an English surname - as shown by Mr Zorzi's evidence that the founder of the applicant was John Boultbee Brooks - which I think is how most consumers would perceive it, in the absence of any reference in the marks to the meaning of brook as a stream. Hence, whatever concept the marks convey, i.e. that of a surname or small streams, it will be the same in both marks.

[16] BL O/1206/24 at paragraph 28

The application and the earlier figurative mark

81. Whilst the presence of the device might reduce the visual similarity between the marks, it remains high, and does not impact the aural and conceptual identity between the marks.

Distinctive character of earlier mark

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

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee* 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)."

83. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as

invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

84. I have found that the word BROOKS in the earlier marks is likely to be perceived by the average consumer either as the plural of a word meaning a small stream or as a surname. Either way it has no meaning in relation to the goods concerned. Further, I have no evidence of Brooks being a very common surname in the UK. Consequently, I consider the earlier marks to be inherently distinctive to a medium degree.

85. At the hearing Mr St Quintin relied on the opponent's evidence of use claiming that the use made of the earlier marks has enhanced their distinctiveness. Ms Wickenden did not really comment on the claim but maintained that whilst the applicant conceded genuine use for running shoes, the higher threshold for reputation and goodwill has not been met.

86. I will therefore assess the evidence of use to see if it supports the opponent's claim to enhanced distinctiveness bearing in mind that the relevant date is 09 September 2003, and that the relevant territory for assessing enhanced distinctiveness is the UK.

87. Mr Ross provides a background history of the opponent, explaining that it is a large US company and an international supplier of footwear and sport apparel and accessories. Having been established in 1914, the opponent has always made footwear, but from 2001 onwards the focus has shifted towards athletic footwear, apparel and accessories with the opponent becoming a leading specialist in athletically related shoes in the UK, Europe and globally. Before introducing his evidence, Mr Ross gives a warning that due to the length of time between now and the relevant time period, it has been difficult to recover all material relating to invoices and marketing records. Nevertheless, from the evidence that is relied upon to show that Brooks was a well-recognised brand in athletic shoes at the relevant date, I note the following:

- Copies of webpages from the opponent's website at www.brooksrunning.com (undated, safe for the printing date of 2 August 2022), show that the Adrenaline GTS4 shoe, which was launched in 2002, won the award *"Runner World's Best Update"* and "*Running Network Best Renovation Gold Medal*" and became

Brooks' bestselling shoes.[17] However, it is not clear how successful this model of shoes was in the UK;

- Whilst copies of two Brooks catalogues for 1998 are exhibited,[18] there is no indication of how many catalogues were distributed in the UK. Nevertheless, the catalogues indicate that the products sold are running shoes and that the opponent's UK distributor was a company called International Sport Ltd.

- Mr Ross produces copy of a distribution and license agreement between the opponent and a UK company called L&B Sports Ltd dated 8 December 1999 for the sale of*, inter alia*, athletic shoes bearing the earlier marks in the UK and Ireland for the period 31 July 1999 to 31 December 2004.[19] Whilst the agreement is signed, it is not evidence of goods being sold;

- Mr Ross produces 18 invoices[20] showing sales of BROOKS-branded athletic shoes from L&B Sports Ltd to UK retailers in the period between 19 October 1999 and 28 August 2003. All invoices are addressed to retailers in different parts of the UK. Although the mark BROOKS does not appear in the product description, some of the models indicated in the invoices match those shown on the opponent's website, such as for example, Beast (launched in 1992), Adrenaline (launched in 1999) and Addiction (launched in 2002);

- L&B Sports Ltd's turnover from the sales of Brooks footwear to UK retailers was as follows:[21] £35,126 1999, £462,393 (2000), £599,557 (2001), £847,393 (2002), £1.360,408 (2003) for a total of over £3.3 million. Most of the turnover derives from sale of footwear with a small percentage (totalling £115.558 for the whole period) deriving from the sale of apparel;

