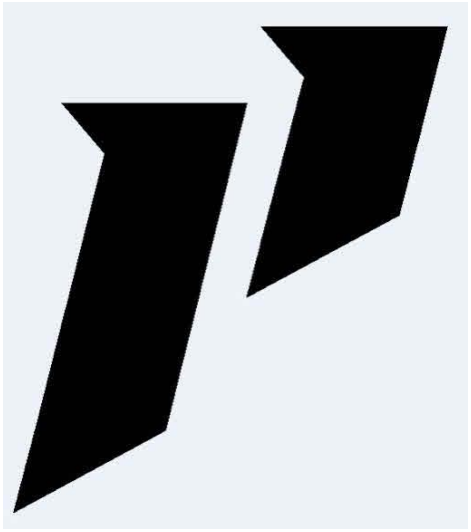
O/0146/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3871728
IN THE NAME OF 1ST PHORM INTERNATIONAL, LLC
TO REGISTER THE FOLLOWING TRADE MARK:



IN CLASSES 5, 9, 25, 29, 30, 32 & 41

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 440723
BY PEAK PERFORMANCE PRODUCTION AB

Background and pleadings

1. On 26 January 2023, 1st Phorm International, LLC ("the applicant") applied to register the trade mark shown on the cover page of this decision in the UK, under number 3871728 ("the applicant's mark"). The application claims a priority date of 8 August 2022 (USA).[1] Registration is sought for the following goods and services:

Class 5: Dietary supplements.

Class 9: Downloadable mobile application featuring customized fitness and nutrition plans, fitness and nutrition tracking, fitness and nutrition support, live streams featuring dietitians and fitness trainers, gym and at home workouts, and education content in the field of fitness and nutrition.

Class 25: Apparel.

Class 29: Nut butters; meat sticks consisting primarily of processed lean beef and pork.

Class 30: Protein bars.

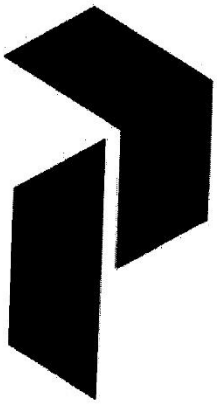
Class 32: Energy drinks.

Class 41: Educational services, namely, providing information about fitness and nutrition accessible by mobile application.

2. On 10 May 2023, Peak Performance Production AB ("the opponent") partially opposed the contested mark under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ("the Act"). The opposition under both grounds is directed at class 25 only.

[1] Whilst there are two separate priority claims, only one is relevant to these proceedings. This is because only one of the US applications from which the priority derives covers class 25 goods.

3. The opponent relies upon its UK trade mark number 800989616, which consists of the following:[2]



("the opponent's mark")

4. The opponent's mark was filed on 3 December 2008 and became registered on 7 December 2009. It claims a priority date of 3 July 2008 (Sweden). It stands registered for goods in classes 3, 9, 18 and 25. For the purposes the opposition, it only relies upon *clothing, footwear, headgear* in class 25.

5. The opponent's mark qualifies as an 'earlier mark' in accordance with section 6 of the Act. As it had been registered for more than five years at the priority date of the applicant's mark, it is subject to the proof of use requirements in section 6A of the Act.

6. Under section 5(2)(b), the opponent contends that the parties' goods are identical or similar and that the competing marks are similar. Based upon these factors, the opponent submits that there is a likelihood of confusion. The opponent also made a statement of use in respect of the goods relied upon.

7. As for section 5(3), the opponent claims that its mark has a reputation for *clothing, footwear, headgear*. It submits that this reputation is such that use of the applicant's mark for *apparel* would, without due cause, take unfair advantage of, and/or be

[2] UK trade mark no. 800989616 is a comparable mark based upon the opponent's International Registration designating the European Union no. 989616. On 1 January 2021, in accordance with the Withdrawal Agreement between the UK and EU, a comparable UK trade mark was automatically created. It is now recorded on the UK register, has the same legal status as if it had been applied for and registered under UK law, and retains its original filing date.

detrimental to, the repute and distinctive character of its mark. The opponent also contends that the relevant public would believe that the competing marks are used by the same undertaking or that there is an economic connection between them.

