

O/0146/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003552227

BY WOLF & SHEPHERD, INC.

TO REGISTER THE TRADE MARK:

**WOLF & SHEPHERD**

IN CLASSES 25 AND 35

AND IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 423809

BY SHEPHERD OF SWEDEN AB

## BACKGROUND AND PLEADINGS

1. On 5 November 2020, Wolf & Shepherd, Inc. (“the applicant”) applied to register the trade mark shown on the cover page of this decision, in the UK. The application was published for opposition purposes on 8 January 2021 and registration is sought for the following goods and services:<sup>1</sup>

Class 25      Footwear, excluding slippers; belts [clothing].

Class 35      Online retail store services for footwear, belts, and shoe care products including shoe brushes, shoe cloths, shoe cream, shoe laces, shoe trees, and shoe wax; none of the aforesaid retail services related to slippers.

2. On 7 April 2021, the application was opposed by Shepherd of Sweden AB (“the opponent”) based upon sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

3. Under section 5(2)(b) of the Act, the opponent relies upon EU trade mark no. 005871892 for the mark SHEPHERD, which was filed on 3 May 2007 and registered on 29 January 2008. The opponent relies upon all goods for which the mark is registered, namely:

Class 25      Slippers, slippers.

4. The opponent claims that the goods and services are similar and the marks are similar, with the result that there is a likelihood of confusion.

5. Under section 5(4)(a) of the Act, the opponent relies upon the sign SHEPHERD which it claims to have used throughout the UK since January 2013 in relation to

---

<sup>1</sup> The applicant’s specification was restricted to expressly exclude slippers and retail services relating to slippers following the filing of a Form TM21B dated 9 March 2023.

“slippers”. The opponent claims that use of the applicant’s mark would be contrary to the law of passing off.

6. The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use of the earlier mark.

## **THE HEARING**

7. A hearing took place before me on 6 December 2023, by video conference. The opponent was represented by Mr Florian Traub of Pinsent Masons LLP and the applicant was represented by Ms Charlotte Blythe of Counsel, instructed by Gill & Gill. Both parties filed a skeleton argument in advance of the hearing.

## **EVIDENCE AND SUBMISSIONS**

8. The opponent filed evidence in chief in the form of the witness statement of Stefan Mårdh dated 11 January 2023, which is accompanied by 26 exhibits (SM1 to SM26). Mr Mårdh is the CEO of the opponent.

9. The applicant filed evidence in the form of the witness statement of David Gill dated 9 March 2023, which is accompanied by 4 exhibits (DG1 to DG4). Mr Gill is the representative of the applicant in these proceedings.

10. The applicant’s evidence was accompanied by written submissions dated 9 March 2023.

11. The opponent filed evidence in reply in the form of the witness statement of Szu-Yu Tao dated 5 May 2023, which is accompanied by 8 exhibits (ST01 to ST08). Ms Tao is one of the representatives acting for the opponent in these proceedings.

12. I have taken the evidence and submissions into account in reaching my decision and will refer to them below, where necessary.

## RELEVANCE OF EU LAW

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

## DECISION

### Section 5(2)(b)

14. Section 5(2)(b) of the Act reads as follows:

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

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

15. Section 5A of the Act is as follows:

“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.”

16. Given its earlier filing date, the trade mark upon which the opponent relies qualifies as an earlier mark pursuant to section 6 of the Act. As the earlier mark had completed its registration process more than 5 years before the filing date of the mark in issue, it is subject to the use provisions set out in section 6A of the Act.

### **Proof of use**

17. I will begin by assessing whether there has been genuine use of the earlier mark. The relevant statutory provisions are as follows:

“(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.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

18. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is the five-year period ending with the filing date of the application in issue i.e. 6 November 2015 to 5 November 2020. As the opponent relies upon an EUTM, it can rely upon use in any EU member state (including the UK, which was at that time a member state of the EU) during the relevant period.

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

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax*

*Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung 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. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(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].”

20. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is, therefore, not genuine use.

21. In its written submissions, the applicant questioned whether the opponent’s evidence of use was acceptable because Mr Mårdh makes reference in his statement to proving use of a UK comparable mark based upon the earlier mark relied upon in these proceedings. This was not pursued by Ms Blythe at the hearing. In my view, this is clearly just a misunderstanding on Mr Mårdh’s part as to whether it is the earlier mark or its UK-clone that is being relied upon for the purposes of these proceedings. For the avoidance of doubt, I do not consider that anything turns on this. Plainly, if the use shown is sufficient to establish genuine use of the mark relied upon, the fact that reference is made to an identical alternative mark also owned by the opponent is irrelevant.