- A collection of reviews of "Brooks" footwear[22] is exhibited. The reviews are dated prior to the relevant date including from the UK edition of the specialist

[17] Exhibit 1
[18] Exhibit 2
[19] Exhibit 3
[20] Exhibit 5
[21] Exhibit 6
[22] Exhibit 8

runner's magazine "Runner's World". As Mr St Quintin pointed out, those reviews describe certain "Brooks" trainers as, for example, "*enduring favourites", "a key player"*, having "*a loyal following among runners*", "*… trainers that Brooks is renowned for",* and "*one of the best shoes in the highly competitive stability market".*

- Mr Ross provides evidence of other distribution agreements with European-based distributors, however, they are not pertinent for the purpose of establishing enhanced distinctiveness (or goodwill and reputation) in the UK.

88. The factors which are relevant to the assessment of enhanced distinctiveness are the same as those against which reputation is measured, namely 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 class of persons who, because of the mark, identify goods as originating from a particular undertaking and statements from chambers of commerce and industry or other trade and professional associations. Although Mr Ross' evidence fails to address many of the factors listed above, the reviews nevertheless demonstrate that the trade mark Brooks was, at the relevant date, a significant brand in the niche market for running shoes. On that basis, I am satisfied that, at the relevant date, the earlier marks had become more distinctive that they inherently were to a significant proportion of runners in the UK, who are the relevant public. However, given the absence of information about, among others, market share and marketing investment, there is not enough material to conclude that the increase in distinctiveness resulted in the earlier mark becoming highly distinctive. In my view, the most that can be said is that the distinctiveness of the marks was enhanced to a level which was above medium but lower than high, and any enhancement to the distinctiveness is in respect only of running shoes.

Likelihood of confusion

89. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind, including that 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 keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. I must be alive to 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 that they have retained in their mind.

90. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark,* BL O/375/10, where Iain Purvis Q.C. (as he then was) as the Appointed Person explained that:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: *"The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark"*.
>
> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:
>
> > (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).

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

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

91. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ approved Mr Purvis’s formulation but added:

> “13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] ‘a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion’. Mr Mellor went on to say that, if there is no likelihood of direct confusion, ‘one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion’. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.”

92. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17. This is mere association not indirect confusion.

93. Earlier in this decision I found that:

- The goods are similar to various degree ranging from identical to similar to a low degree.
- The goods will be purchased visually with a medium degree of attention.
- The applied-for mark and the earlier word mark are visually similar to a very high degree and are aurally and conceptually identical. The applied-for mark and the earlier figurative mark are visually similar to a high degree and aurally and conceptually identical.

- The earlier marks are inherently distinctive to a medium degree, but their distinctiveness has been enhanced to above medium in relation to running shoes.

94. Ms Wickenden's primary position for the applicant was that the similarity between the marks and the goods is low and insufficient to establish a likelihood of confusion. In addition, she claimed that the absence of confusion is supported by the lack of actual confusion, notwithstanding the parties having coexisted in the marketplace for decades. Alternatively, Ms Wickenden relied on honest concurrent use.

95. Mr St Quintin for the opponent stated that the issues of lack of actual confusion and alleged honest concurrent use were not pleaded and I should disregard them. Alternatively, Mr St Quintin argued that most of the evidence filed by Mr Zorzi for the applicant is either dated after the relevant date or concerns different goods from those at issue in these proceedings, such as bicycle saddles. As regards the pleading point, admittedly, the applicant did not refer to honest concurrent use although it referred to having used the applied-for mark in the UK and to the absence of confusion. However, if I agree with Mr St Quintin's more substantial point that Mr Zorzi's evidence does not show use of the applied-for mark in relation to any of the applied-for goods in classes 18 and 25 prior to the relevant date, the pleading point becomes redundant.