8. The applicant filed a counterstatement, denying the grounds of opposition. It also indicated that it would require the opponent to provide proof of use and of a qualifying reputation.

9. Only the opponent filed evidence. A hearing was requested and held before me, by video conference, on 15 May 2024. The opponent was represented by Thomas St Quintin of counsel, instructed by Osborne Clarke LLP. The applicant was represented by Lee Curtis of HGF Limited.

Relevance of EU law

10. 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.

Evidence

11. The opponent's evidence is given in the witness statement of Katarina Johannesson dated 6 November 2023. Her statement is accompanied by 14 exhibits (KSJ1-KSJ14). Ms Johannesson is the opponent's Vice President of Products, a position she has held since November 2022. She provides evidence of use of the opponent's mark.

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

Proof of use

13. Section 6A of the Act reads 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."

14. Pursuant to the above provisions, the relevant period for assessing whether there has been genuine use of the opponent's mark is the five-year period ending with the priority date claimed by the application at issue, i.e. 9 August 2017 to 8 August 2022.

15. As the opponent's mark is a comparable mark, it may rely upon use of the mark in the EU for any parts of the relevant period which fall prior to IP Completion Day, that being 31 December 2020.[3]

16. Moreover, section 100 of the Act states that:

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

[3] Part 1, Schedule 2A of the Act, paragraph 7

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

> "105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'*[2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].
>
> 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]."

18. 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 and services protected by the mark" is not, therefore, genuine use.[4]

19. Ms Johannesson gives evidence that 'Peak Performance' was founded in Sweden in 1986 to create activewear for outdoor sports. It has since expanded and is said to offer casualwear and accessories in addition to these core goods. The opponent, which is the owner of the 'Peak Performance' brand (including the opponent's mark), was acquired by Amer Sports Corporation ("Amer") in 2018, having previously been owned by IC Group A/S ("ICG"). Printouts from an article dated 2 February 2018 – regarding the purchasing of the brand for €255million by Amer – states that the brand generated sales of €145million in the preceding 12 months.[5] A photograph of a 'Peak Performance' storefront is included in the article, in which the opponent's mark can be seen in the signage. Ms Johannesson says that the store is in the EU.

20. According to Ms Johannesson, 'Peak Performance' products first became available in the UK in 2013. She says that UK users of the opponent's website are redirected to the UK version at peakperformance.com/gb. A selection of printouts from this website is in evidence. They were obtained via the Wayback Machine and, insofar

[4] *Intermar Simanto Nahmias v Nike Innovate C.V.,* BL O/222/16
[5] Exhibit KSJ1

as they are from within the relevant period, are dated between 1 September 2017 and 9 April 2022. They show items of menswear and womenswear for sale, including shirts, trousers, jackets, fleeces, hooded sweatshirts, hats, socks, jumpers, leggings, t-shirts and ski suits. The opponent's mark can be seen throughout, for example:

21. Information from Google Analytics and Adobe Analytics shows that the UK website had the following number of visits:

Year	Visits
2018	7,061,661
2019	8,713,247
2020	9,123,596
2021	10,380,996
2022	12,660,341
Total	47,939,841

22. Ms Johannesson says that the opponent's mark is used on the opponent's store fronts in the EU. In addition to the photograph referenced above at paragraph 19, a photograph of a 'Peak Performance' store has been provided.[6] The opponent's mark is prominently displayed. Ms Johannesson says this photograph was taken in Sweden, as part of the Fall/Winter 2019 campaign.

[6] Exhibit KSJ3

23. A report relating to this campaign in the EU is in evidence.[7] I note that the 'Live More' campaign page of the 'Peak Performance' website achieved nearly 35,000 sessions between 29 October and 20 December 2019. 41% of users were Swedish, whilst 12% were German. For the launch, they delivered 116,661 newsletters to Sweden (of which 58,033 were opened) and 21,905 to Germany (of which 11,502 were opened). The opponent's mark also featured in an Instagram TV post on 29 October 2019, which had over 9,000 views. Between 1 October 2019 and 2 December 2019, the opponent's Instagram page had between approximately 1,000 and 3,000 views per day. The opponent also posted videos on YouTube and Vimeo. The opponent's YouTube channel had 3.5million views, whilst its Vimeo account had 980 followers. I note that 'Peak Performance' also held 'brand movie' screenings in, *inter alia*, Austria, Germany and Switzerland in 2019, with a reach of around 2,000. It also appears that the brand featured in magazines (print and online) with a reach of around 650,000, and on third-party websites in banner form with a reach over 900,000. The report also details the opponent's social media activity for that year. I note that, in respect of targeting markets in Austria, Germany, Sweden and Switzerland, the opponent achieved a reach of 1.9million and 9.4million impressions.