22. I note the following from the opponent’s evidence:

- a) The opponent first sold its goods in the UK in 2004.
- b) The opponent sells a wide range of goods, but slippers are “the most renowned products” of the opponent.
- c) There are examples of the word SHEPHERD in use as registered, but the mark also appears as follows:<sup>2</sup>

---

<sup>2</sup> Exhibit SM04



- d) A brochure dated 2015 confirms that the opponent's goods were available for sale in Norway, Sweden, Denmark, Finland, Estonia, Latvia, Lithuania, Germany, the UK, the Netherlands, Belgium, Austria, France, Italy and Belgium.<sup>3</sup>
- e) There are examples of the opponent's goods displaying labels bearing the word SHEPHERD in a catalogue dated 2016:<sup>4</sup>



- f) There are examples of men's slippers and women's slippers in the opponent's brochures dated 2018.<sup>5</sup>
- g) During the relevant period, the opponent has attended trade fairs in the UK, Denmark and Sweden.

---

<sup>3</sup> Exhibit SM05

<sup>4</sup> Exhibit SM08

<sup>5</sup> Exhibits SM14 and SM15

- h) During the relevant period, the opponent has had physical premises in Sweden, Germany, Norway, Finland and Denmark.<sup>6</sup> Branding at those premises appears as follows:



- i) The opponent has also sold through UK-based online retailers during the relevant period.<sup>7</sup> All of these web pages display either exclusively slippers or footwear, including slippers.
- j) The opponent's turnover figures are as follows:

2015	€6.5million
2018	€9.6million
2021	€12.7million

These figures are not broken down by product type.

- k) I note that one UK-based retailer sold over SEK600,000 in 2016, over SEK800,000 in 2017 and 2018, over SEK400,000 in 2019 and SEK800,000 in 2020.<sup>8</sup> Again, no breakdown is given by product type. In GBP this translates to a total of approximately £500,000.
- l) As of 20 December 2022, the opponent had over 17,000 followers on Instagram, 12.5% of which were from the UK.

23. Clearly, the opponent's mark has been used as registered, such as on the label shown at paragraph **22(e)** above. I also agree with Mr Traub's submission that the use shown in paragraphs **22(c)** and **(h)** is use of the mark as registered. The word

---

<sup>6</sup> Exhibit SM20

<sup>7</sup> Exhibit SM23

<sup>8</sup> Exhibit SM24

SHEPHERD appears in both and continues to indicate origin.<sup>9</sup> The addition of descriptive words such as “OF SWEDEN” and “SWEDEN 1982” do not impact this, nor does the addition of the device. Consequently, this is all use upon which the opponent can rely.

24. There are clearly issues with the opponent’s evidence in that its turnover figures are not broken down by product type. This makes it difficult for me to assess what proportion of those figures relate to the goods for which the opponent is required to demonstrate genuine use i.e. slippers. However, I must look at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.<sup>10</sup> Mr Mårdh’s narrative evidence is that slippers are the opponent’s most “renowned” product, and they appear frequently in product catalogues and websites throughout the relevant period. In my view, the evidence is sufficient to establish that the opponent has made genuine use of its mark in relation to slippers during the relevant period.

### **Section 5(2)(b) – case law**

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

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to

---

<sup>9</sup> *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

<sup>10</sup> *New Yorker SHK Jeans GmbH & Co. KG v OHIM*, Case T-415/09

make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

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

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### Comparison of goods and services

26. In light of my findings above, the competing goods and services are as follows:

Opponent's goods	Applicant's goods and services
<p><u>Class 25</u> Slippers, slippers.</p>	<p><u>Class 25</u> Footwear, excluding slippers; belts [clothing].</p> <p><u>Class 35</u> Online retail store services for footwear, belts, and shoe care products including shoe brushes, shoe cloths, shoe cream, shoe laces, shoe trees, and shoe wax; none of the aforesaid retail services related to slippers.</p>

27. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

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

28. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

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

29. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

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

30. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity

between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

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

31. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

## Class 25

*Footwear, excluding slippers.*

32. The opponent’s goods are not identical to those of the applicant because the opponent’s goods are expressly excluded from the applicant’s specification. However,

they will still overlap in nature, all being footwear, and method of use. The purpose of the goods will also overlap to the extent that they are intended to protect the feet, albeit they may differ to the extent that the opponent's goods are specifically for indoor use only, whereas the applicant's goods are more likely to be for outdoor use. The user of the goods will clearly overlap. I also consider it likely that the goods will be sold through the same trade channels, as businesses that sell slippers are also likely to sell other types of footwear. There is not likely to be any meaningful competition between the goods, given that the applicant's goods are for outdoor use and the opponent's goods are for indoor use. They will also not be complementary as one is not important or indispensable for the other. Taking all of this into account, I consider the goods to be similar to a high degree.

