BL O/0092/25

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION No. 3845492
BY JUSTIN WATTS
TO REGISTER THE TRADE MARK:

SUB 4

IN CLASS 25

-AND-

THE OPPOSITION THERETO UNDER No. 439558
BY DENNIS AND GILLIAN MACFARLANE

Background and pleadings

1. On 3 November 2022, Justin Watts (**"the Applicant"**) applied to register the word-only trade mark 'SUB 4' in the UK. The application was accepted and published for opposition purposes in the Trade Marks Journal on 18 November 2022. Registration is sought for the following goods:

> Class 25
>
> Clothing; footwear; headwear; athletic apparel; shirts; pants; jackets; hats; caps; athletic uniforms; cap visors; cycling shoes; cycling bib shorts; cycling caps; cycling shorts; cyclists' jerseys; gilets; gloves; polo shirts; shorts; singlets; socks; sports vests; t-shirts; tights; parts, fittings and accessories for all of the aforesaid goods.

2. On 14 February 2023, Dennis and Gillian Macfarlane (**"the Opponents"**) opposed the application. Opposition was originally sought under sections 5(1), 5(2), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (**"the Act"**). There were several deficiencies with the Opponents' Form TM7 'Notice of Opposition' and the incorrect fee was paid for reliance on all those grounds.[1] Following correspondence from the Registry outlining the deficiencies,[2] the Opponents ultimately elected to proceed with the opposition based solely on sections 5(2)(a) and 5(2)(b) of the Act.

3. The Opponent relies on its UK trade mark registration for the word only mark 'SUB4', trade mark number 2530450, which was filed on 2 November 2009 and became registered on 5 February 2010. It is registered in respect of the following goods which the Opponents seek to rely on for the purposes of their opposition:

> Class 25
>
> Hats, caps, balaclavas, headbands (clothing), bandannas (neckerchiefs), long sleeve T-shirts, short sleeve T-shirts, fleece tops, sweatshirts, shirts, pullovers, vests, gilets, jackets, tops, sports brassieres, briefs, shell suits, track suits, footless running tights, footless shorter running tights, shorts, trousers, over trousers, gloves, wristbands (clothing). Footwear.

[1] The Opponents had paid the fee for an opposition based solely on sections 5(1) and/or 5(2) only.
[2] Registry's official letter dated 14 March 2023.

4. By virtue of its earlier filing date, the trade mark upon which the Opponents rely qualifies as an earlier trade mark pursuant to section 6 of the Act.

5. Under their opposition based on section 5(2)(a) of the Act the Opponents claim that the contested mark is identical to their earlier mark and that the applied-for goods are similar to the goods for which their earlier mark is registered, giving rise to a likelihood of confusion.

6. Under their opposition based on section 5(2)(b) of the Act the Opponents claim that the contested mark is similar to their earlier mark and that the applied-for goods are similar or identical to the goods for which their earlier mark is registered, giving rise to a likelihood of confusion.

7. As the earlier mark had been registered for more than five years at the filing date of the contested mark, it is subject to the use conditions pursuant to section 6A of the Act. Accordingly, the Opponents made a statement that they have used their mark in relation to all the goods for which it is registered.

8. The Applicant filed a defence and counterstatement. The Applicant requested that the Opponents prove use of the earlier mark in relation to all the goods for which the mark is registered. Whilst its primary position is that if the Opponents do not meet the use conditions under section 6A of the Act, then the opposition must be dismissed in its entirety, in the alternative (in the event that the use conditions are met in relation to any or all the goods relied on) the Applicant partly admits and partly denies the claims made.

9. The Applicant's counterstatement contains multiple alternate submissions on the claims at hand, however, its substantive admissions and denials about the comparison of the respective goods and the comparison of the respective marks are as follows: (1) in relation to the comparison of the goods, its admission extends only to the fact that the competing goods both fall in the same class; (2) with regard to the comparison of the respective marks, it admits that they are phonetically and conceptually identical but denies that they are visually identical because *"they differ in that there is a space between the 'SUB' and '4' in the Later Mark",* whereas the earlier mark does not have this space, as such the Applicant submits that this is a significant visual difference.

10. The Applicant denies that there is any likelihood of confusion, submitting that:[3]

> "there is no likelihood of confusion for the following reasons (without limitation):
>
> a. in relation to the goods covered by the Registration, the Earlier Mark has a low distinctive character;
>
> b. while the phonetic and conceptual identity of the Earlier Mark and the Later Mark are admitted, there is – as pleaded above – a significant visual difference between the Earlier Mark and the Later Mark;
>
> c. where a mark is short (as in the case of the Earlier Mark), smaller differences have a greater effect in distinguishing the respective marks;
>
> d. the visual aspect will be most significant in the purchasing act in respect of all of the goods in question, as the average consumer will self-select what they wish to buy;
>
> e. the average consumer will exercise a high level of attention when purchasing the goods in question."

11. Neither party elected to file submissions during the evidence rounds however both parties filed evidence. After the filing of the Opponents' evidence in chief, the Applicant filed its evidence, to which the Opponents responded with evidence in reply. Neither party requested a hearing and only the Applicant elected to file submissions in lieu of a hearing. I therefore make this decision following a careful consideration of the papers before me.

12. The Opponents are litigants in person and do not have professional legal representation. The Applicant had initially been represented by Mark Corran of Artington Services Limited, but during the course of the proceedings it changed its representation to Asenda Law Ltd,[4] however, the solicitor instructed remained the same, being Mark Corran.

[3] See the Applicant's counterstatement, paragraph 35.
[4] Form TM33 to change representative details was filed on 16 October 2023.

EVIDENCE FILED

Opponents' evidence in chief

First Witness Statement of Gillian Macfarlane and accompanying exhibits

13. The Opponents' evidence in chief is provided in the first witness statement of Gillian Macfarlane dated 16 October 2023,[5] and has five accompanying exhibits labelled GM1 to GM5. Ms Macfarlane is one of the joint owners of the earlier trade mark. Her witness statement and evidence are provided to prove use of the earlier mark. It also contains evidence to counter the Applicant's argument about the space between the 'SUB' and '4', such evidence being taken from the Applicant's website with a view to demonstrating that the Applicant uses its sign without the space.

Applicant's evidence

Witness Statement of Mark Andrew Corran and accompanying exhibits

14. The Applicant's evidence is provided in the witness statement of Mark Andrew Corran dated 18 December 2023, and has twelve accompanying exhibits labelled MC1 to MC12. Mr Corran is a solicitor engaged by Asenda Law Ltd, the Applicant's representative firm. The witness statement provides commentary on the Opponents' evidence in chief and sets out evidence based on Mr Corran's own internet research conducted in relation to the contents displayed on the website with the domain name 'upandrunning.co.uk'.

Opponents' evidence in reply

Second Witness Statement of Gillian Macfarlane and accompanying exhibits

15. The Opponents' evidence in reply is filed in response to the Applicant's evidence. It is provided in the second witness statement of Gillian Macfarlane dated 19 February

[5] The first Witness Statement of Gillian Macfarlane was originally dated 24 September 2023. However, there were deficiencies with the Witness Statement therefore it was not admitted into proceedings. Ms Macfarlane was granted additional time to remedy the deficiencies and file an amended statement. The amended statement was filed on 16 October 2023 and was admitted into proceedings. Upon reviewing the case file after the conclusion of the evidence rounds in February 2024, the Registry noted a typographical error in the amended witness statement of Gillian Macfarlane, which had erroneously been dated 16 October **2024** but should have read as 16 October **2023**. The witness accordingly corrected the error on 6 March 2024.

2024, and has thirteen accompanying exhibits labelled GM01 to GM13 (I note that Exhibit GM09 has 12 sub-labels being GM09A to GM09L). To avoid confusion with the exhibits accompanying the evidence in chief, when referencing these exhibits I shall include the number 2 in front of the labelling, for example GM01 shall be referred to as 2GM01 and so on.

16. I have taken the parties' evidence into consideration and I shall refer to it throughout this decision to the extent that I consider necessary.

Preliminary Issues

Without prejudice correspondence

17. During the course of proceedings the Opponents provided the Registry with details of correspondence between them and the Applicant and also copied the Registry into correspondence between themselves and the Applicant's representative Mr Corran. The Registry has deemed the aforementioned correspondence as being without prejudice correspondence, and notified the parties that such correspondence will play no further part in these proceedings, and were directed to remove reference to it in part of one of their witness statements.[6] The without prejudice correspondence does not form part of the 'papers' before me as it has not been admitted into proceedings. I therefore shall make no reference to it in my decision.

18. The task before me is to consider the Opponents' claims under sections 5(2)(a) and 5(2)(b) of the Act only, which extend to nothing more than a consideration as to whether the respective goods are identical or similar, whether the respective marks are identical or similar and whether there is a likelihood of confusion. Any statements/ submissions from the parties (whether entered into proceedings or not) which allege anything else, will not form part of my decision under those sections of the Act.

The witness statements of Gillian Macfarlane

19. It is noted that although the Opponents did not file any separate submissions during the evidence rounds, the witness statements of Ms Macfarlane are dual

[6] By way of the Registry's official letters dated 27 September 2023 and 17 October 2023.

purpose documents because they contain both submissions and evidence. This is despite the Registry having pointed the Opponents to the necessary information about filing evidence and submissions and the difference between the two.[7] The underlying issue is that legal arguments should be set out separately to evidence, as legal arguments are not statements of fact.[8]

20. Although having 'dual purpose' witness statements is not ideal, in this instant case, I do not consider it too onerous a task to separate the opinions of Ms Macfarlane from her statements of fact. The pragmatic approach I intend to adopt (which in any event appears to be the approach the Applicant has adopted) is to treat the submissions as legal arguments and/or opinions rather than statements of fact, even though they are nevertheless conveyed in a witness statement accompanied by a statement of truth.

Assimilated law

21. 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.

DECISION

PROOF OF USE

22. In general, in order to rely on an earlier mark as a basis for opposition, an opponent must first establish that it has made genuine use of the mark in relation to the goods and/or services for which its earlier mark is registered. This is because if no genuine

[7] In its official letter dated 25 July 2023, inviting the Opponents to file evidence and submissions, the Registry referred the Opponents to its 'Glossary' of terms (which defines 'evidence' as "*information provided in a witness statement to prove the facts of a case"*; and 'submissions' as *"written arguments by a party to support its case or comment on the other side's evidence. Submissions are not facts and if a party wishes to rely on facts they must be presented as evidence"*). Furthermore the Registry referred the Opponents to information on how to complete a witness statement which states inter alia that *"Evidence is about giving facts. If you want to give your opinion about something (for example how similar trade marks are) or make points about the law, these should be filed separately as submissions."*

[8] See Tribunal Practice Notice ('TPN') 5/2004 titled 'Evidence in inter partes proceedings before the Registrar of Trade Marks: submission and argument'.

use is proven, then it follows that the opposition would fail at that first hurdle. In addition, if genuine use is proven in relation to only some of the goods and/or services, then an opponent would only be able to rely on those goods and/or services for the purposes of the opposition.

Proof of use – legislation and case law

23. The relevant statutory provisions in relation to genuine use of a registered trade mark are as follows:

Section 6A

(1) This section applies where—

(a) an application for registration of a trade mark has been published,

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

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if—

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

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

(4) For these purposes—

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

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

[...]

(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.