24. A second marketing report, relating to a three-week EU campaign in Spring/Summer 2021, has also been provided.[8] This states that 730 products were sold via 29 stores in the EU and through the opponent's e-commerce site. The goods included jackets, vests and caps, with RRPs between €50 and €550. The opponent's mark can be seen on some of these goods in the report. Moreover, there is a report relating to the promotion of the 'Shielder Stretch' range of goods in Fall/Winter 2021.[9] I note that this campaign utilised paid media, both online and in print. In particular, I note that 'Peak Performance' goods, including some which feature the opponent's mark, appeared in paid articles and adverts in several German printed publications. Each had a reach of around 50,000.

25. Ms Johannesson says that, between 2015 and the beginning of 2021, the vast majority of 'Peak Performance' products were sold in the UK via the opponent's

[7] Exhibit KSJ4
[8] Exhibit KSJ5
[9] Exhibit KSJ6

exclusive distributor, Unify Brands Partnerships Ltd ("Unify"). A copy of the distributor agreement between ICG (UK) and Unify, signed by both parties in March 2015, has been provided.[10] The agreement confirms that Unify was to act as exclusive wholesale distributor of 'Peak Performance' products in the UK. Unify was not permitted to sell directly to consumers. A spreadsheet is in evidence which shows the net invoiced value of 'Peak Performance' products shipped to the UK.[11] Only two years in the spreadsheet relate to the relevant period: €712,283 in 2017 and €629,555 in 2018.

26. Ms Johannesson says that, roughly, a further £250,000 of 'Peak Performance' products were invoiced between August 2019 and January 2021. She confirms that the majority of 'Peak Performance' products display the opponent's mark. A selection of invoices demonstrating the purchase of 'Peak Performance' goods by Unify has been provided.[12] They are dated 18 February 2018 and 13 May 2019, and feature t-shirts, sweatshirts, leggings, skirts, shirts, outerwear, shorts, waistcoats, jeans, hats and headbands.

27. Having been assigned to the opponent from ICG (UK) ahead of Amer's acquisition, and then transferred to Amer (UK) thereafter, the decision was made not to extend the distributor agreement into 2021. This is documented in a press release in evidence.[13] It is Ms Johannesson's understanding that a key reason for this decision was the desire for 'Peak Performance' products to be sold directly in the UK, via retailers and the opponent's own stores.

28. According to Ms Johannesson, the first 'concept' or 'pop-up' store was launched in November 2018. It was located in Guildford, Surrey, and remained open until February 2019. In October 2019, a store at an alternative location in Guildford was launched. This remained open until 30 June 2021. An article from *Adventure 52*, dated 28 November 2019, details the opening of the store and contains a photograph of its exterior.[14] Further photographs of this second store are in evidence.[15] A store front,

[10] Exhibit KSJ7
[11] Exhibit KSJ8
[12] Exhibit KSJ9
[13] Exhibit KSJ10
[14] Exhibit KSJ11
[15] Exhibit KSJ12

with the ‘Peak Performance’ mark can be seen in the photographs, as can clothing such as jackets, shirts, t-shirts, leggings, hats and jumpers. The opponent’s mark can be seen on some of the goods, as shown in the examples below.

29. Ms Johannesson provides the following turnover figures for goods sold in the pop-up stores, as well as online after the closure of the second store on 30 June 2021:

Time period	Turnover (£)
1 May 2018 to 28 February 2019	98,558.00
1 September 2019 to 31 August 2020	131,482.00
1 September 2020 to 31 August 2021	158,704.51
1 September 2021 to 31 August 2022[16]	151,087.71
Total	539,832.22

30. In support of this narrative evidence, a spreadsheet entitled ‘Sales History UK Pop Ups’ has been provided.[17] It confirms Ms Johannesson’s account of these figures and the closing date of the second store.