96. Before I turn to Mr Zorzi's evidence, I bear in mind the following guidance of honest concurrent use. In *Aceites del Sur-Coosur SA v OHIM*, Case C-498/07 P, the CJEU found that:

> "82. First, although the possibility cannot be ruled out that the coexistence of two marks on a particular market might, together with other elements, contribute to diminishing the likelihood of confusion between those marks on the part of the relevant public, certain conditions must be met. Thus, as the Advocate General suggests at points 28 and 29 of his Opinion, the absence of a likelihood of confusion may, in particular, be inferred from the 'peaceful' nature of the coexistence of the marks at issue on the market concerned.

83. It is apparent from the file, however, that in this case the coexistence of the La Española and Carbonell marks has by no means been 'peaceful' and the matter of the similarity of those marks has been at issue between the two undertakings concerned before the national courts for a number of years."

97. In *Budejovicky Budvar NP v Anheuser-Busch Inc*, Case C-482/09, the CJEU held that:

"74. In that context, it follows from the foregoing that Article 4(1)(a) of Directive 89/104 must be interpreted as meaning that a later registered trade mark is liable to be declared invalid where it is identical with an earlier trade mark, where the goods for which the trade mark was registered are identical with those for which the earlier trade mark is protected and where the use of the later trade mark has or is liable to have an adverse effect on the essential function of the trade mark which is to guarantee to consumers the origin of the goods.

75. In the present case, it is to be noted that the use by Budvar of the Budweiser trade mark in the United Kingdom neither has nor is liable to have an adverse effect on the essential function of the Budweiser trade mark owned by Anheuser-Busch.

76. In that regard, it should be stressed that the circumstances which gave rise to the dispute in the main proceedings are exceptional.

77. First, the referring court states that Anheuser-Busch and Budvar have each been marketing their beers in the United Kingdom under the word sign 'Budweiser' or under a trade mark including that sign for almost 30 years prior to the registration of the marks concerned.

78. Second, Anheuser-Busch and Budvar were authorised to register jointly and concurrently their Budweiser trade marks following a judgment delivered by the Court of Appeal (England & Wales) (Civil Division) in February 2000.

79. Third, the order for reference also states that, while Anheuser-Busch submitted an application for registration of the word ‘Budweiser’ as a trade mark in the United Kingdom earlier than Budvar, both of those companies have from the beginning used their Budweiser trade marks in good faith.

80. Fourth, as was stated in paragraph 10 of this judgment, the referring court found that, although the names are identical, United Kingdom consumers are well aware of the difference between the beers of Budvar and those of Anheuser-Busch, since their tastes, prices and get-ups have always been different.

81. Fifth, it follows from the coexistence of those two trade marks on the United Kingdom market that, even though the trade marks were identical, the beers of Anheuser-Busch and Budvar were clearly identifiable as being produced by different companies.

82. Consequently, as correctly stated by the Commission in its written observations, Article 4(1)(a) of Directive 89/104 must be interpreted as meaning that, in circumstances such as those of the main proceedings, a long period of honest concurrent use of two identical trade marks designating identical products neither has nor is liable to have an adverse effect on the essential function of the trade mark which is to guarantee to consumers the origin of the goods or services.”

See also: *Budejovicky Budvar NP v Anheuser-Busch Inc*, [2012] EWCA Civ 880.

98. In *Match Group, LLC & Ors v Muzmatch Ltd & Anor* [2023] EWCA Civ 454 at [115] to [117], Arnold LJ held that honest concurrent use is not a separate defence in a trade mark case, but a factor which can be taken into account in deciding whether use of the later mark will affect the functions of the earlier mark. A use which was initially infringing could eventually cease to be infringing if the trade mark proprietor took no action, there was substantial parallel trade for a long period, and as a result the trade marks came to be understood by the relevant class of consumers as denoting the goods/services of more than one trader. In that scenario there would no longer be a likelihood of confusion.

99. Arnold LJ said that once the claimant has established a *prima facie* case of infringement, the burden shifts to the defendant to establish that, by virtue of its honest concurrent use, there is no longer an adverse effect on any of the functions of the earlier trade mark.