24. Section 100 of the Act makes it clear that the trade mark proprietor bears the burden of proving genuine use of its trade mark.[9]

25. The law relating to genuine use of a registered trade mark was summarised by Arnold LJ in *easyGroup Ltd v Nuclei Ltd & Ors*[10] as follows:

> "105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU [Court of Justice of the European Union] 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].
>
> "106. […] the principles may be summarised as follows:

[9] Also see *Ferrari SpA v DU*, C–721/18, at paragraphs 73 to 83.
[10] [2023] EWCA Civ 1247.

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

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

107. […] The General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. Case T-78/19 *Lidl Stiftung & Co KG v European Union Intellectual Property Office [EU:C:2020:166*] at [25]. It has also repeatedly held that the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. *Lidl* at [33]. In *Awareness Ltd v Plymouth City Council [2013] RPC 24* Daniel Alexander QC sitting as the Appointed Person said:

19. For the tribunal to determine in relation to what goods or services there has been genuine use of the mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the

nature of that use during the period in question from a person properly qualified to know. …

22. … it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal … comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaking, having regard to the interests of the proprietor, the opponent and, it should be said, the public."

26. In *Awareness Ltd,* the Appointed Person goes on to say that:

"28. […] Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered […]."

27. I also note Mr Alexander's comments in *Guccio Gucci SPA v Gerry Weber International AG*.[11] He stated:

"The Registrar says that it is important that a party puts its best case up front – with the emphasis both on "best case" (properly backed up with credible exhibits, invoices, advertisements and so on) and "up front" (that is to say in the first round of evidence). […] The rule is not just "use it or lose it" but (the less catchy, if more reliable) "use it – and file the best evidence first time round – or lose it"."

[11] Case BL O/424/14.

28. The genuine use provision is not there to assess economic success or large-scale commercial use.[12] An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.[13]

29. The Opponents can rely on their earlier trade mark only to the extent that the evidence filed establishes that the earlier trade mark had been put to genuine use in respect of the goods for which it is registered, within the five years leading up to the date on which the contested trade mark application was filed. **The relevant period in which the Opponents must establish use of the earlier mark is therefore 4 November 2017 to 3 November 2022**. However, I note that later evidence still has relevance, particularly if it casts light backwards on the position during the relevant period.[14]

Evidence

Opponents' evidence in chief

30. Although Ms Macfarlane does not expressly state her position in her Witness Statement, I note that in the Form TM7 'Notice of Opposition'[15] the Opponents state that their 'SUB4' range of goods are *"designed by Gillian Macfarlane; manufactured and retailed primarily for the use in sports, in particular running, cycling and fitness based activities.* […] *We have designed, manufactured and retailed SUB4 products across the UK since 2010."*

31. By way of background, Ms Macfarlane states that she jointly owns a retail business called 'Up & Running' with Mr Dennis Macfarlane and that the 'SUB4' branded products are an *"own brand label"* which they sell via that retail business both in its 29 nationwide high street stores (although no details are provided as to where those 'Up

[12] *MFE Marienfelde GmbH v OHIM*, Case T-334/01.
[13] *New Yorker SHK Jeans GmbH & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-415/09, paragraph 53.
[14] *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited,* [2012] EWHC 1929 (Ch).
[15] Which contains statements which are in any event accompanied by a statement of truth.

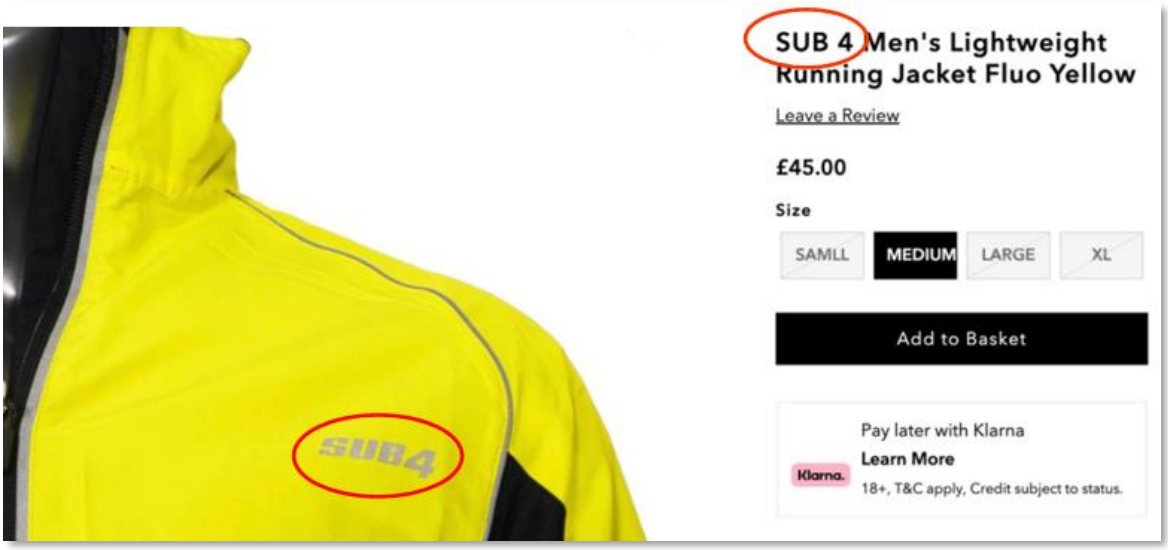
and Running' stores are located) and online via its 'Up and Running' website (the business having permission granted to it by the Opponents to sell such products).

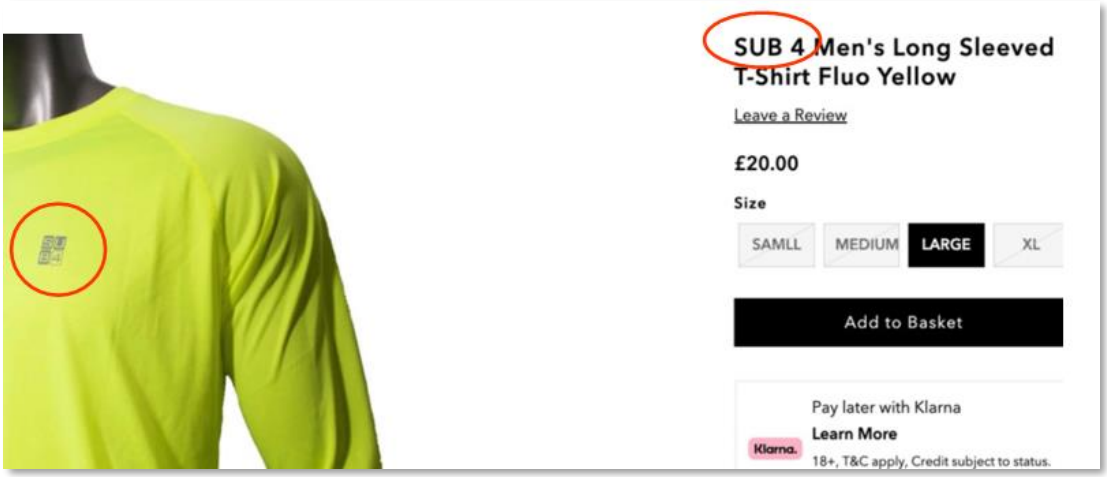
32. Exhibit GM1 contains undated images of the Opponents' retail staff uniforms as follows:

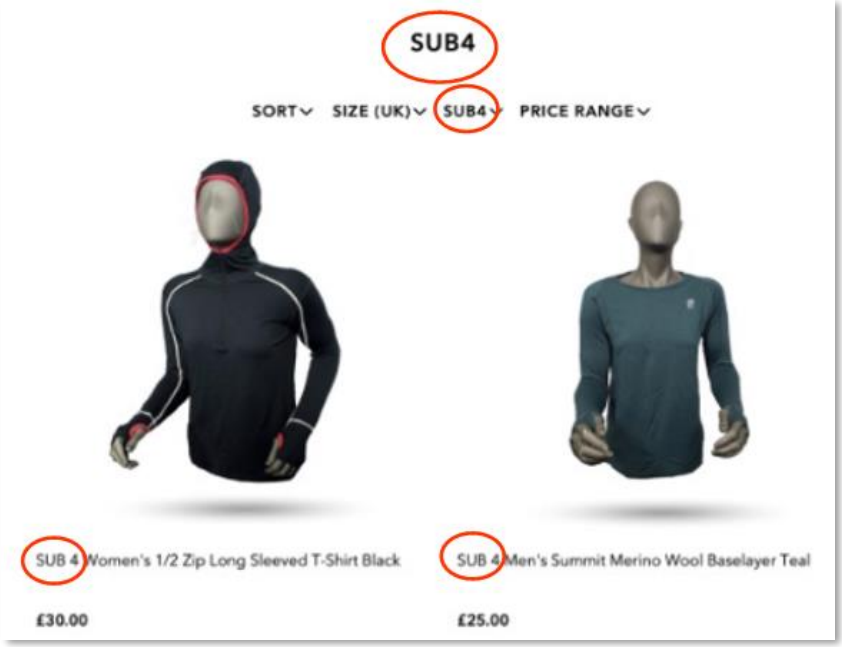
33. Exhibit GM3 contains images dated 24 September 2023, which is after the relevant five year period. Those images consist of a member of staff wearing the above staff uniform and an image of what appears to be an outdoor 'Up and Running' market stall (which was set up at a 10k race in Sheffield) showing a long sleeve top on a clothing rack displaying the following logo on its swing tag:

34. Further undated images are provided in Exhibit GM3 showing screenshots of the Opponents' 'Up and Running' website (upandrunning.co.uk). The images consist of long-sleeve t-shirts, long-sleeve base layers and running jackets all listed on the website pages as 'SUB 4' products as well as images of 'SUB4' branded beanie hats/caps. The images show a running jacket and the hats/caps displaying the logo below on the left (the 'linear' logo) and a long-sleeve t-shirt and various tops displaying the logo below on the right (the 'square' logo). I also include an image of the hats/caps:

35. The product listings in Exhibit GM3 also show ‘SUB4’ in plain text either with a space or without a space – see examples below (the red circling is mine for ease of reference):







36. Exhibit GM4 is another collection of undated images which are described as a *"photo shoot of Sub4 ranges"*. They are images of runners/models wearing sports clothing. Some of the clothing display a logo which appears to be the square logo referenced in my paragraph 34. The same staff t-shirt image provided in Exhibit GM1 is also included as well as an undated image of spiked running shoes as follows (a 'SUB4' logo is shown on the heel and on the shoe boxes):

37. Exhibit GM5 contains what Ms Macfarlane describes as (original emphasis added by the witness) *"excerpts from the Applicant's Australian web site* [www.sub4.com.au] *reflecting clearly the use of the Sub4 wording – <u>WITHOUT</u> a space between the Sub & 4"*. These images consist of long-sleeve 'running' t-shirts and running jackets. The logo shown on the garments is below (on the left) and an excerpt from this website is also below (on the right - the red underlining is Ms Macfarlane's) – the plain text underlined in red is excerpted from a paragraph that reads: *"Looking good and feeling good while you run is important, and that's why Sub4 has designed its women's running gear to be both functional and fashionable.* […] *Whether you're a seasoned runner or just starting out, Sub4 has everything you need to make your next run a success.* […]*"*:

<u>Applicant's evidence</u>

38. In reference to the Opponents' exhibit GM3, Mr Corran states he visited the 'upandrunning.co.uk' website on 14 December 2023 and he could not see some of the products listed in GM3 on the website on the date he visited it – namely a men's fluorescent yellow long-sleeve t-shirt, a men's fluorescent yellow running jacket and the beanie hats. He produces Exhibit MC1 to demonstrate those items were not present on 14 December 2023. Exhibit MC1 shows short-sleeved and long-sleeved t-shirts and socks listed for sale as 'SUB 4' products on the 'Up & Running' website. 'SUB4' is also listed as one of the brands for sale on the website amongst other brands such as 'Adidas', 'New Balance' and 'Asics'.