#### *Belts [clothing].*

33. These goods will plainly differ in nature, purpose and method of use with the opponent's goods. However, there will remain an overlap in user. There is also likely to be an overlap in trade channels as businesses that sell footwear (including slippers) are also likely to sell clothing and clothing accessories (including belts). I do not consider the goods to be in competition or complementary. Taking all of this into account, I consider them to be similar to between a low and medium degree.

#### Class 35

*Online retail store services for footwear, belts, and shoe care products including shoe brushes, shoe cloths, shoe cream, shoe laces, shoe trees, and shoe wax; none of the aforesaid retail services related to slippers.*

34. Plainly, these services will differ in nature, purpose and method of use with the opponent's goods. However, there will remain an overlap in user. I also consider that the same businesses that sell slippers are also likely to sell other types of footwear, clothing and clothing accessories (as well as replacement parts and maintenance products for those goods) and are likely to offer retail services in relation to the same. For example, a footwear retailer might very well sell both slippers and shoe cream, used for maintaining other types of shoe (such as leather boots). There is no

competition or complementarity. Taking all of this into account, I consider the goods and services to be similar to between a low and medium degree.

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

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

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

36. Ms Blythe and Mr Traub agreed that:

- a) The average consumer is a member of the general public.
- b) A medium (or average) degree of attention is likely to be paid during the purchasing process.
- c) The purchasing process will be predominantly visual, although I should not discount an aural component to the purchase.

37. I agree entirely and will proceed on that basis.

## Comparison of trade marks

38. It is clear from *Sabel* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

40. The respective trade marks are shown below:

<b>Opponent's trade mark</b>	<b>Applicant's trade mark</b>
SHEPHERD	WOLF & SHEPHERD

41. The opponent's mark consists of the word SHEPHERD. There are no other elements to contribute to the overall impression, which lies in the word itself. The applicant's mark consists of the words/sign WOLF & SHEPHERD. These are likely to be seen as a unit, referring to two individuals with the surnames WOLF and SHEPHERD. Even if they are not seen as names (which I consider very unlikely when

used in this way) but are seen as the animal and someone who cares for sheep, the mark would still form a unit. I consider the overall impression of the mark lies in the combination of these words.

42. Visually, the marks coincide in the presence of the word SHEPHERD. They differ in that the word SHEPHERD is preceded by the word/sign WOLF & in the applicant's mark. I bear in mind that the beginnings of marks tend to make more of an impact than the ends.<sup>11</sup> I consider the marks to be visually similar to no more than a medium degree.

43. Aurally, the word SHEPHERD will be pronounced identically in both marks. However, the pronunciation of the word/sign WOLF & will act as a point of aural difference. I consider the marks to be aurally similar to no more than a medium degree.

44. Conceptually, I consider the words SHEPHERD and WOLF most likely to be seen as referring to surnames when used together in this way. Consequently, the applicant's mark is likely to be understood as referring to two individuals by the names of WOLF and SHEPHERD. The opponent's mark may also be understood as referring to the surname SHEPHERD (although it may be seen as referring to someone who cares for sheep). If it is viewed as a surname, which is the opponent's best case on conceptual similarity, the marks will be conceptually similar to a medium degree.

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

45. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the Court of Justice of the European Union ("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

---

<sup>11</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-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 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).”

46. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods and services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

47. As explained above, the word SHEPHERD, when used on its own, may be viewed as either a surname or a dictionary word referring to someone who cares for sheep. The opponent submits that the latter is more likely and has filed evidence to show that the most common searches for the word SHEPHERD on Google relate to dogs (such as German Shepherds).<sup>12</sup> However, the exhibit in question simply lists the number of times that the word SHEPHERD has been searched and returns “related topics” and “relates queries” under which dog-based topics appear. I do not consider this to be conclusive. In any event, I do not consider the nature of Google searches and the results they return to be indicative of the understanding of the average consumer. Further, I do not consider that the two possible interpretations of the opponent’s mark are mutually exclusive; the average consumer is likely to understand that the word

---

<sup>12</sup> Exhibit ST02

SHEPHERD can be used to refer to someone who cares for sheep but is also a surname. Ms Blythe suggested that where the mark refers to someone who cares for sheep it is likely to be seen as allusive of goods which are made of sheepskin. In my view, this is simply too tenuous a connection to expect the average consumer to make and I do not consider that the earlier mark can be viewed as allusive on that basis.