31. According to Ms Johannesson, following the termination of the distribution agreement with Unify, all sales into the UK have been through Amer (UK). Example invoices, showing the “ship to” entity being the opponent and the “bill to” entity being

[16] I bear in mind that some of the turnover for this period may have been accrued after the end of the relevant period.
[17] Exhibit KSJ13

Amer (UK), are in evidence.[18] They are dated 22 September 2021. The goods listed in the invoices include hats, jackets, t-shirts, trousers, vests, shirts, socks and bags.

32. The evidence is not without its limitations. For instance, no details as to size of the relevant market or the share of that market held by goods bearing the opponent's mark have been provided and there is no evidence to that effect. Moreover, the opponent has not provided any indication as to the amounts spent on promoting its mark in the UK (or the EU prior to IP Completion Day) and there is no direct evidence of any promotional activities. I also note that the marketing reports from 2021 relate to the EU, which is not the correct territory for use after IP Completion Day.

33. Nevertheless, an assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole.[19] The evidence shows that goods bearing the opponent's mark featured on the UK 'Peak Performance' website during the relevant period and the website had several million visits each year. For most of the relevant period, these goods were sold in the UK by an exclusive distributor, which accrued around €1.5 million in wholesale. These turnover figures are supported by sales invoices and a spreadsheet. In addition to the distributor's sales, two pop-up stores in Guildford were in operation for part of the relevant period. Goods bearing the opponent's mark were presented for sale within the same. The evidence shows that the sale of 'Peak Performance' goods in the stores, as well as online, accrued over £530,000 in turnover during the relevant period.

34. The turnover figures, themselves, are not immune from criticism. As the applicant has highlighted, they have not been broken down by reference to the particular goods sold under the opponent's mark. However, the opponent is required to demonstrate genuine is in relation to, *inter alia*, the broad category of *clothing*. Ms Johannesson's narrative evidence is that the mark has been used in relation to these goods, and various types of clothing can be seen throughout the documentary evidence. The evidence, and the opponent's specification for that matter, does not include a wide range of disparate goods. As such, I do not consider the opponent's failure to break

[18] Exhibit KSJ14
[19] *New Yorker SHK Jeans GmbH & Co. KG v OHIM*, Case T-415/09

down the figures by reference to particular items of clothing to be fatal. It is also considered that Ms Johannesson states that the opponent's mark featured on the majority/most of the 'Peak Performance' goods sold during the relevant period. A more precise indication would have undoubtedly been helpful. Nevertheless, Ms Johannesson's narrative evidence has not been challenged. Even accounting for some of the turnover figures not being relevant to the present assessment, and even in the context of what is an extremely large market in the UK, it is my view that the turnover figures are indicative of an attempt to create a market in the UK for the opponent's goods during the relevant period.

35. Taking all of the evidence into account, I am satisfied that the opponent has demonstrated genuine use of its mark in the UK.

36. I now turn to determining a fair specification for the opponent's mark, based upon the use of the mark shown in the evidence. In Mr Curtis' skeleton argument he submitted that, in the event that the evidence is held to be sufficient to establish genuine use, the opponent's specification ought to be narrowed to the following list of goods:

> Class 25: Long sleeve jackets, jackets, hats, leggings, t-shirts, shorts, socks, jumpers, fleeces, sweatshirts, headbands, shirts, skirts, dresses, pants, waistcoats, tights, vests and hooded jackets.

37. Firstly, I agree with Mr Curtis that there is no evidence that any *footwear* has been sold under the opponent's mark. These goods may not be relied upon for the purposes of the opposition. As for *clothing* and *headgear*, I note that goods such as shirts, trousers, jackets, skirts, shorts, waistcoats, jeans, fleeces, sweatshirts, hooded sweatshirts, hats, headbands, socks, jumpers, leggings, t-shirts and ski suits appear in the evidence. I remind myself that fair protection is not to be achieved by identifying and defining particular examples of goods for which there has been genuine use but, rather, the particular categories of goods they should realistically be taken to exemplify.[20] I must consider how the average consumer would fairly describe the

[20] *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited,* BL O/345/10

goods shown in evidence; the task is not to describe the use made by the opponent's mark in the narrowest possible terms, unless that is what the average consumer would do.[21] It is my view that the average consumer would fairly describe the goods shown in evidence as *clothing* and *headgear*, and I find that the range of goods shown in evidence is sufficient to retain protection for these broad categories.