39. In his Exhibit MC2 he provides screenshots of the results of his search conducted on 14 December 2023 on the 'Up & Running' website for the terms 'sub 4' and 'sub4'. They also show product listings for short-sleeved and long-sleeved t-shirts and socks listed for sale as 'SUB 4' products.

40. Exhibit MC3 contains screenshots of one of the products listed for sale on the 'Up and Running' website under the 'SUB 4' brand, namely a product listed as *"Unisex Social Run Group Running T-Shirt SUB 4"*. Albeit the garment does not appear to have 'SUB4' branding on the outside, I can just about ascertain that the inside back of the neck part of that t-shirt (where customarily a label is attached/printed on clothing), the Opponents' 'square' logo[16] is displayed, and 'SUB 4' is nonetheless in plain text in the product listing.[17]

41. Wayback Machine evidence is provided. Mr Corran states that the 'Wayback Machine' is a website featuring historical archives of many website pages and allows for the search of those archives. He searched various archived URLs for the 'Up and Running' website via the Wayback Machine, and produces his results in Exhibits MC5 to MC12. The URLs he used in his searches are specific and include pathnames such as 'brand', 'collections,' 'sub4' etc. and even 'adidas'. For many of his searches for 'SUB4' products he states that no results were found. Mr Corran made no statement at the time of filing this evidence as to what conclusions he drew from any of his results.

Opponent's evidence in reply

42. In her second witness statement, by way of background, Ms Macfarlane states that *"Up and Running UK Ltd is an omni retailer"* and that *"we have operated a very successful specialist sports retail business in the UK for 32 years* [and] *the SUB4 brand has been a big part* [of that] *for 14 years providing a range of clothing, footwear and accessories."* She reiterates that 'SUB4' products are sold in the 29 'Up & Running' nationwide stores and also states that 'Up and Running' retails at running race events and that 'SUB4' products are sold at those events.

43. Wayback Machine evidence dated 23 November 2016 (although outside of the relevant period) provides further background information about the Opponents' 'SUB4' brand, stating as follows:[18]

[16] As referenced in my paragraph 34.
[17] Exhibit MC3.
[18] Exhibit 2GM10.

"Running is the very core of SUB4. […] Gillian Macfarlane (SUB4's founder) […] knew there is nothing worse than ill-fitting gear or non-performing fabrics […].

In 2010 this desire to make running comfortable and stylish came to fruition in SUB4.

Why the name SUB4?

The Sub 4-minute mile was an iconic and seemingly impossible barrier but on the 6th May 1954, this goal was achieved with a then world record of 3:59.4. This benchmark heralded a new era of athletic achievement and particularly individual performance. […] Whether it be a Sub-4-minute mile or a Sub-4-hour marathon, Sub4 means many things to many people. These benchmarks and many others are now the personal goals of runners from all across the globe.

[…]

SUB4 celebrates athletic achievement and athletic performance […]. Through offering performance, functional and stylish athletic clothing, SUB4 aims to help push runners beyond their own limits. […]"

44. Ms Macfarlane provides the following table which she states are the turnover figures for 'SUB4' products from 2010 to 2024:

Year	Sum of revenue	Sum of quantitysold
2010	£20,761.03	
2011	£331,858.61	
2012	£557,385.27	31837
2013	£548,716.12	32513
2014	£433,057.95	27945
2015	£306,938.20	9764
2016	£318,566.59	11004
2017	£307,431.78	13260
2018	£150,776.01	9829
2019	£30,403.14	2465
2020	£6,982.60	615
2021	£2,094.61	165
2022	£1,584.00	159
2023	£2,755.71	221
2024	£438.50	27
Grand Total	£3019 750.12	47509

45. Ms Macfarlane provides some background information about the 'design and manufacturing' process of the Opponents' 'SUB4' products. She states *"At least 12-18 months from design process to production is normal. It is quite the norm to produce at least 2 seasons in any one calendar year. In the case of running clothing generally Spring/Summer (SS) and autumn/winter (AW). Therefore, to produce garments for SS20 season, for example, one would generally start the design process, factory visits to discuss designs, fabric/trim selections 12-18 months prior i.e. autumn 2018 to spring 2019."* To this end, she produces copies of emails dated in 2019 between her and one of the Opponents' 'SUB4' clothing manufacturers in relation to the 2019/2020 ranges – these emails discuss postponing production until 2020 due to various issues like design and fabric choices, and factory capacity.[19]

46. Ms Macfarlane also states that the Covid-19 pandemic had an *"enormous"* impact on her business, and that with the imposed closure of the business' 29 stores *"the decision was taken to halt production of the Sub4 ranges due to the huge financial investments necessary to produce such ranges, until more certainty for the future and stability in the economy."* She goes on to state that with growing economic pressures as a result of the pandemic and other global factors, *"we self-imposed a short hiatus over full production of our Sub 4 product ranges planned for AW19/ SS20 seasons, focusing instead on a smaller range of key garments."* Ms Macfarlane also provides a copy of an email from one of the Opponents' manufacturers in Turkey (referencing the 'Covid-19' pandemic) the manufacturer states in the email that it has downsized their company and they are working from home.[20]

47. Exhibit 2GM13 show design drawings/schematics for the *"postponed"* Autumn/Winter 2019 collection of 'SUB4' clothing products, namely:

> *Ladies hoodie; long sleeved men's tee; ladies and men's long tights [leggings]; ladies and men's shorts; skorts.*

In reference to this evidence Ms Macfarlane states that *"the work has been done"*.

[19] Exhibit 2GM01.
[20] Exhibit 2GM02.

48. The schematics show images of the garments and set out details such as fabric choice, size ranges, stitching colour, logo placement and the design of the logo to be applied to the garments. The deign schematics show that the logo to be applied to the ladies hoodie is the one below on the left, and the logo to be applied to all other garments I have listed is the one below on the right:

49. Exhibit 2GM03 is a *"purchase invoice"* dated 20 January 2020 for 2000 units (with a value of $4,700 USD) of the unisex social run group ('SRG') t-shirts.[21] The customer name on the invoice is 'SUB4' and the products were shipped from China (the first instalment of the payment having been made by the Opponents on 26 November 2019 and the second and final instalment on 13 January 2020).

50. Ms Macfarlane states that *"SUB4 are the sole manufacturer/supplier"* of the SRG t-shirts and that they are available to purchase *"in all Up & Running stores where there is active SRG groups and on www.upandrunning.co.uk."* Undated images of the SRG t-shirts are provided (see example below)[22] as well as undated images of runners wearing them (those images show that the products being worn are short sleeved t-shirts and vests)[23]:

[21] Ms Macfarlane refers to them by the acronym 'SRG' i.e. '**S**ocial **R**un **G**roup'.
[22] Exhibit 2GM05
[23] Exhibit 2GM06

51. A ‘bill of lading’ is provided, dated 1 July 2019 in relation to a shipment of 14 cartons of the Opponents’ ‘SUB4 staff polo’ shirts from China to the UK. The consignee is marked as ‘SUB4’.[24] Ms Macfarlane states that *“those very staff polo shirts* [are] *clearly marked with the SUB4 logos”* and provides further undated images of the polo shirts as follows:[25]

52. Ms Macfarlane makes reference to Mr Corran’s evidence, in particular his statement that he could not find certain items of ‘SUB4’ clothing in his search of the Opponents’ website. As I have detailed above, Mr Corran states he visited the ‘upandrunning.co.uk’ website on 14 December 2023 and he could not see a men’s fluorescent yellow long-sleeve t-shirt, a men’s fluorescent yellow running jacket, and the hats listed for sale. To this end, Ms Macfarlane produces copies of 12 *“sales orders extracted from the Up & Running website on Shopify* [showing] *the most recent sales orders of Sub4 product”* (Exhibits 2GM09A to 2GM09L). This is evidence of sales which occurred after the relevant period between 28 September 2023 and 2 February 2024, and show that (amongst other things) the ‘SUB4’ men’s fluorescent yellow long-sleeve t-shirt was sold on 26 September 2023[26] and 24 October 2023,[27] a men’s fluorescent yellow running jacket was sold on 28 September 2023,[28] and that the ‘SUB4’ beanie hats (itemised as ‘SUB 4 Fluo Hat Black Pink) were sold on 12 November 2023[29] and 2 February 2024.[30] Other ‘SUB4’ products listed in those sales orders are: *women’s long and short sleeved t-shirts and a high visibility vest*. I note that all the product listings include ‘SUB 4’ in plain text.

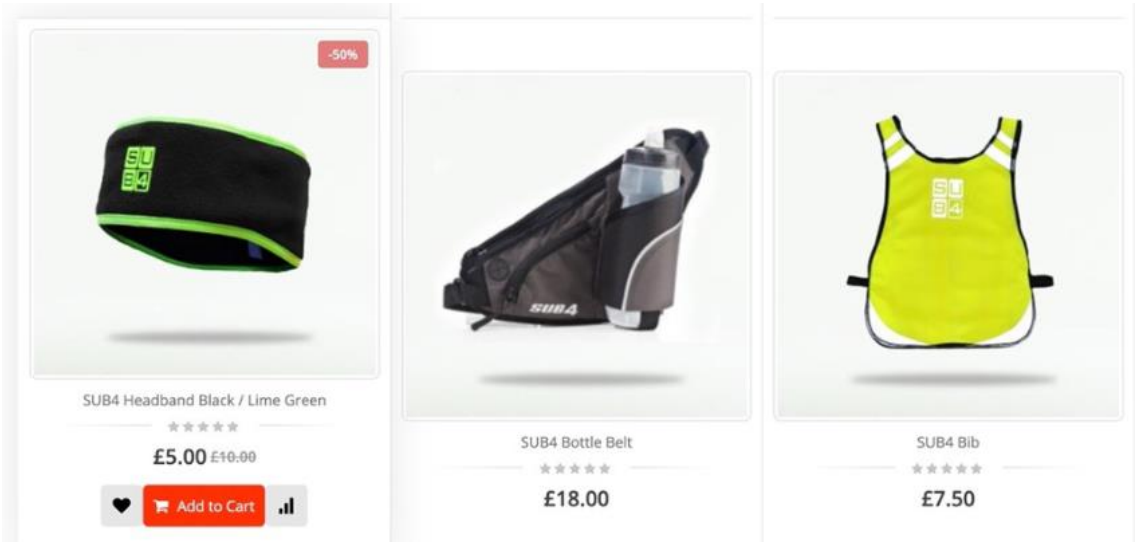
[24] Exhibit 2GM07
[25] Exhibit 2GM08
[26] Exhibit 2GM09B
[27] Exhibit 2GM09C
[28] Exhibit 2GM09A
[29] Exhibit 2GM09E
[30] Exhibit 2GM09F

53. Making reference to Mr Corran's Wayback Machine evidence (in particular paragraphs 13 to 18 of his Witness Statement), Ms Macfarlane states that she is *"not entirely clear to the point he is making. However, rather than looking for a particular product on one particular date, I would like to show that, with the use of the Wayback Machine, how Sub4 has very much been very apparent over the decades since its registration in 2010".* Exhibit 2GM10 contains screenshots of the Opponents' 'Up & Running" website,[31] obtained via the Wayback Machine, dated between 27 July 2011 and 13 May 2020.