48. Where the earlier mark is viewed as a surname, it is important to bear in mind how unusual (or common) the name is.<sup>13</sup> However, I bear in mind that it is not necessarily decisive.<sup>14</sup> The parties have both filed evidence on this point. The applicant has filed a copy of *The Oxford Dictionary of Family Names in Britain and Ireland* from 2016.<sup>15</sup> This shows that at that time, there were over 28,000 people in the UK with the surname SHEPHERD. In addition, there were almost 20,000 people who had a name pronounced in the same or very similar way (e.g. SHEPPARD, SHEPPERD, SHEPARD etc.). The opponent has also filed evidence from the same publication, it is not clear from which year, that confirms the prevalence of other names. These are CLARK (including the variant CLARKE) which was held by over 200,000 people, HUDSON which was held by over 32,000 people and WILLS which was held by over 10,000 people.<sup>16</sup> It is not clear whether the position would have been any different in relation to any of these names as at the relevant date. I accept, of course, there are more common names (CLARKE or CLARK being one). However, I do not consider SHEPHERD to be an unusual name and, in my view, it is relatively common. I consider that the average consumer is likely to perceive this name as being more common than perhaps it is because of the prevalence of other names that are pronounced so similarly, by virtue of the various spellings available. In my view, the earlier mark is inherently distinctive to either between a low and medium degree or a medium degree, depending on how it is perceived.

49. Mr Traub indicated at the hearing that he accepted that the evidence did not support a finding that the distinctiveness of the opponent's mark has been enhanced through use. I agree. The turnover figures are not broken down to enable me to

---

<sup>13</sup> *Harman International Industries, Inc v OHIM*, Case C-51/09P

<sup>14</sup> *Nichols Plc v Registrar of Trade Marks*, C-404/02

<sup>15</sup> Exhibit DG1

<sup>16</sup> Exhibit ST06

determine what proportion of sales relate to the UK (which is the relevant market for assessing enhanced distinctiveness). There is some further detail provided on this which shows the sales made by two UK retailers. These amount to approximately 2.8million in 2020, 1.4million in 2019, 1.8million in 2018, 1.5million in 2017, 800,000 in 2016 and 1.2million in 2015. These figures are given in SEK (Swedish Krona) which converts to approximately £200,000 for 2020, £100,000 in 2019, £135,000 in 2018, £100,000 in 2017, £60,000 in 2016 and £90,000 in 2015. I note that no breakdown is provided to enable me to identify what proportion of these figures relate to the goods relied upon. However, even if I proceeded on the assumption that they all related to slippers, this would be a relatively low turnover given the size of the UK market for such goods, which is undoubtedly large. I have no overall advertising and marketing expenditure, and very little information about promotional activities undertaken in the UK other than social media posts and trade fairs. I accept that the opponent sells through a number of online retailers in the UK, but I have limited evidence about when these retailers began selling the opponent's goods (other than a handful of screenshots relating to a limited number of retailers to show that their websites displayed the opponent's goods during the relevant period). Taking the evidence as a whole into account, I am not satisfied that the evidence establishes that the distinctiveness of the earlier mark has been enhanced through use.

### **Likelihood of confusion**

50. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing act. In doing so, I must be alive to the fact that the average

consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

51. I have found as follows:

- a) The goods and services vary from being highly similar to similar to between a low and medium degree.
- b) The average consumer is a member of the general public who will pay a medium (or average) degree of attention during the purchasing process.
- c) The purchasing process for the goods will be predominantly visual, although I do not discount an aural component to the purchase.
- d) The marks are visually and aurally similar to no more than a medium degree and conceptually similar to a medium degree.
- e) The earlier mark is inherently distinctive to a low to medium degree.

52. Bearing in mind the differences between the marks, I do not consider it likely that they will be mistakenly recalled or misremembered as each other. I do not consider that the word/sign WOLF & in the applicant's mark will be overlooked. This is the case even accounting for the principle of imperfect recollection and where the marks are used on highly similar goods. There is no likelihood of direct confusion.

53. I will now consider whether there is a likelihood of indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the

other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'.

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

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

54. I do not consider that the first category applies. Even where the earlier mark is inherently distinctive to a medium (or average) degree, I do not consider that it can be said to be so strikingly distinctive that the average consumer would assume that no-one except the opponent could be using it. It is an ordinary dictionary word and relatively common surname. I also do not consider that the second category applies. The addition of the word/sign WOLF & cannot be said to be a non-distinctive element.

I also do not consider the third category applies. The earlier mark does not comprise a number of elements, and the addition of the word/sign WOLF & does not appear to me to be logical and consistent with a brand extension.