38. In light of the above, I find that the opponent may rely upon the following specification for the purposes of the opposition:

> Class 25: Clothing, headgear.

Section 5(2)(b)

Legislation and case law

39. Sections 5(2)(b) and 5A of the Act read as follows:

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

[21] *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch)

trade mark is applied for, the application is to be refused in relation to those goods and services only."

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

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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

41. In its counterstatement, the applicant concedes that its goods, namely *apparel*, are identical to the opponent's *clothing*.

42. Even if I was wrong to find that the opponent's evidence is sufficient to retain protection for the broad category of *clothing*, the parties' goods would still be identical. This is because the law requires that goods be considered identical where one party's description of its goods encompasses the specific goods covered by the other party's description (and vice versa).[22] The specific items of clothing shown in evidence (and

[22] *Gérard Meric v OHIM,* Case T-33/05

those suggested in Mr Curtis' skeleton argument) all fall within the scope of the applicant's *apparel*.

The average consumer and the nature of the purchasing act

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

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The […] 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."

44. The goods at issue in these proceedings are ordinary purchases consisting of items of clothing. The average consumer of such goods is a member of the general public. The goods are likely to be purchased relatively frequently. Their cost may range from inexpensive items such as socks at one end of the spectrum, to more expensive fashion pieces at the other. However, the purchasing process will not involve an overly considered thought process as, overall, they are relatively inexpensive. That being said, the average consumer will consider factors such as the style, quality, size and compatibility with other items when making a selection. In light of this, I find that the average consumer will demonstrate a medium level of attention during the purchasing process. The goods are typically sold in physical retail establishments and their online equivalents, where the goods are likely to be self-selected from rails and shelves or after viewing information on the internet. In these circumstances, visual considerations

will dominate.[23] However, I do not exclude aural considerations in the form of word-of-mouth recommendations or discussions with sales assistants.

Distinctive character of the earlier mark

45. In *Lloyd Schuhfabrik Meyer*, 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 undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *WindsurfingChiemsee*, paragraph 51)."

46. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods, to those with high inherent distinctive character, such as invented words. The

[23] As was held by the General Court in *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03.

degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion. The distinctive character of a mark may be enhanced as a result of it having been used in the market.

47. The opponent's mark is figurative and consists of two geometric shapes. It is my view that, due to the particular arrangements of the shapes, a significant proportion of consumers will perceive the opponent's mark as a stylised letter 'P'. Although there are likely to be consumers who do not identify the letter and, for instance, simply view the mark as two geometric shapes, I will focus on those who do for the purposes of determining this ground. The letter 'P' does not appear to be descriptive or allusive of the goods relied upon. However, given that there is a propensity for many undertakings to adopt letters as indicators of trade origin, the letter 'P' is not particularly distinctive. In my view, the opponent's mark possesses no more than a medium level of inherent distinctive character. I should add that the distinctive character of the mark is largely attributable to its particular graphic representation, not the letter *per se*.

48. Although it has not been expressly pleaded, evidence has been filed by the opponent and, therefore, I am now required to determine whether it has demonstrated that its mark had an enhanced distinctive character at the relevant date of 8 August 2022.

49. I have already assessed the evidence above and found that it demonstrates genuine use of the opponent's mark in the five years preceding the relevant date. However, the burden for establishing enhanced distinctive character is a much heavier one, in that it requires a level of knowledge of the mark amongst average consumers leading to the mark having a greater capacity to identify the goods as coming from a particular undertaking, not simply that there has been an attempt to create or maintain a market for goods under the mark.