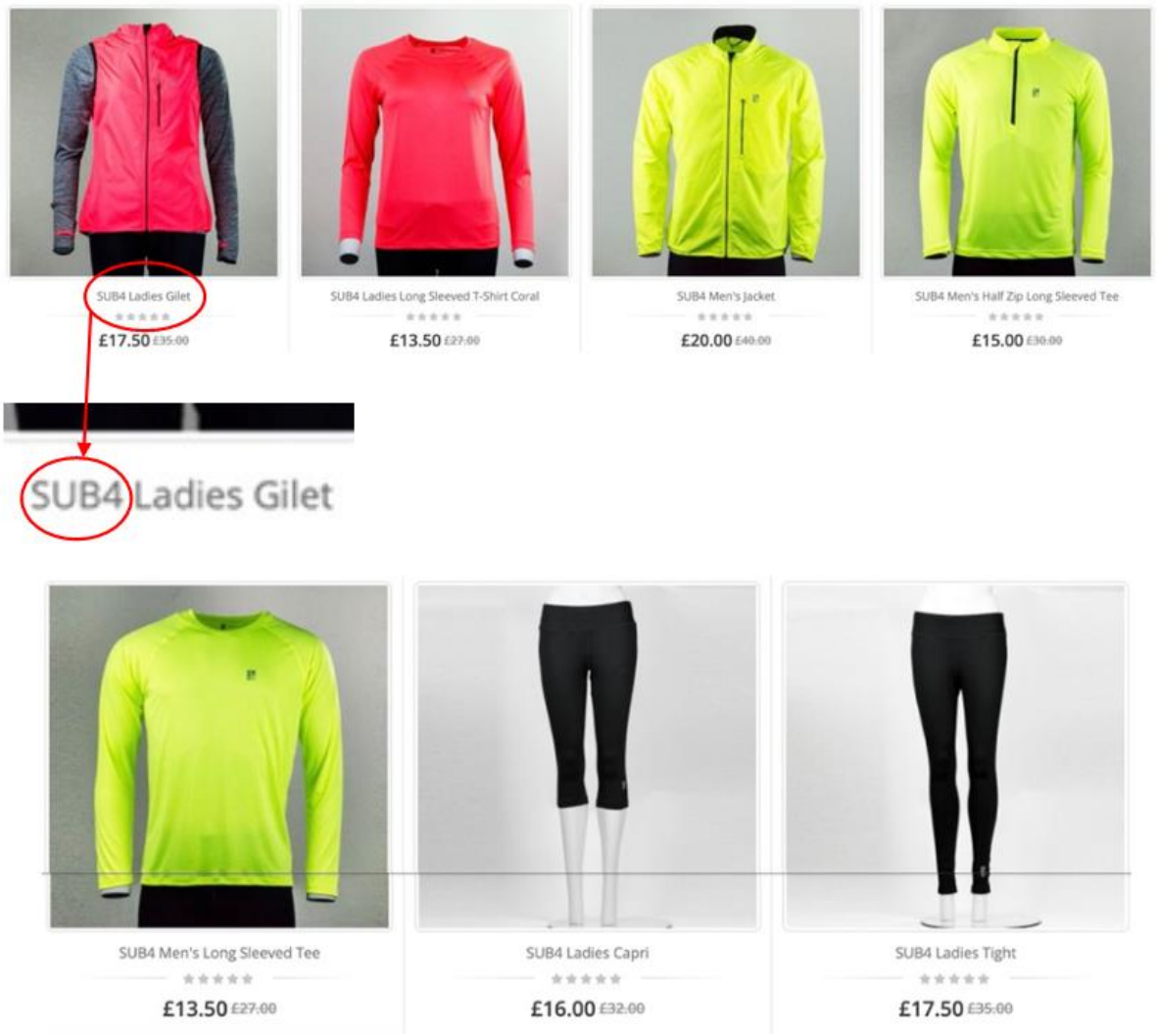
54. The Wayback Machine screenshots which fall in the relevant period are dated 30 August 2018 and 13 May 2020. The 13 May 2020 screenshot shows an alphabetical list (in plain text) of brands available on the website,[32] of which 'SUB4' is one. The 30 August 2018 screenshots show 'SUB4' products listed for sale, namely:

> *Ladies gilet; ladies long sleeved t-shirt; men's jacket; men's half zip long sleeved tee; men's long sleeved tee; ladies capri [leggings]; ladies tight [leggings]; men's reflective tight [leggings]; headband; bottle belt; [sports] bib.*

55. All of the above listings show images of the products. Whilst a logo is not clearly visible on the all the products, all the images nevertheless clearly have a description below them showing 'SUB4' in plain text. Some examples taken from the 30 August 2018 screenshots are below (the red circling is mine for ease of reference). Included in the images are a men's fluorescent yellow long-sleeved t-shirt and jacket:



[31] www.upandrunning.co.uk
[32] Such as Adidas, Asics, Garmin, Mizuno, New Balance and Under Armour.



56. Finally, Ms Macfarlane provides a table detailing the *"current Sub4 stock holding"* (for ease of reference I have annexed a copy of the table to this decision). The table consists of a list of the names of various products all including 'SUB4' in the description. The total quantity of items is 3202 units with a stated total cost price (as opposed to retail price) of £15,601.28, although I note that a small proportion of those items are not Class 25 goods, namely the sports bottles (accounting for 10 units) and phone holders (accounting for 98 units).

57. The table lists the following products:

- *"SUB4 SRG" t-shirts and vests* – the 'SRG' products account for the largest proportion of the stock (i.e. 2,957 units).

- *"SUB4 FLITE SPIKE J*"* and *"SUB4 FLITE SPIKE UNI"*. I have deduced that the name 'flite spike' refers to spiked running shoes an image of which is shown in the Opponents' Wayback Machine evidence dated 12 October 2012 (see below):

- *"SUB4 MITTEN GLOVE"* – images of 'SUB4' gloves, including the mitten gloves (top right image below), are shown in the Opponents' Wayback Machine evidence dated 16 February 2016 as follows:

58. Although the images for the running spikes and mitten gloves are dated before the relevant period, the list of *"current Sub4 stock holding"* (which is dated at least the date of Ms Macfarlane's second Witness Statement i.e. 19 February 2024), shows that those goods were in stock at that later date and a line the Opponents' still carried (albeit in small quantities).

59. The remainder of the 'SUB4' products included in the table are as follows:

> *Long sleeved tops/ t-shirts; shorts; bibs; capri tights; tights; long tights; short tights; cross training pants; base layers; t-shirts; vests; bibs; hats; headbands; jackets; storm jacket; armbands*.

Form of the mark

60. As provided in section 6A(4)(a) of the Act, the Opponents may rely on use of a mark *"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"*.

61. The purpose of this provision is to avoid imposing strict conformity between the used form of the trade mark and the form in which the mark was registered, and therefore to allow its proprietor, on the occasion of its commercial exploitation, to make variations in the sign, which, without altering its distinctive character, enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned. Where the sign used in trade differs from the form in which it was registered only in *negligible elements*, so that the two signs can be regarded as broadly equivalent, the abovementioned provision envisages that the obligation to use the trade mark registered may be fulfilled by furnishing proof of use of the sign which constitutes the form in which it is used in trade.[33]

62. The Opponents' evidence shows the following signs (I have numbered these for ease of reference):

Plain text	Stylised
(1) SUB4 (2) SUB 4	(3)  (4)  (5) 

[33] See the General Court ruling in T-194/03 *Il Ponte Finanziaria* [2006] ECR II-445 at paragraph 50 (not overturned by the Court of Justice C-234/06 *Il Ponte Finanziaria* [2007] ECR I-7333).

63. The correct approach in assessing whether a mark has been used in a 'variant form' requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences).[34]

64. Any genuine use of sign (1) during the relevant period will be use of the mark as registered and therefore use on which the Opponents can rely.

65. The space between 'SUB' and '4' in sign (2) represents a negligible difference between the sign in use and the sign registered. The space does not alter the distinctive character of the mark and is therefore an acceptable variant form. Any genuine use of sign (2) during the relevant period will be use on which the Opponents can rely.

66. I bear in mind that the mark relied on is a word-only mark, therefore the protection afforded by the registration is not limited by any features such as typeface or capitalisation appearing on the Register. Albeit signs (3) and (4) are in a stylised font, the distinctive character of the registered mark is not affected as 'SUB4' is clearly discernible. In addition, the square device included in sign (4) is decorative and does not alter the distinctive character of the mark as the words 'SUB4' are nonetheless the distinctive element. Consequently, any genuine use of signs (3) and (4) during the relevant period will be use on which the Opponents can rely.

67. Sign (5) represents a departure from the registered mark, this is because the letters and number making up the registered mark have been arranged in such a way that they appear as a stylised logo. The fact that the letters 'S' and 'U' are stacked above the letter 'B' and number '4' means that the sign could be perceived by the consumer as 'S.U.' 'B.4.' (i.e. 'ESS' 'YOU' 'BEE' 'FOUR') and not 'SUB4'. The stylisation alters the distinctive character of the registered mark such that the two signs cannot be regarded as broadly equivalent. Use of sign (5) is therefore not use on which the Opponents can rely. That said, I note that the evidence shows that even where sign (5) is applied to the goods themselves, the goods are nonetheless listed for sale with 'SUB4' or 'SUB 4' in plain text in the description, as demonstrated in the 'Up &

[34] See *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, paragraph 13.

Running' website product listings.[35] I shall return to this point in my conclusions on the evidence.

Conclusions on the evidence

68. As indicated in the case law cited above, genuine use is such use which is consistent with the essential function of a trade mark, i.e. to identify the origin of the goods bearing the mark. I bear in mind that the use must be by way of real commercial exploitation of the mark, however there is no quantitative threshold, therefore the volume of trade does not necessarily have to be high in order for that trade to be genuine. Genuine use must therefore be understood to denote use that is real and not merely token.

69. The term 'token' use refers to use of a trade mark that is solely to preserve the rights conferred by the mark, as opposed to any true interest in or expectation of making commercial sales in order to maintain or create a share in the market for the goods that bear the mark. Use can be deemed tokenistic where there is no particular intention that the mark will become associated with the origin of the goods.

70. This is why it is essential that when assessing whether there has been genuine use, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real (those factors and circumstances being interdependent[36]), whilst being alive to situations where commercial use of a mark, that is neither sham nor token, is capable of not representing genuine use due to the circumstances of the case, perhaps because the use is restricted in some way, for example, it could be territorially restricted to only one area of the UK.[37]

71. What matters is whether the use is warranted in the economic sector concerned to maintain or create a share of the market for the registered goods or services,[38] and in this regard I note that Professor Philip Johnson, sitting as the Appointed Person,

[35] See examples displayed in my paragraph 55.
[36] See the decision of Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15), whose analysis was approved by Arnold J (as he then was) in *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited,* [2016] EWHC 52 (Ch).
[37] As in the *'London Taxi'* case.
[38] Reber Holding GmbH & Co KG v OHIM, C-141/13 at paragraph 29.

found that genuine use was established in relation to the retail of certain items of sportswear clothing where the earlier right (for which revocation was sought) was used in relation to a single store based in London which had only traded for one year at the beginning of the relevant 5 year periods.[39]

72. I am required to determine in relation to which goods the earlier mark has been used and, if that use is not on everything relied upon (nor a reasonable range of goods within the terms in the specification), to decide upon a reduced, fair specification representative of the actual use shown. I note that a mere assertion from a trade mark proprietor that its earlier mark has been used in relation to all the goods relied on will not suffice. I also note that the use must relate to the goods for which the earlier mark is registered, therefore if use is shown in relation to goods not covered by the specification relied on, then use on such goods cannot be relied on.