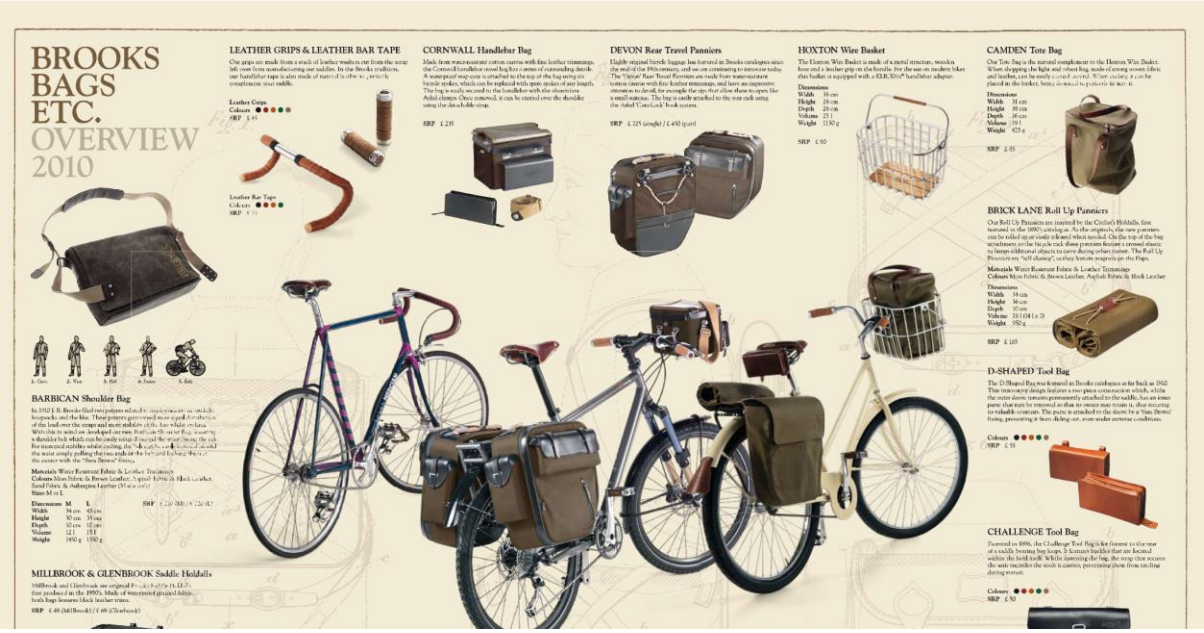
100. The *Budweiser* case shows that honest concurrent use may also be relevant in trade mark opposition and cancellation proceedings. Consequently, the above guidance also applies to proceedings of this kind.

101. For honest concurrent use to be relevant it must relate to the applied-for goods. Whilst the evidence establishes that the applicant has made use of the name BROOKS in the UK, as Mr St Quintin entirely correctly pointed out, the use shown prior to the relevant date relates exclusively to the sale of 115 bicycle saddles,[23] and the evidence indicates that the earliest the bags were going to be produced was 2004, which is after the relevant date. In this connection, the evidence is that having started manufacturing saddles and harness for horses in 1866, by 1950 the applicant had grown to become the world's largest saddle manufacturer and still retains its position as the world's leading leather saddle manufacturer nowadays.[24]

102. Although Mr Zorzi says that the applied-for mark had been used on bags since 1890, on clothing since 1914 and on cycling shoes since 1933, as Mr St Quintin pointed out, there is no evidence about the volume of trade (if any) in such goods. Webpages from the applicant's websites at www.brooksengland.com (undated save for the printing date of 18 November 2022, which is after the relevant date) show bags for sale being marketed as a vintage comeback of Brooks' most interesting designs produced between the end of the 1800s and the 1950s. The same evidence also indicates that the Brooks Range expanded until 1960s when "*the amount of products was much larger than nowadays*"; it also suggests that, at some point after the 1960s, the production of bags was discontinued and was started again in 2004.[25] This is corroborated by the following (a) Mr Zorzi's description of exhibit SZ4 as a *"selection of bags taken from Brooks Book catalogues between 2004 and 2018";* (b) an extract