50. The opponent's evidence indicates that its mark was displayed on its UK website for several years before the relevant date, with several millions of views per annum. Moreover, Ms Johannesson's unchallenged evidence is that 'Peak Performance' goods were first available in the UK in 2013. Therefore, use had been relatively

longstanding. The wholesale of 'Peak Performance' goods accrued around €2.9 million between 2013 and the relevant date, whilst the opponent's pop-up stores and online sales generated another £530,000. As previously indicated, Ms Johannesson does not say that these turnover figures relate exclusively to goods bearing the opponent's mark; she confirms that the majority/most of them would have been. Therefore, the relevant turnover figures must have, in fact, been lower. Without market share information, or even specific turnover figures, it is difficult to ascertain how significant the sales of goods bearing the opponent's mark were before the relevant date. However, even when taken at their highest, the figures do not strike me as indicative of intensive use of the mark. This is particularly the case, given how large the clothing market in the UK must be. I note that there is no evidence of the amounts the opponent spent on promotional activities in the UK prior to the relevant date. There is evidence from social media, but there is no way of ascertaining, for instance, how many of the opponent's Instagram, YouTube or Vimeo followers were based in the UK. The evidence relating to non-UK activities (i.e. those in other Member States of the EU before IP Completion Day) does not assist the opponent either; this assessment is undertaken from the perspective of UK consumers. On the balance of all the evidence, I am not satisfied that the distinctive character of the opponent's mark had been enhanced above its inherent characteristics at the relevant date.

Comparison of trade marks

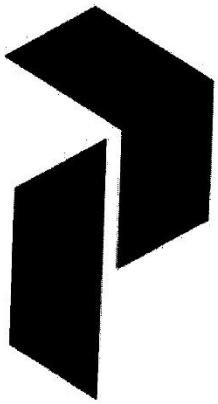
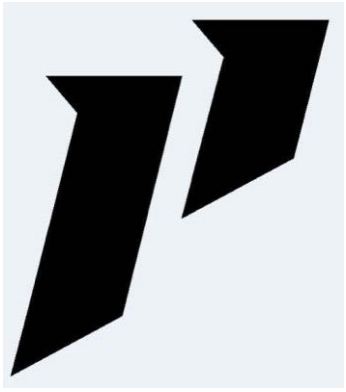
51. It is clear from *Sabel* that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created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

52. Therefore, it would be wrong to dissect the trade marks artificially, though it is necessary to take into account the distinctive and dominant components of the marks; due weight must be given to any other features which are not negligible and hence contribute to the overall impressions created by the marks.

53. The marks to be compared are as follows:

The opponent's mark	The applicant's mark
	

54. At the hearing, Mr St Quintin and Mr Curtis both made submissions as to how the competing marks would be perceived by the average consumer and the similarity (or otherwise) between them. Similar comments were made in the parties' pleadings. I will not reproduce these but confirm that I have taken them into account in making the following assessment.

55. The parties' marks consist of two geometric shapes. I have already found that a significant proportion of consumers are likely to perceive the opponent's mark as a stylised letter 'P'. Whilst there are other possibilities, due to the way in which the shapes are configured, it is my view that this is equally applicable to the applicant's mark. In respect of each mark, the letter 'P' and the way in which it is presented will dominate the overall impression.

56. Visually, the competing marks are similar in that they both comprise two geometric shapes presented in a single colour. In both marks, one of the shapes is offset to the top right of the other. As wholes, both will be perceived as representations of the letter 'P'. Whilst I acknowledge that visual similarity does not automatically follow where two marks share representations of the same thing,[24] it is my view that there are stylistic commonalities between the letters in this instance. The competing marks are visually different in that the particular shapes used are somewhat different. Moreover, the alignment of the shapes differs (roughly vertical in the opponent's mark and more diagonal in the applicant's mark). Bearing in mind my assessment of the respective overall impressions, I find that there is between a medium and high degree of visual similarity between the competing marks.

57. In situations where the marks are perceived as representations of the letter 'P', both marks will be articulated as such (in the ordinary way). For these consumers, the competing marks are aurally identical.

58. For a conceptual message to be relevant, it must be capable of immediate grasp.[25] The letter 'P' does not convey any clear and obvious meaning which could be discerned by the average consumer, over and above its mere existence as a letter in the alphabet. In my view, as neither of the marks has any real semantic content, the conceptual position is, effectively, neutral. It is arguable whether common use of the same letter should, in the absence of any other meanings, render the marks conceptually identical. However, I will proceed on the basis of my primary finding (conceptual neutrality) and return to consider the impact of the marks being conceptually identical, should it become necessary to do so.