73. Firstly addressing Mr Corran's evidence that he could not find the 'SUB4' men's fluorescent t-shirt, fluorescent jacket and the 'SUB4' hats listed for sale on the Opponents' website on 14 December 2023. I note that Ms Macfarlane subsequently demonstrated in her evidence in reply through the Shopify sales orders exhibited that these items (amongst others) were sold before Mr Corran even conducted his search of the Opponents' website (although her evidence nonetheless shows they were sold after the relevant period). Furthermore, the Opponents' Wayback Machine evidence from 2018 shows a men's fluorescent yellow long sleeved t-shirt and a men's fluorescent yellow jacket listed for sale during the relevant period.

74. Ms Macfarlane's narrative evidence in relation to the 'design and manufacturing' process is that it is usual to produce at least 2 seasons of running clothing in any one calendar year, and that it takes at least 12-18 months from design process to production. I have no reason to doubt the truth of that evidence, therefore, with this 12-18 month period in mind, it is reasonable to infer that the goods sold via Shopify from 28 September 2023 to 2 February 2024 could have been for the sale of goods from an Autumn/Winter 2023 collection, the planning for which, according to Ms Macfarlane's timelines, would have occurred 12-18 months prior, i.e. hypothetically at least from spring 2022 to autumn 2022. Therefore it would be reasonable to also infer

[39] See BL O/1202/24. Although this is a case involving revocation of a registered trade mark, it nonetheless considered whether the mark at issue had been put to genuine use.

that preparations to put those goods on the market would have been underway during the relevant period.

75. In the alternative, if no Autumn/Winter 2023 collection were ever produced (and I certainly have no evidence before me that it ever was), it is nonetheless reasonable to infer that the goods sold via Shopify from 28 September 2023 to 2 February 2024 would have been from previous seasons, and it follows that the investment and preparations to put those goods on the market would have had to have occurred during the relevant period (i.e. these later sales cast light backwards on the position during the relevant period).

76. In its later submissions in lieu of a hearing the Applicant submits the following in relation to Mr Corran's Wayback Machine evidence:

> "It is also clear from Mr Corran's evidence that he did substantial work trying to find use of the SUB4 brand on the Up and Running website of Macfarlane. Exhibit MC12 shows the relative ease in finding ADIDAS branded content. By contrast, MC11 shows only a range of older linked pages (outside the relevant period) for accessories such as bottles, waist pouches and shoe bags and MC8 shows links outside the period to branded promotions. Again, it would have been perfectly acceptable for Watts ['the Applicant'] to have filed nothing and to have relied solely on submissions that the evidence was insufficient: instead, Watts went further to positively show the evidence was not in the relevant period."

77. However this evidence does not unequivocally prove that the goods displayed in the undated images of the Opponents' evidence in chief were not available for sale during the relevant period. It merely shows that some of Mr Corran's specific search parameters did not produce results. Indeed, I am somewhat critical of his search parameters, this is because I bear in mind that the pathnames of the URLs he used in his searches are specific and likely dependent on whether the Wayback Machine 'crawled' those specific URLs (which may explain why no results were found), rather than whether it just crawled the general URL 'upandrunning.co.uk'. The burden to provide evidence of use rests with the Opponents in any event, and the Opponents have demonstrated through their Wayback Machine evidence in reply that 'SUB4'

branded products were in fact listed for sale on their website during the relevant period, including a men's fluorescent yellow long-sleeve t-shirt and a men's fluorescent yellow jacket).

78. With regard to the Opponents' evidence, I note my overriding criticism is that parts of the evidence are undated. However, undated evidence is not necessarily detrimental when the evidence is viewed as a whole, this is because it may be the case that certain pieces of evidence support each other, and I bear in mind that an assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.[40]

79. The Opponents' email evidence shows that they were actively engaging in discussions with their clothing manufacturers in 2019 for the 2019/2020 collection, and the clothing schematic drawings are evidence of some of the designs for that collection. These combined are evidence that preparations were underway to put those goods on the market (albeit these plans were ultimately delayed according to Ms Macfarlane's narrative evidence).

80. With regard to the Opponents' postponed 2019/2020 range, the Applicant submits that Ms Macfarlane states that this range was not produced, however, that is not what she states – she states that (my underlining for clarity) *"we self-imposed a short hiatus over full production of our Sub 4 product ranges planned for AW19/ SS20 seasons, focusing instead on a smaller range of key garments."* She also states that the work *"has been done"*. I accept this to mean that the range was eventually put into production and notwithstanding there was a short hiatus over production of the full range, the production of a smaller range went ahead.

81. The Applicant criticises the Opponents' business decision in this regard and submits that:

> "Macfarlane says they did not proceed due to the financial investments necessary: it is common knowledge that during lockdown there was a significant shift to online sales and so there is no suggestion that Macfarlane

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

could not have shifted sales online (they did, of course, have the Up and Running website)."

82. I acknowledge that there was a shift to online sales during the pandemic, however these submissions are overtly oversimplistic because they do not take into account a plethora of factors the Covid-19 lockdown imposed on many businesses (with some major nationwide chains even going out of business and vacating their high street locations). For example, even without evidence I can imagine that such factors businesses may have faced could have included the lack of a facility to fulfil online orders where suitable social distancing measures could be imposed. It also doesn't factor in the actual evidence provided that the manufacturers of the 'SUB4' clothing themselves were downsizing (as demonstrated in the Opponents' email evidence) and therefore it is reasonable to infer from that evidence that the manufacturer may not have been able to easily fulfil the Opponents' orders.

83. In assessing Ms Macfarlane's evidence I also adopt a pragmatic view, having regard to basic business acumen, and it is apparent that an imposed closure of the Opponents' retail stores would inevitably have also meant less revenue streams for the Opponents. Therefore, once again it is reasonable to make another inference i.e. that the business would have had less money available to it to invest in production of further product. In addition, due to imposed closures during the pandemic, I am aware that many 'bricks and mortar' businesses were faced with the difficulty of having to continue to pay their fixed costs such as rent, rates etc. It follows that even closed stores would have represented an ongoing cost to businesses, thus depleting funds to invest in production i.e. if the money coming in (from online sales for example) is funnelled towards paying fixed costs of redundant closed stores, then this would mean less money to invest elsewhere.

84. The Applicant's submissions also do not take into account that the Opponents' clothing line is sportswear – which people are likely to have had less call for during lockdown because of gym closures and being housebound.

85. In summary, I have no reason to be critical of the Opponents' business decision to impose a temporary hiatus on full production of new lines (instead focusing on a smaller range of key garments) and the Covid-19 pandemic is an acceptable reason

for doing so. I do not consider that this business decision represents a lack of intent to commercialise the earlier mark.

86. The turnover figures for 'SUB4' products show turnover being in excess of £300 thousand in 2017 (with in excess of 13 thousand items sold), dropping to in excess of £150 thousand in 2018 (with in excess of 9.5 thousand items sold) and thereinafter they show further declines in sales dropping to just circa £1.5 thousand in 2022 (with only 159 items sold for the entire year). However, these figures cannot be viewed in the abstract and account must again be given to what Ms Macfarlanes states was an *"enormous"* impact the Covid-19 pandemic had on her business. Therefore a decline in sales from 2020 to the end of the relevant period is not surprising. I also have to take into consideration that the production of a paired back collection would inevitably impact on ultimate sale volumes i.e. the less products for sale, the less potential turnover.

87. The task of assessing genuine use is not one to look at the turnover in just one year during the relevant period but to look at the turnover across the relevant period. Whilst the figures have declined, there have been sales in each year of the relevant period nonetheless, with the sales at the beginning of the period being reasonably good. Furthermore, the 2023 figures (although after the relevant period) show a very slight uptake from the previous year and not a continuous year-on-year decline. Certainly I do not consider the turnover at the beginning of the relevant period to be tokenistic and I do not think that the revenue derived from sales at the end of the relevant period was merely to preserve the rights in the mark either. The narrative evidence paints a picture that the Opponents' business was struggling during the pandemic and due to other global events thereafter, and that certain decisions were made to preserve the business. I do not think that is sufficient reason to find that the low sales by the end of the five-year period were tokenistic.

88. The turnover figures are not broken down by product. The Applicant submits that *"it is not possible to ascertain how much of the asserted turnover relates to* [the goods falling within the specification relied upon]*."* Whilst I share this criticism, I have nothing before me to suggest these do not relate to the Class 25 products and no reason to doubt that they do not either, especially as Ms Macfarlane has asserted in her narrative evidence that the turnover figures relate to the sale of 'SUB4' products (as opposed to

the turnover of the 'Up and Running' business in general). The Applicant makes reference to 'other products' such as bottles, phone holders and shoe bags and submits that the individual price point of these items (being £12 and under) is less than the clothing items such as the t-shirts (which they submit are priced around £22-£25 in the Opponents' website evidence), tights (around £35-£40) and jackets (around £45).[41] The Applicant also provides calculations of the average transaction value (by dividing the revenue by the quantity sold), thus they have calculated that in 2018 the average transaction value was £15.34 and that it was £9.96 in 2022.[42]

89. The Applicant therefore concludes that *"In order to have such a low average purchase value we submit that a significant amount of the turnover would need to be of items other than clothing, since the tops and tshirts asserted to have been sold were at prices well above the average"*[43] (contradictorily, the bottles and shoe bags are items which the Applicant had already submitted, based on its search of the Wayback Machine, were not sold in the relevant period in any event - see my paragraph 76 above). I reject this line of argument since these average calculations are inherently imprecise and do not take into account any potential scenario where the clothing items could have been sold, not least because they do not take into account that perhaps the turnover may include items that were on sale, hence a lower price point (for example, the evidence in reply shows that the headbands are priced on sale at only £5).[44] Therefore an average transaction value is not conclusive as to what was actually sold.

90. It appears that the core of the 'SUB4' products are products falling within Class 25, particularly when taking into account, as shown in the 'SUB4' stock holding table, the stock holding of sports bottles and phone holders are significantly lower in total than the total of all the clothing, footwear and headwear items combined i.e. of the 3202 items listed, sports bottles account for only 10 and phone holders only 98.

[41] See the Applicant's submissions in lieu, paragraph 36.
[42] See the Applicant's submissions in lieu, paragraph 35.
[43] See the Applicant's submissions in lieu, paragraph 36.
[44] See examples of sale prices from the Opponents' 2018 evidence included at my paragraph 55.