[23] SZ10 pages 171-173,
[24] SZ9
[25] SZ5 page 45

from a Brooks catalogue which says that travelling bags *"will be available as limited edition from 2004,"*[26] (c) copy of an article dated April 2014,[27] which states that whilst for 150 years *"Brooks saddles have remained constant*", *"saddle bags [were] back in production after manufacture stopped around 40 years ago"* and (d) extracts from catalogues dated 2010, 2011, 2012, 2013 and 2014, an example of which is shown below:[28]



103. Likewise, Mr Zorzi states that the applicant produced cycling jersey in 2007 and launched the sub brand John Bloutlbee, which is the applicant's clothing label for cycling clothing, in 2010 with extracts from catalogues being exhibited from the year 2011, 2012 and 2013 (all after the relevant date).

104. Ms Wickenden accepted that the evidence *"is in large part for saddles*". However, she argued that it goes back a very long way and the evidence shows that the applicant is very well-established in the sphere of saddle cycles and that if a consumer "*sees or saw at the priority date"* a saddle bag with the mark applied-for featuring on it, they would certainly much more likely to believe that the bag comes from the applicant rather than the opponent. She stated:

[26] SZ4 page 36
[27] SZ9
[28] SZ5 page 46 onwards

"Why would a consumer think that there is a likelihood that a saddle bag would come from a running shoe manufacturer, even though there is a similar mark, when there is such a presence in the cycling sector in relation to saddles? Yes, I think probably my strongest case is in relation to saddle bags but in my submission that would extend to broader cycling goods as well."

105. Whilst Ms Wickenden warned herself against referring to the actual trade as opposed to the marks, that is exactly what her argument comes to. First, the evidence of use of the name BROOKS by the applicant prior to the relevant date of 9 September 2003 in relation to bicycle saddles does not establish honest concurrent use of the applied-for mark in relation to the applied-for goods in classes 18 and 25. Even if the applicant might have used the name BROOKS in relation to bags up until the 1960s, there is no evidence of the volume of trade in those goods. In any event, that use was discontinued for 40 years and there is no evidence that the name BROOKS was still associated with bags after the production of bags was discontinued and at the relevant date.

106. Second, Ms Wickenden's argument refers to the goods in which the applicant actually trades and appears to be well-known for, namely saddles, which are not at play in the case at issue and I am not aware of (nor have I been directed to) any case-law which establishes that the applicant's reputation is a relevant factor when assessing the likelihood of confusion. Likewise, the applicant's reputation for goods other than those for which registration is sought cannot count towards honest concurrent use (if it had been pleaded). Hence, I reject the argument.

107. Likewise, Ms Wickenden's argument that there is no evidence of actual confusion after the applicant started trading in bags and clothes (which is after the relevant date) is not decisive. Absence of such evidence is rarely decisive.

108. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchin L.J. stated that:

"80. .....the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in

> Specsavers at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur."

109. In *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett L.J. stated that:

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

110. Accordingly, I do not consider that the point about the absence of confusion assists the applicant.

111. Having clarified all of the above, I now turn to the likelihood of confusion.

112. In my view, given the identity of the verbal element BROOKS in the respective marks, and the fact that the only differences between the marks resides in figurative elements which will be perceived as ornamental, or in a verbal element which will be perceived as descriptive, there is a risk of the average consumer directly confusing the marks (especially for identical goods) or believing that the applicant's mark is a variation of the earlier mark using a different stylisation of the brand BROOKS (especially for less similar goods).