55. There is no express pleading relying on the *Medion* case.<sup>17</sup> However, even if there was, it would not assist the opponent. Firstly, I have found the applicant's mark forms a unit, meaning that the word SHEPHERD does not retain an independent distinctive role within that mark. Secondly, even if I am wrong in that finding, I must still be satisfied on making a global assessment that there would be a likelihood of confusion.<sup>18</sup> In this case, I do not find that there would be. The opponent's mark is not particularly distinctive, and I can see no reason why the average consumer would make a connection with the opponent, rather than just viewing the use of the word SHEPHERD in the marks as a coincidence in the use of a common surname. There is no real reason or explanation put forward by the opponent as to why the applicant's mark is likely to be seen as two different brands juxtaposed. It seems far more likely, in my view, that it will simply be seen as referring to two relatively common surnames, one of which just happens to coincide with the opponent's mark. As explained above, I consider it unlikely that the applicant's mark will be viewed as a reference to an animal and someone who cares for sheep (rather than two surnames). However, even if that is the case, it will still form a unit, and I can see no reason why the average consumer would believe that the marks originate from the same undertaking, rather than there just being a coincidence in the use of an ordinary dictionary word.

56. In reaching this decision I have borne in mind the opponent's references to previous decisions of this Tribunal, being *HUBBS & WILLS*, BL O/024/18 and *ELLIS & HUDSON* BL O/266/22 in which the earlier marks were WILLS and HUDSON respectively and a likelihood of confusion was found. In the first of these cases, the earlier mark was found to have a fairly high degree of distinctive character. Consequently, it is not on a par with the assessment that I am undertaking. In the second of these, the hearing officer was persuaded that the name HUDSON was relatively uncommon. I am, of course, not bound by decisions of other hearing officers;

---

<sup>17</sup> *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, C-120/04, EU:C:2005:594

<sup>18</sup> *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch)

I am considering an entirely different name here and must reach my own conclusions about its distinctiveness (as I have above).

57. I have also borne in mind Mr Traub's reference to the fact that the well-known fashion brand JACK WILLS has a sub-brand called AUBIN & WILLS. Even if that is correct, I have no evidence before me that it is common practice in the fashion industry for sub-brands to be formulated in this way. Even if it was, that is a sub-brand of a well-known mark benefitting from enhanced distinctiveness and a reputation. That is not the case for the opponent's mark, and I do not consider that any parallels can be drawn.

58. I am fortified in my finding that there is no likelihood of confusion by the case of *JACK & VICTOR*, in which a similar argument was made.<sup>19</sup> The hearing officer in that case found that there was no indirect confusion between the marks JACK & VICTOR and JACK. That decision was upheld on appeal.<sup>20</sup> Whilst each case must be decided on its own merits, very similar considerations appear to me to apply here.

59. I can see no other basis on which indirect confusion might arise. Consequently, I do not consider there to be a likelihood of indirect confusion.

60. The opposition based upon section 5(2)(b) of the Act is dismissed.

### **Section 5(4)(a)**

61. Section 5(4)(a) of the Act states as follows:

“5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

---

<sup>19</sup> BL O/0453/23

<sup>20</sup> BI O/0037/24

a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

aa)...

b) ...

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

62. Subsection (4A) of section 5 of the Act states:

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

63. I can deal with this ground relatively swiftly. At the hearing, Mr Traub accepted that this ground will stand or fall with the 5(2)(b) ground. I agree. Whilst the test for misrepresentation is different from that for likelihood of confusion in that it entails “deception of a substantial number of members of the public” rather than “confusion of the average consumer”, it has been acknowledged that they are unlikely to produce different outcomes in practice.<sup>21</sup> Certainly, I believe that to be the case here.

64. The opposition based upon section 5(4)(a) of the Act is dismissed.

## **CONCLUSION**

65. The opposition is unsuccessful, and the application may proceed to registration.

---

<sup>21</sup> *Marks and Spencer PLC v Interflora* [2012] EWCA (Civ) 1501

## **COSTS**

66. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of **£2,350**, calculated as follows:

Considering the Notice of opposition and preparing a counterstatement	£350
Preparing evidence and considering the opponent's evidence	£1,000
Preparing for and attendance at hearing	£1,000
<b>Total</b>	<b>£2,350</b>

67. I therefore order Shepherd of Sweden AB to pay Wolf & Shepherd, Inc. the sum of **£2,350**. This sum is to be paid within 21 days of the expiry of the appeal period, or if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 26<sup>th</sup> day of February 2024**

**S WILSON**  
**For the Registrar**