91. Although the stock holding table is dated after the relevant period,[45] fundamentally it is reasonable to infer that the goods listed in the table are either goods for which the planning, preparation and manufacture was conducted during the relevant period (when taking into account Ms Macfarlane's narrative evidence in relation to the design and manufacturing timeframes)[46] or, they were actually put on the market during the relevant period because it is conceivable that the list contains goods still held in stock from previous seasons falling within the relevant period, or maybe even trans-seasonal products. Indeed the evidence seems to suggest that the 'SRG' products are trans-seasonal, showing up in the *"purchase invoice"* dated 20 January 2020, within the relevant period; for sale on the Opponents' website on 4 December 2023 (as per the Applicant's evidence); in addition to being listed in the 'SUB4' stock holdings table.

92. The evidence shows that certain items of clothing have the stylised square logo affixed to them (i.e. sign (5), in my paragraph 62), which I have determined is not an acceptable variant of the earlier mark. Returning to my earlier point,[47] notwithstanding the evidence shows that some garments have sign (5) affixed to them (including the 'SRG' garments), the evidence nonetheless shows that the goods themselves are put on the market as 'SUB4' products (in plain text) on the Opponents' website, and as I have already noted, use of 'SUB4' in plain text is use on which the Opponents can rely.

93. To this end I note that use 'in relation to the goods' may be established without it being necessary for the mark to be affixed on the goods themselves where the proprietor uses that sign in such a way that a link is established between the sign and the goods marketed.[48] The fact that the evidence demonstrates that the products are listed for sale with a plain text use of the 'SUB4' brand, would in any event be sufficient on its own to establish a link between the sign and the goods marketed.

94. It follows that if use can be established without the need for affixing a sign to the product itself, then the fact that a proprietor markets its products using the sign as

[45] It can at least be dated with the same date as Ms Macfarlane's second witness statement i.e. 19 February 2024.
[46] i.e. preparations to put those goods on the market may have been underway during the relevant period.
[47] See my paragraph number 67.
[48] See the judgement of the CJEU in *Céline SARL v. Céline SA*, Case C-17/06 (*Céline*), in particular paragraph 23.

registered in its product listings, should therefore be use on which a proprietor can rely, irrespective of any stylised logo that is affixed to the goods. Furthermore, listing the products for sale as 'SUB4' products (with use of the mark in plain text) is only likely to reinforce the consumer perception that sign (5) can be read as 'SUB4', notwithstanding it is not an acceptable variant of the registered mark. For the foregoing reasons, I do not dismiss the evidence where sign (5) has been affixed to the items because the evidence demonstrates that the goods are nonetheless listed for sale as 'SUB4' in plain text and the latter is use of the earlier mark as registered.

95. The Opponents have produced evidence in relation to staff uniforms/polo shirts branded with a 'SUB4' logo. However, use on staff uniforms is not genuine use of the trade mark. The *raison d'être* of a trade mark is to create a market for the goods concerned that bear the mark – affixing the mark to a staff uniform does not contribute to creating a market for the goods, not least because it does not represent any commercial exploitation of the mark since those garments are not being sold to the public. Use of the mark on staff uniforms is not use with the aim of penetrating the market and is therefore not genuine use. Consequently the Opponents cannot rely on the use in relation to staff uniforms.

96. The Opponents have not produced any evidence of marketing within the relevant period. That said, whilst use of the earlier mark on staff uniforms is not genuine use in relation to the registered goods, I recognise that affixing the mark to a staff uniform is a form of creating awareness of the business' own brand to its customers, and the production of staff uniforms represents a cost to the business for creating such awareness, especially as the business name is 'Up & Running' and not 'SUB4'. The inclusion of 'SUB4' branding on the staff uniforms is at least signposting the mark to the Opponents' customers and the Opponents have produced evidence that they bought staff uniforms within the relevant period.

97. The UK market for sportswear clothing is likely to be significant but no evidence of the size of the market nor market share held by the earlier mark has been provided. That said, Ms Macfarlane has provided narrative evidence that the Opponents' business has 29 nationwide stores and that the 'SUB4' products (being an 'own brand' range) have been available to purchase at those stores as well as via their website and at pop-up stalls at running events. Although I note that the Opponents have not

provided the locations of their 29 stores I have no reason to doubt the truth of this evidence. I consider 29 stores nationwide (as opposed to being limited to a certain area of the UK) to be a relatively sizeable undertaking and the availability of the 'SUB4' goods in 29 nationwide stores is not insignificant.

98. In summary, the Opponent's Wayback Machine evidence demonstrates that 'SUB4' branded clothing was sold during the relevant period and that 'SUB4' was listed as one of the brands sold via the 'Up & Running' website. Furthermore, the 'SRG' range is sold as 'SUB4' clothing and 2000 'SRG' t-shirts were shipped to 'SUB4' in January 2020 (the manufacture of which would have inevitably occurred prior to that date and in any event within the relevant period). Although towards the end of the relevant period the turnover was drastically lower than the turnover at the beginning of the relevant period, I take into account that there is no *de minimis* rule and the genuine use provision is not there to assess economic success or large-scale commercial use, therefore I do not think that even the low turnover figures represent token use for the reasons I have already set out above, despite my assumption that the market for sportswear clothing is likely to be significant. Furthermore, as it appears from the evidence that the 'SUB4' sign has been used in relation to predominantly Class 25 goods (as opposed to other goods such as water bottles) it is reasonable to infer that the turnover figures relate predominantly to the sale of Class 25 goods even though no breakdown of the turnover has been provided.

99. In conclusion, notwithstanding its limitations, in the context of an overall assessment of the evidence and of the relevant factors, I consider that the evidence lends support to a finding that the Opponents have proved that their earlier 'SUB4' mark has been put to genuine use in the UK during the relevant period.

100. Whilst I have concluded that there is genuine use, I do not consider that the use is sufficient to allow the opposition to continue in respect of all of the goods relied upon. Therefore I move on to framing a fair specification on which the Opponents can rely, which reflects the use shown.

Fair specification

101. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*,[49] Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as follows:

> "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."

102. 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.

103. In framing a fair specification I have regard to the approach set out by the Court of Appeal in *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 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.

[49] BL O/345/10.

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 […] 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. […]."

104. In reaching a fair specification I have taken into account the goods shown for sale in the Opponents' Wayback Machine evidence; the clothing design schematics for the 2019/2020 collection; the way in which the goods are listed for sale on the Opponents' website with 'SUB4' in plain text; the delivery of 2000 'SRG' t-shirts during the relevant period; the stock holding table which, when viewing the evidence as a whole, makes it reasonable to infer that the goods contained in that table were put on the market during the relevant period and/or preparations to put those goods on the market may have been underway during the relevant period; the 'Shopify' sales and my conclusions in relation to that evidence, particularly the reasonable inference in relation to the stock sold during that time period.[50]

105. Therefore taking into account the evidence before me and my foregoing conclusions in relation to that evidence, I consider a fair specification to be as follows:

[50] See my paragraphs 73 to 75 in relation to my conclusion on the Shopify sales.

Hats, caps, headbands (clothing), long sleeve T-shirts, short sleeve T-shirts, vests, gilets, jackets, tops, footless running tights, footless shorter running tights, shorts, mitten gloves, running spikes [track shoes].

106. I consider the Opponents' use in relation to vests, bibs, hoodies, half zip t-shirts and other styles of long and short-sleeved t-shirts warrants reliance in relation to the broad term 'tops'.

107. With regard to the terms 'hat' and 'cap', these are clearly forms of headwear. I have taken into consideration that although strictly speaking the definition of 'hats' refers to headwear with brims (such as a bowler hat or top hat) and 'caps' are defined as brimless headwear (such as flat caps), these terms are used interchangeably both in trade and by the consumer, therefore it is difficult to divide them and say that use has been shown for one and not the other, particularly when taking into account that 'beanies' are 'caps' because they are brimless but are often referred to in trade, and by the consumer as 'hats' (in the same way a 'bobble hat' is referred to as a 'hat' but it is by definition a 'cap' because it is brimless).

108. However, the evidence is not sufficient to warrant reliance in relation to the broad category of 'footwear', thus an appropriate fair specification is *"running spikes [track shoes]"* (as this is an independent subcategory of 'footwear').

109. Finally, with regard to a fair specification, I note that whilst it is the Applicant's primary position that genuine use has not been established, the Applicant submits the following:[51]

> "Following the *Titanic Spa* case set out above, the only item from that specification for which we can say it is even possible to find use is "short-sleeve tshirts", and we have explained we say that would not be a reasonable finding already. We assume use on this term, however, for the purposes of exploring the case under s. 5(2)(a) and (b)."

I shall return to these submissions later in my final remarks.

[51] Paragraph 41 of its submissions in lieu of a hearing.

THE CLAIM UNDER SECTIONS 5(2)(a) and 5(2)(b)

Legislation and Case Law

110. Sections 5(2)(a), 5(2)(b) and 5A the Act are as follows:

> "5(2) A trade mark shall not be registered if because-
>
> (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
>
> (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".
>
> "5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."[52]

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

[52] Although where an opposition is successful against a range of goods/services covered by a broad term or terms, it may be considered disproportionate to embark on formulating proposals which are unlikely to result in a narrower specification of any substance or cover the goods or services provided by the owner's business, as indicated by the evidence. In these circumstances, the trade mark will simply be refused for the broad term(s) caught by the ground(s) for refusal. See Tribunal Practice Note 1/2012.

(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

112. It is a requirement of section 5(2)(a) of the Act that the competing goods be at least similar to each other and it is a requirement of section 5(2)(b) of the Act that the competing goods be identical or similar to each other.

113. The goods to be compared are shown in the table below.

Opponents' fair specification	Applicant's specification
Hats, caps, headbands (clothing), long sleeve T-shirts, short sleeve T-shirts, vests, gilets, jackets, tops, footless running tights, footless shorter running tights, shorts, mitten gloves, running spikes [track shoes].	Clothing; footwear; headwear; athletic apparel; shirts; pants; jackets; hats; caps; athletic uniforms; cap visors; cycling shoes; cycling bib shorts; cycling caps; cycling shorts; cyclists' jerseys; gilets; gloves; polo shirts; shorts; singlets; socks; sports vests; t-shirts; tights; parts, fittings and accessories for all of the aforesaid goods.

114. In *Gérard Meric v Office for Harmonisation in the Internal Market,*[53] ("***Meric***"), the General Court held to the effect that goods can be considered identical when the goods designated by the earlier mark are included in a more general category designated by the trade mark application, and vice versa.

115. When considering whether goods are similar, all the relevant factors relating to the goods should be taken into account. Those factors include, inter alia:[54]

(1) the physical nature of the goods;

[53] Case T- 133/05
[54] See *Canon*, Case C-39/97, paragraph 23; and *British Sugar PLC v James Robertson & Sons Ltd.,* [1996] R.P.C. 281 – the *"Treat"* case

(2) their intended purpose;
(3) their method of use / uses;
(4) who the users of the goods are;
(5) the trade channels through which the goods reach the market;
(6) in the case of self-serve consumer items, where in practice they are found or likely to be found in shops and in particular whether they are, or are likely to be, found on the same or different shelves; and
(7) whether they are in competition with each other (taking into account how those in trade classify goods, for instance whether market research companies put them in the same or different sectors);
or
(8) whether they are complementary to each other.

"Clothing; athletic apparel; athletic uniforms; footwear; headwear"

116. The above applied-for goods are general categories of goods and are identical under the principle outlined in *Meric* to the Opponent's goods as follows:

(1) *"Clothing; athletic apparel; athletic uniforms"* are *Meric* identical to the Opponent's *"long sleeve T-shirts, short sleeve T-shirts, vests, gilets, jackets, tops, footless running tights, footless shorter running tights, shorts, mitten gloves"* – when taking into account that 'athletic apparel' and 'athletic uniforms' are broad terms that would encompass those items of clothing.