113. Hence, there is a likelihood of confusion in respect to the entire applied-for specification.

114. For the sake of completeness, I should explain that I consider that some of the bags listed in the applied-for specification do not appear to be similar to the opponent's athletic footwear. The most obvious examples are, in my view, *briefcases* and *tool bags of leather,* because these goods are not generally produced by the same manufacturers who produce athletic footwear (being *athletic footwear* a term which encompasses sport shoes, cycling shoes, or trainers as a type of sport shoes suitable for casual wear), are not used at the same time (*briefcases* and *tool bags* being used by business people to carry documents and by workers such as plumbers to carry their tools, respectively),[29] are not usually distributed through the same trade channels and are not regarded as being aesthetically complementary to athletic footwear. I have therefore considered whether it would be possible to allow the applied-for mark to be registered in relation to these terms only, by deleting the limitation *"all for cyclists*" and the wording *"bags including*". However, having carefully considered the matter, I have reached the conclusion that it is not open to me to take this course of action. This is because the limitation *"all for cyclists*" means that it is not within my gift to allow the registration of these goods (or any other goods), since deleting the limitation would result in broadening of the scope of the specification originally applied-for. This is the reason why, in this case, I have not (and it does not seem to me to be possible to) suggest a revised list of acceptable goods.

114. The opposition under Section 5(2)(b) is successful in relation to the entire specification.

Section 5(3)

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

> "5(3) A trade mark which –
>
> is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or

[29] Collins online dictionary

international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark."

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

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

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

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

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

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

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

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

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

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

118. The conditions of Section 5(3) are cumulative. Firstly, the opponent must show that the earlier marks and the applicant's mark are similar. Secondly, the opponent

must show that the earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them in the sense of the earlier marks being brought to mind by the later mark. Finally, assuming the first three conditions have been met, Section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of Section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

119. The relevant date for the assessment under Section 5(3) is the filing date of the application at issue, being 9 September 2003.

Reputation

120. In *General Motors,* Case C-375/97, the CJEU held that:

> "25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.
>
> 26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.
>
> 27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.
>
> 28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot

be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

121. Whilst enhanced distinctiveness and reputation are different, the factors relevant to both assessments are the same. For the same reasons given above, I consider that the opponent has demonstrated a moderate reputation in the UK at the relevant date for to running shoes.

122. Given my finding above about the similarity of the marks, the similarity of the goods, the enhanced distinctiveness of the earlier marks and the likelihood of confusion, I find that the public is likely to make a link between the marks and that this will result in an unfair advantage for the applicant through consumers believing that the applicant's goods come from the opponent, and the applicant gaining a commercial advantage from that belief and/or from the transfer of the image of the earlier trade marks to the later mark.

123. The opposition under Section 5(3) is successful.

Section 5(4)(a)

124. Section 5(4)(a) of the Act reads as follows:

> "(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-
>
> (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,
>
> (aa) …..
>
> (b) …..

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

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

> "(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application."

126. In *Marks and Spencer PLC v Interflora,* [2012] EWCA (Civ) 1501, Lewison L.J. had previously cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that *"a substantial number"* of the relevant public are deceived, which might not mean that the average consumer is confused. However, in the light of the Court of Appeal's later judgment in *Comic Enterprises,* it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

127. I have found that, at the relevant date, the opponent had a moderate reputation in the UK in relation to running shoes. I am also satisfied that it had sufficient goodwill in the sign BROOKS to sustain an action for passing off and that due to the similarities of the marks and the goods concerned, use of the applied-for mark would have resulted in misrepresentation and damage.

128. The opposition under Section 5(4)(a) is also successful.

CONCLUSION

129. The opposition has been successful in its entirety, and the applicant's mark will be refused registration.

COSTS

130. The opponent has been successful and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of £2,500, calculated as follows:

Preparing a notice of opposition:	£300
Filing evidence and reviewing the other party's evidence:	£1,000
Preparing for and attending a hearing:	£1,000
Official fees:	£200
Total:	£2,500

131. I therefore order BROOKS ENGLAND LIMITED to pay Brooks Sports Inc the sum of £2,500. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 13th day of January 2025

TERESA PERKS
For the Registrar