Likelihood of confusion

59. 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. One such factor is the interdependency principle, i.e. a lesser degree

[24] *The Royal Academy of Arts v Errea Sport S.P.A.*, BL O/010/16
[25] *The Picasso Estate v OHIM*, Case C-361/04 P

of similarity between the competing marks may be offset by a greater degree of similarity between the respective goods, and vice versa. As mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be mindful 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 they have retained in their mind.

60. 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 down to the responsible undertakings being the same or related.

61. Earlier in this decision, I concluded that:

- The parties' goods are identical;

- The average consumer is likely to be a member of the general public, who will demonstrate a medium level of attention;

- The purchasing process is predominantly visual in nature, though aural considerations have not been discounted;

- The opponent's mark has a medium level of inherent distinctive character;

- For a significant proportion of consumers, the overall impression of each mark is dominated by the letter 'P' and the way in which it is presented;

- The competing marks are visually similar to between a medium and high degree and aurally identical, whilst the conceptual position is neutral.

62. I acknowledge that there are differences between the competing marks. As previously outlined, the shapes are not precisely the same and neither is their alignment. Nevertheless, considering the overall levels of visual and aural similarity between the competing marks, the identity between the parties' goods, and the distinctiveness of the opponent's mark, it is my view that the differences between the marks may not be sufficient to distinguish the applicant's goods from those of the opponent. The competing marks will be perceived by a significant proportion of consumers as representations of the same letter ('P') presented in a similar manner, i.e. in two parts made up of angular geometric shapes. The slight differences in, for instance, the alignment or the specific design features of the shapes, may, when viewing the competing marks as wholes, go unnoticed by the average consumer. In consideration of all the above, and factoring in the principles of imperfect recollection and interdependency, it is considered that the average consumer, paying no more than a medium level of attention, may not recall the competing marks with sufficient accuracy to differentiate between them. Consequently, I find that there is a likelihood of direct confusion.

63. I acknowledge that, in reaching this conclusion, I have only considered the significant proportion of average consumers who identify the letter 'P' in the competing marks. Whilst there are other ways in which the competing marks may be perceived, it is not necessary to establish that all actual or potential consumers of the relevant goods are likely to be confused; a likelihood of confusion amongst a significant part of the relevant public is sufficient.[26]

Conclusion

64. The opponent's claim under section 5(2)(b) is successful.

[26] See *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41 and *Soulcycle Inc v Matalan Ltd* [2017] EWHC 496 (Ch).

Section 5(3)

Legislation and case law

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

> "(3) A trade mark which-
>
> is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark".

66. Section 5(3A) states:

> "(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected".

67. As the opponent's mark is a comparable mark, paragraph 10 of Part 1, Schedule 2A of the Act is relevant. It reads:

> "(1) Sections 5 and 10 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.
>
> (2) Where the reputation of a comparable trade mark (EU) falls to be considered in respect of any time before IP completion day, references in sections 5(3) and 10(3) to-
>
> (a) the reputation of the mark are to be treated as references to the reputation of the corresponding EUTM; and
>
> (b) the United Kingdom include the European Union."

68. The effect of these provisions is that, when considering whether the opponent has established that its mark has a reputation, evidence of use in the EU until IP Completion Day is to be taken into account. Thereafter, any continuing reputation of the mark is to be based upon use of the mark in the UK. [27]

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

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

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

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

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

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph*

[27] For further information, see article 54 of the Withdrawal agreement and Tribunal Practice Notice 2/2020.

68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79.*

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

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

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

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

70. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that its mark is similar to the applicant's mark.[28] Secondly, the opponent must show that its mark has achieved a level of knowledge, or reputation, amongst a significant part of the public. Thirdly, the opponent must establish that the public will make a link between the marks, in the sense of its mark being brought to mind by the applicant's mark. Finally, assuming the foregoing conditions have been met, section 5(3) requires that one or more types of damage claimed by the opponent will occur. It is not necessary for the purposes of section 5(3) that the goods are similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

71. The relevant date for the assessment under this ground is the priority filing date of the applicant's mark, that being 8 August 2022.

Reputation

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

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

[28] Given my findings at paragraphs 56-58, this condition is satisfied.