(2) The Opponents' *"running spikes [track shoes]"* are a form of footwear and are therefore *Meric* identical to the Applicant's *"footwear".*

(3) The Opponents' *"hats, caps, headbands (clothing)"* are forms of headwear and therefore *Meric* identical to the Applicant's *"headwear".*

Hats; caps; cap visors; cycling caps.

117. I have already noted that the terms 'hat' and 'cap' can be used interchangeably, and that the word 'hat' is often used in relation to brimless hats, notwithstanding most brimless headwear is by definition 'caps'. I also bear in mind that headwear such as

‘baseball caps’ nonetheless have long visor brims even though they are referred to as ‘caps’.

118. *“Hats; caps”* appears identically in both parties’ specifications.

119. *“Cap visors”* are a form of headwear and are essentially like baseball hats but without any fabric covering the top of the head. *“Cycling caps”* are a subcategory of ‘caps’ and ‘hats’. The foregoing goods are therefore identical on the principle outlined in *Meric* to the Opponents’ *“hats; caps”*.

Shirts; jackets; cyclists’ jerseys; gilets; polo shirts; singlets; sports vests; t-shirts.

120. *“Jackets; gilets”* appears identically in both parties’ specifications.

121. *“Singlets”* is a term used to refer to sleeveless tops, for example, vests, therefore *“singlets; sports vests”* are identical to *“vests; tops”* in the Opponents’ specification on the principle outlined in *Meric*.

122. *“T-shirts”* in the Applicant’s specification are self-evidently identical to *“long sleeve T-shirts; short sleeve T-shirts”* in the Opponents’ specification.

123. T-shirts are a form of shirt. Polo shirts are a form of t-shirt. Both are also ‘tops’ (as opposed to ‘bottoms’) i.e. they are intended to be worn on the top part of the body / torso. Therefore *“shirts; polo shirts”* in the Applicant’s specification are identical on the principle outlined in *Meric* to the Opponents’ *“long sleeve T-shirts; short sleeve T-shirts; tops”.*

124. *“Cyclists’ jerseys”* are a form of close fitting short sleeved or long-sleeved garment to be worn on the top part of the body / torso. Therefore this term is identical on the principle outlined in *Meric* to the Opponents’ *“long sleeve T-shirts; short sleeve T-shirts; tops”.*

Pants; cycling bib shorts; cycling shorts; shorts; tights.

125. The above are all garments intended to be worn as ‘bottoms’ i.e. on the bottom part of the body to cover someone below the waistline and to either fully or partially cover the legs separately.

126. I note the following: the term *"pants"* is predominantly another word for trousers but it can also refer to men or women's underpants; *"cycling bib shorts"* are tight fitting shorts made of thin stretchy fabric and have a form of in-built braces to loop over the wearer's shoulders, as opposed to having an elasticated waist-band to hold them up; *"tights"* can refer to a type of women's hosiery and the term is also another word for leggings (i.e. garments of thin stretchy fabric, fitting tight to the legs) intended to be worn for athletic activities / sports.

127. Therefore, to the extent that tights are garments to be worn for athletic activities / sports, *"tights"* in the Applicant's specification are identical to the Opponents' *"footless running tights; footless shorter running tights"* on the principle outlined in *Meric.*

128. *"Shorts"* appears identically in both parties' specifications.

129. *"Cycling bib shorts; cycling shorts"* in the Applicant's specification are identical on the principle outlined in *Meric* to the Opponents' *"shorts"*. In addition, they are also highly similar to the Opponents' *"footless shorter running tights"* on the basis that they are both tight fitting garments partially covering the legs to be worn for athletic activities. They therefore overlap in nature, purpose and use; may also overlap in user; share the same trade channels; and may be in competition with each other.

130. To the extent that *"pants"* are trousers, I consider them to be highly similar to the Opponents' *"footless running tights"* on the basis that the latter are essentially garments worn as bottoms to cover the legs. They therefore overlap in nature, purpose and use; they may overlap in user; share the same trade channels; and they may be in competition with each other, for example a consumer may choose stretchy tight fitting, legging-style trousers as opposed to 'pants' or to wear in place of 'pants'.

"Gloves; socks."

131. *"Gloves"* are identical to the Opponents' *"mitten gloves"* on the principle outlined in *Meric.*

132. Clothing is a term used to refer to items to be worn on the human body with the purpose of covering, protecting and adorning the wearer. Albeit *"socks"* cover the feet, they are nonetheless articles of clothing, therefore, to the extent that *"socks"* are

articles of clothing, I consider there to be an overlap with the items of clothing included in the Opponents' specification as they too all have the purpose of covering, protecting and adorning the body. The respective goods would therefore also overlap in user and would reach the market through the same trade channels, as the manufacturer of other clothing items is also likely to manufacture socks. Socks would be sold in clothing stores and the consumer would also typically expect to be able to purchase them in clothing stores. They may even be found sold next to other clothing items (such as t-shirts) perhaps as part of a cohesive collection. These goods are therefore similar to a medium degree.

"Cycling shoes"

133. Albeit the Applicant's *"cycling shoes"* are specifically for cycling and the Opponents' *"running spikes [track shoes]"* are specifically for running, they are nonetheless items of footwear intended to be worn for sports and therefore they overlap in purpose.

134. The user may also overlap, perhaps because the user may be multi-disciplinary athletes (such as duathletes or triathletes) who require both running and cycling shoes for their sports. The respective goods are also likely to share the same trade channels as the manufacturer of sports shoes are likely to manufacture shoes for various sports.

135. Sports shoes (of any kind) are usually found in a dedicated section in general shoe stores or they are likely to be found in dedicated sportswear retailers, and although when sold in specialist retailers they are likely to be displayed in categorised sections (such as cycling shoes will be grouped together, running spikes will be grouped together, football boots would be another grouping, as would trainers and golf shoes and so on), they would nonetheless likely be sold on shelves next to each other.

136. With the foregoing in mind, I consider the respective goods to be similar to a medium degree.

137. In the alternative, the Applicant's *"cycling shoes"* would overlap with the items of clothing included in the Opponents' specification as they too have the purpose of covering and protecting a part of the body. The respective goods would therefore also overlap in user and would likely reach the market through the same trade channels,

as the manufacturer of sportswear clothing items is also likely to manufacture sports shoes such as cycling shoes. *"Cycling shoes"* would likely be sold in sports stores also selling sports clothing. They may even be found sold next to other clothing items (such as tops) perhaps as part of a cohesive collection. These goods are therefore similar to a medium degree.

"Parts, fittings and accessories for all of the aforesaid goods"

138. I have found that all the applied-for goods are identical or similar to the Opponents' fair specification. To the extent that the above term relates to those applied-for goods, I consider it to be similar to a low degree to the goods contained in the Opponents' specification, on the basis that the parts, fittings and accessories would likely share the same users as the Opponents' goods, would reach the market through the same trade channels and the respective goods would also be complementary.

Alternative findings – *"gloves; footwear; cycling shoes"*

139. If I am wrong in my finding that the Opponents' fair specification includes *"mitten gloves"*, to the extent that *"gloves"* in the Applicant's specification are an item of clothing, I consider them to be similar to a medium degree to the clothing goods contained in the Opponents' fair specification, when applying the same reasoning that I applied in relation to *"socks"* at my paragraph 132 above.

140. If I am wrong in my finding that the Opponents' fair specification includes *"running spikes [track shoes]"*, to the extent that *"footwear; cycling shoes"* are items to be worn on the human body to protect and adorn specifically the feet, I consider there to be overlap with the Opponents' clothing goods. This is on the basis that the goods are likely to share the same purpose i.e. to protect / cover parts of the body; they would likely reach the market through the same trade channels; they may also be found retailed next to each other as part of a cohesive collection; and they may also share the same user as a consumer seeking to purchase sports clothing may also likely require sports footwear. The respective goods are therefore similar to a medium degree.

The average consumer and the nature of the purchasing act

141. Trade mark questions, including the likelihood of confusion, must be viewed through the eyes of the average consumer of the goods in question. It is therefore necessary to determine who the average consumer of the goods is, and how the consumer is likely to select them.

142. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. The word 'average' merely denotes that the person is typical,[55] which in substance means that they are neither deficient in the requisite characteristics of being well informed, observant and circumspect, nor top performers in the demonstration of those characteristics.[56]

143. The average consumer of the goods at issue will be a member of the general public.

144. The goods are likely to be sold through a range of retail outlets as well as via catalogues (and their online equivalents). The goods are likely to be selected visually in stores and where the purchase is via websites or catalogues, the selection will be made after viewing images of the products displayed. I do not discount that the goods may be selected orally by making requests to sales assistants in stores, although even in those circumstances the selection process prior to purchase would be visual in nature since the consumer will see the goods prior to purchase. Accordingly, visual considerations dominate.

145. Whilst it is true that the goods will range in price from inexpensive to luxury high-end prices, considerations such as material, style, fit and durability will apply even where the goods are of low cost. The goods are consumer items that follow trends and seasonal changes, and growth (such as changes in body size and shape) therefore consumers will tend to purchase them on a fairly regular basis. However, I also acknowledge that some of the goods may be purchased less frequently than others, and only as and when the need arises.

[55] *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), paragraph 60
[56] *Schutz (UK) Ltd v Delta Containers Ltd* [2011] EWHC 1712, paragraph 98

146. The Applicant submits that the average consumer would pay a high degree of attention when selecting and purchasing the goods. I disagree, because the purchasing process for clothing, footwear and headwear will not, on average, require an overly considered thought process. Whilst the average consumer will tend to pay more than a low degree of attention because the goods are items that they intend to wear, re-use and retain for a period of time, they will not typically demonstrate more than a medium level of attention.

Comparison of marks

147. The respective trade marks are shown below:

Opponents' mark	Applicant's mark
SUB4	SUB 4

148. It is a prerequisite of section 5(2)(a) of the Act that the trade marks are identical. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union held that (my underlining for clarity):

> "54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer."

149. The competing marks are both word-only marks. The Applicant admits that they are aurally and conceptually identical, I agree. However, the Applicant argues that the space between the word 'SUB' and the number '4' in the applied-for mark is visually significant, I disagree. A space is a difference that is *"so insignificant"* it may go unnoticed by the average consumer, especially when factoring in imperfect recollection. I also note the evidence produced by the Opponents shows that even the Applicant itself uses its mark both with and without a space.

150. The competing marks are self-evidently identical, it therefore follows that there is no requirement for me to consider the position under section 5(2)(b) of the Act, which is a claim alleging that the marks are similar. I therefore move on to consider the remainder of the claim solely under section 5(2)(a) of the Act.

Distinctive character of the earlier mark

151. There is a requirement to consider a likelihood of confusion under a section 5(2)(a) claim and the degree of distinctiveness of the earlier mark is one of the factors that must be taken into account when assessing whether there is a likelihood of confusion. This is because the more distinctive the earlier mark, the greater the likelihood of confusion may be.[57]

152. Registered trade marks possess varying degrees of inherent distinctive character, perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods, ranging up to those with higher inherent distinctive character, such as invented words which have no allusive qualities.

153. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*,[58] 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 C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR 1-2779, 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

[57] Although it is always important to bear in mind what it is about the earlier mark which gives it distinctive character. *See Kurt Geiger v A-List Corporate Limited*, Case O-075-13, paragraph 39
[58] Case C-342/97.

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)."

154. There being no dominant components, or any elements that retain an independent distinctive role in the earlier mark, the distinctive character of the mark lies solely in the word 'SUB' in combination with the number '4'.

155. The word 'sub' can be understood as a prefix, meaning 'below something' such as 'sub-zero' temperatures. The Opponents' evidence explains that 'SUB4' was inspired by the 'sub 4 mile' i.e. a mile run in under 4 minutes. Thus in this context 'sub' means 'below'. However, 'sub' can also mean other things, and is an abbreviation for the word 'substitute' as in, a substitute player in sport; as well as the abbreviation for the word 'submarine'. In the context of the goods themselves, the average consumer may perceive that it alludes to a 'sub 4 mile' although that does not mean that the mark describes the goods nor does it mean that it alludes to the actual goods themselves. It is an ordinary mark that is inherently distinctive to a low to medium degree when bearing in mind the allusive nature with regard to running and sports.

156. The distinctive character of a mark can however be enhanced by virtue of the use that has been made of it. Ms Macfarlane has provided narrative evidence that the earlier mark has been used since 2010 and the turnover figures support a finding that between 2010 and 2018 at least, the business was successfully selling its 'SUB4' products in decent quantities and that the 'SUB4' goods were and are being sold in 29 nationwide stores.

157. However, the evidence is limited. In that regard I note that there is no evidence provided that would enable me to determine the Opponents' market share, nor any specific details of advertising expenditure. Although I am aware that the Opponents sell their 'SUB4' products via their website, no details are provided as to how geographically widespread those sales are.

158. Ms Macfarlane has stated that the goods are sold at pop-up stalls at running events, however no details are provided as to the attendance at those running events that would enable me to determine what level of awareness of the brand was created at those events. No other evidence of engagement with its customers has been provided either, such as evidence of advertising via social media.

159. In conclusion, I do not find the evidence sufficient to establish any enhancement of the distinctiveness of the earlier mark in the UK market for the goods the Opponents may rely on, and certainly there is nothing in the evidence that would enable me to conclude that the distinctiveness of the mark has been enhanced beyond the low to medium degree I have already attributed to it.

Likelihood of Confusion under section 5(2)(a)

160. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them that they have kept in mind.[59] I must also consider the average consumer of the goods, the nature of the purchasing process and bear in mind that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa.[60]

161. Making an assessment as to the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. The global assessment is supposed to emulate what happens in the mind of the average consumer on encountering the later mark with an imperfect recollection of the earlier mark in mind. It is not a process of analysis or reasoning, but an impression or instinctive reaction.[61] The relative weight of the factors is not laid down by law but is a matter of judgement for the tribunal on the particular facts of each case.[62]

[59] *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, Case C-342/97, paragraph 27

[60] *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, Case C-39/97, paragraph 17

[61] *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81

[62] See paragraph 33 of the Appointed Person's decision in Case No. O/049/17, (*Rochester Trade Mark*).

162. Taking into account the identity of the respective marks and the predominant identity between the respective goods, I find that the average consumer or a significant proportion thereof, would be directly confused as to the trade origin of the goods.

163. I make this finding even though I have found only a low to medium degree of inherent distinctiveness of the earlier mark, as that finding is largely neutralised by the identity of the marks and the predominant identity of the goods.

164. I note that whilst I have found that some goods are similar to only a low degree, those goods are only 'parts, fittings and accessories' and in any event there is no minimum threshold level of similarity that has to be shown as it is sufficient that some similarity exists in order to consider the likelihood of confusion.[63] As a matter of completeness I find that even a lesser degree of similarity between the respective goods would in this case be offset by the identity of the respective marks, such that the average consumer, when seeing an identical mark on goods that are similar (even to a low degree), would conclude that the goods come from the same (or at least economically linked) undertaking, thus giving rise to a likelihood of confusion.

OUTCOME

165. The opposition under section 5(2)(a) of the Act is successful. Subject to any appeal, contested trade mark application number 3845492 shall be refused registration.

Final remarks

166. The opposition is successful in its entirety under section 5(2)(a) of the Act. Therefore there is no need to consider the claim under section 5(2)(b) as it does not materially improve the Opponents' position.

167. Returning to the Applicant's submissions,[64] I note that even had I made a finding that a fair specification was limited to solely *"short-sleeve t-shirts",* I would have nonetheless found identity and similarity between that limited specification and the applied-for specification when applying the same reasoning on the comparison of the

[63] See *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, paragraph 49
[64] See my paragraph 109.

respective goods as detailed above (my paragraphs 116 to 140). Therefore this would not have materially affected the Opponents' position and I would have still found a likelihood of confusion even if that similarity were only low, when factoring in the identity of the marks and all other relevant factors.

COSTS

168. The Opponents have been successful and are entitled to a contribution towards their costs. As the Opponents had not instructed professional representatives, they indicated that they intended to make a request for an award of costs by returning a completed costs proforma.

169. These proceedings were initiated after 1 February 2023, therefore the contributory scale for costs is set out in Tribunal Practice Notice ('TPN') 1/2023. The TPN sets out the scale to determine costs awarded to represented parties, with an underlying *"contribution-not-compensation"* approach, and paragraph 4 of the TPN states the following in relation to 'unrepresented parties' (my emphasis for the sake of clarity):

> "4. Unrepresented parties generally incur lower costs because they do not have to pay legal or other professional fees. If the scale of costs were applied to unrepresented parties, they might receive costs in excess of what they may reasonably have incurred, which would undermine the contribution-not-compensation approach and the indemnity principle. Therefore, unless a Hearing Officer directs otherwise, unrepresented parties will be sent a proforma at the end of proceedings inviting them to set out the number of hours spent on the various steps of the proceedings. If an award is to be made in favour of an unrepresented party, Hearing Officers will consider the information provided when determining the sum to be awarded. The number of hours claimed will not, however, be binding on Hearing Officers, who will continue to assess whether the time spent was reasonable in the circumstances of the case and who will retain a residual discretion in any event. The sum to be awarded per hour will be analogous to that set out in the Civil Procedure Rules, Part 46, which is currently **£19 per hour**. The total amount awarded should, though, not exceed the maximum amount payable on the scale of costs (unless off-scale

costs are sought). If the unrepresented party does not complete and return the proforma, no costs award will be made save in relation to official fees (except fees for extensions of time)."

170. In addition to the £100 official fee for filing form TM7, the Opponents have claimed they spent 62 hours in relation to the proceedings, calculated as follows (bearing in mind the £19 per hour award):

Description	**Time spent**	**Cost**
(1) Official fee for filing Form TM7	N/A	£100
(2) Preparing the notice of opposition	6 hours	£114
(3) Considering forms filed by the other party	4 hours	£76
(4) Preparation of witness statement and evidence	18 hours	£342
(5) Consideration and cross referencing and research witness statement of Mark Corran	6 hours	£114
(6) Preparation of 2nd witness statement – research, reporting and information collation	28 hours	£532
TOTAL	**62 hours**	**£1,278**

171. The Opponents have not sought off-scale costs and I see no justifiable reason to depart from the scale. Items (2) and (3) do not exceed the scale, however, the Opponents have claimed costs for items (4), (5) and (6) which I consider excessive when factoring in the amounts payable on the scale of costs, and the factors I am to take into account when making an award of costs.

172. I bear in mind that where the evidence is light, an award 'on the scale' for the preparation of evidence and for considering and commenting on the other side's evidence is £600. I consider the evidence provided is light, I therefore only make an award of £600 rather than the £988 claimed. I note that had the Opponents had to gather the same amount of evidence for a representative to file on their behalf, I would

have still reached the same conclusion and only awarded them a *contributory* sum of £600.

173. Thus, in the circumstances I award the Opponents the sum of **£890** as a contribution towards their costs. The sum is calculated as follows:

Official fee for filing Form TM7	£100
Preparing a statement of grounds and considering the other side's counterstatement	£190
Preparing evidence in chief, considering the other side's evidence and preparing evidence in reply.	£600
TOTAL	**£890**

174. I therefore order Justin Watts to pay Dennis and Gillian Macfarlane the sum of **£890**. This sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 31st day of January 2025

Daniela Ferrari

For the Registrar

Annex

SUB4 stock holding table – 19 February 2024

Row Labels	Sum of stockqty	Sum of costprice	Sum of Total Cost
SUB4 1/2 ZIP LONG SLEEVE M	1	£8.55	£8.55
SUB4 7 SHORT M "	2	£9.50	£19.00
SUB4 BIB	8	£4.50	£18.00
SUB4 BOGHOPPER M	1	£7.75	£7.75
SUB4 BOTTLE BELT	7	£11.00	£38.50
SUB4 CAPRI TIGHT W	3	£26.75	£26.75
SUB4 CAPRI W	2	£18.15	£18.15
SUB4 CROSS TRAINING PANT S LENGTH W	7	£53.75	£75.25
SUB4 ESS BASE LAYER M	3	£18.55	£18.55
SUB4 ESS BASE LAYER W	7	£27.65	£38.15
SUB4 ESS SHORT TIGHT M	2	£10.50	£10.50
SUB4 ESSENTIAL BASE LAYER W	1	£5.00	£5.00
SUB4 FLASH BIB	36	£100.00	£144.00
SUB4 FLITE JKT 3 W	1	£13.50	£13.50
SUB4 FLITE SPIKE J*	1	£7.45	£7.45
SUB4 FLITE SPIKE UNI	4	£29.80	£29.80
SUB4 FLITE4 LST M	1	£9.35	£9.35
SUB4 FLITE4 LST W	1	£10.75	£10.75
SUB4 GRAPHIC TEE M	1	£3.65	£3.65
SUB4 HAT	12	£17.52	£52.56
SUB4 HEADBAND	18	£22.02	£43.56
SUB4 iCAN ARMBAND	8	£16.00	£32.00
SUB4 iRUN iPHONE4 HOLDER	40	£18.00	£80.00
SUB4 iRUN iPHONE5 HOLDER	48	£14.00	£96.00
SUB4 JACKET M	1	£14.10	£14.10
SUB4 JACKET W	2	£23.80	£23.80
SUB4 LONG FLIGHT TIGHT M	1	£12.50	£12.50
SUB4 LONG FLIGHT TIGHT W	1	£11.50	£11.50
SUB4 LONG SLEEVE TEE M	2	£14.90	£14.90
SUB4 LONG SLEEVE TEE W	3	£20.55	£20.55
SUB4 LS TEE M	3	£13.00	£19.50
SUB4 MITTEN GLOVE	2	£8.00	£8.00
SUB4 REFLECTIVE TIGHT M	1	£12.37	£12.37
SUB4 SPORTS BOTTLE 550ml	10	£0.90	£9.00
SUB4 SRG LS TEE U	833	£520.80	£4,664.80
SUB4 SRG TEE SHIRT	56	£77.00	£196.00
SUB4 SRG TEE SHIRT U	1164	£669.50	£5,524.00
SUB4 SRG TEE U	821	£494.00	£3,899.75
SUB4 SRG VEST	83	£52.50	£290.50
SUB4 STORM JACKET MCL	1	£46.00	£46.00
SUB4 TIGHT W	3	£9.08	£27.24
Grand Total	**3202**	**£2,464.19**	**£15,601.28**