> 28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

73. At the hearing, Mr St Quintin submitted that proving a reputation is not a particularly onerous task. I take this to be a reference to the comments of Arnold J (as he then was) in *Enterprise Holdings Inc. v Europcar Group UK Ltd.* [2015] EWHC 17 (Ch). It is important to note that the evidence before Arnold J in that case showed that the claimant was the market leading car hire company in the UK with a 30% share of the market. It was in that context that it was said that proving a reputation "is not a particularly onerous requirement". Arnold J had no reason to turn his mind to situations where a claimant has only a small or unquantified share of the relevant market. In *Sacentro – Cinercio de Texteis SA v Michael Codd*, BL O/360/20, Professor Phillip Johnson, sitting as the Appointed Person, stated to the effect that it is not the case that a party who has filed only weak, incomplete, or irrelevant evidence to establish a reputation should be given the benefit of the doubt at the expense of the other party. The reason it is not an onerous requirement is because collecting the evidence should be straightforward (even if time consuming) where a mark has the necessary reputation.

74. I have already assessed the opponent's evidence above. For the same reasons as given at paragraph 50, I am unable to conclude that the opponent's mark had a qualifying reputation in the UK at the relevant date.

75. Turning to the EU, I note that 'Peak Performance' was founded in Sweden in 1986 and there is evidence of the mark being used on store fronts in the EU. Moreover, I acknowledge the information contained in the 'Live More' EU campaign report (Fall/Winter 2019), such as, for instance, the newsletters sent to customers in Sweden, the website visits from Swedish and German internet users, the brand screenings, and the social media marketing in Austria, Germany, Sweden and Switzerland. However, no turnover figures or information about the market share held by the opponent's mark

in these territories have been provided.[29] There is no evidence as to the amounts spent on advertising in these territories, or any other parts of the EU. The evidence is also not focused on a particular part of the EU; for instance, turnover figures are provided for the UK, but not for Germany or Austria, for example, whilst details of marketing have been provided for some of the EU but not the UK. The evidence appears to have different features for different parts of the EU which does not, whether in isolation or in combination, constitute sufficient use in either a Member State or an otherwise substantial part of the EU. Taking all of the evidence into account, I do not consider it to be sufficient to establish that the opponent's mark had a reputation in the EU prior to IP Completion Day.

Conclusion

76. The opponent's claim under section 5(3) is dismissed.

Overall outcome

77. The partial opposition, insofar as it is based upon section 5(2)(b) of the Act, has been successful. Subject to a successful appeal against this decision, registration of the applicant's mark will be refused in respect of *apparel* in class 25. The applicant's mark will proceed to registration in the UK for the following goods and services, which were not opposed:

Class 5: Dietary supplements.

Class 9: Downloadable mobile application featuring customized fitness and nutrition plans, fitness and nutrition tracking, fitness and nutrition support, live streams featuring dietitians and fitness trainers, gym and at home workouts, and education content in the field of fitness and nutrition.

[29] I note that the 'Peak Performance' brand is said to have generated sales of €145million in the year preceding its acquisition by Amer in 2018. However, this is a global figure not broken down by reference to whether it relates to goods bearing the opponent's mark or the relevant territory/territories.

Class 29: Nut butters; meat sticks consisting primarily of processed lean beef and pork.

Class 30: Protein bars.

Class 32: Energy drinks.

Class 41: Educational services, namely, providing information about fitness and nutrition accessible by mobile application.

Costs

78. The opponent has been successful and is entitled to a contribution towards its costs. It was common ground at the hearing that costs in these proceedings ought to be awarded by reference to the ordinary scale. These proceedings commenced after 1 February 2023 and, therefore, the relevant scale is that published in Tribunal Practice Notice 1/2023. In the circumstances, I award the opponent the sum of **£2,200** which is calculated as follows:

Preparing a statement and considering the applicant's counterstatement	£300
Preparing evidence	£1,000
Preparing for and attending the hearing	£800
Official fees[30]	£100
Total	£2,200

[30] Although the opponent paid £200 in official fees when filing its Form TM7, it only succeeded in its claim under section 5(2)(b). As such, I have awarded official fees in line with filing an opposition under this ground only.

79. I hereby order 1st Phorm International, LLC to pay Peak Performance Production AB the sum of **£2,200**. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of the proceedings if any appeal against this decision is unsuccessful.

Dated this 18th day of February 2025

James Hopkins
For the Registrar