O/0214/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003877917
BY DARREN MOORE
TO REGISTER:

AS A TRADE MARK IN CLASS 25

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 440987 BY
MICHAEL ROY PHILLIPS TRADING AS SCORE DRAW

BACKGROUND AND PLEADINGS

1. On 14 February 2023, Darren Moore ("the applicant") applied to register the trade marks shown on the cover of this decision in the UK (the applicant's mark) for the following goods:

Class 25: Sportswear; Casualwear; Ready-to-wear clothing; Knitwear [clothing]; Clothing for sports; Sports clothing; Sports footwear; Sports garments; Athletic clothing; Jackets being sports clothing; Footwear for sport; Athletic footwear; Men's clothing; Menswear; Triathlon clothing; Leisurewear; Leisure footwear; Outerwear; Clothing for cycling; Sports clothing [other than golf gloves]; Gymwear; Moisture-wicking sports shirts; Leisure clothing; Clothes for sports; Clothing; Denims [clothing]; Surfwear; Shorts [clothing]; Jerseys [clothing]; Sports shirts; Casual clothing; Clothes for sport; Clothing for leisure wear; Clothing for gymnastics; Beach footwear; Sport shirts; Knitwear; Swimwear; Jackets [clothing]; Moisture-wicking sports pants; Woolen clothing; Sports jackets; Windproof clothing; Parts of clothing, footwear and headgear; Golf clothing, other than gloves; Water-resistant clothing; Quilted jackets [clothing]; Articles of sports clothing; Knitted clothing; Jogging bottoms [clothing]; Embroidered clothing; Dance clothing; Tennis pullovers; Jogging sets [clothing]; Clothing for cyclists; Loungewear; Garments for protecting clothing; Sport shoes; Rainwear; Sports pants; Tennis shirts; Woven clothing; Moisture-wicking sports bras; Maillots [hosiery]; Linen clothing; Soccer shirts; Clothing for wear in judo practices; Sports jerseys and breeches for sports.

2. The applicant's mark was published for opposition purposes on 24 February 2023 and, on 24 May 2023, was opposed by Michael Roy Phillips trading as Score Draw

("the opponent"). The opposition is brought under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ("the Act") and is reliant upon the following trade mark:

SCORE DRAW
UK registration no. 902482115[1]
Filing date 28 November 2001; registration date 7 July 2003
Relying on some goods, which will be set out further below
("the opponent's mark").

3. Under the section 5(2)(b) ground, the opponent relies on "clothing", which sits in his mark's class 25 list of goods. In respect of the substance of the claim, the opponent argues that the marks are extremely similar and, as such, a consumer with imperfect recollection would struggle to differentiate between them. The opponent claims that the consumer would be inevitably confused between the marks if they are used for similar or identical goods.

4. In respect of his section 5(3) ground, the opponent claims to enjoy a reputation in "football shirts". While not an express term within his mark's specification, it is a suitable sub-category of the term for which it does stand registered. The opponent's claim under this ground is that his mark enjoys an extremely significant reputation in the UK for the manufacture and supply of football shirts. In light of this and the confusingly similar applied for mark, the opponent claims that the relevant public would understand the marks to be the same brand or related brands. As a result, the opponent claims that use of the applicant's mark would take unfair advantage of the opponent's reputation.

5. The applicant filed a counterstatement wherein he made a series of comments as to the merits of the opponent's case. I will not summarise these here but will simply

[1] The opponent's mark is a comparable mark based upon an earlier EUTM. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing EUTMs. These comparable marks enjoy the same filing and registration dates as their European counterparts.

confirm that the applicant denies the claims against it. Further, it is noted that the applicant made a proof of use request in respect of the opponent's mark.

6. The applicant is unrepresented and the opponent is represented by Serjeants LLP. Both parties filed evidence with the opponent also electing to file submissions in reply. No hearing was requested and both parties filed written submissions in lieu of the same.[2] This decision is taken after careful consideration of the papers.

7. 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

8. The opponent's evidence came in the form of a witness statement in his own name dated 6 November 2023. The opponent's statement is accompanied by 18 exhibits, being those labelled MRP1 to MRP18, and was filed in support of his claim to have used his mark and that his mark enjoys a reputation.

9. The applicant's evidence came in the form of a witness statement in his own name dated 3 March 2024. The applicant's statement is accompanied by eight exhibits, being those labelled DM1 to DM8. It covers a wide range of points and I note that this includes evidence as to the history of the applicant's brand, mention of other brands using the word 'SCORE' within them and a comparison of the products

[2] On this point, I note that the applicant sought to file submissions in reply to the opponent's submissions in lieu on 30 June 2024. However, it was confirmed to the parties via email on 2 July 2024 that these would form no part of the present proceedings.

offered by the parties. Additionally, it is noted that some of the narrative evidence provided by the applicant is submission as opposed to evidence of fact.

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

PRELIMINIARY ISSUES

11. As alluded to above, the applicant filed evidence that covers a range of points. For the most part, the points raised have no relevance to the proceedings (the same goes for the submissions filed by the applicant also). It is not appropriate for me to go through each and every point and dismiss them in turn. That being said, I do consider it necessary to discuss a sample of the points raised as preliminary issues and explain, briefly, why they are of no impact.

The opponent's failure to oppose other trade marks that include the word 'SCORE'.

12. At DM3 of his evidence, the applicant refers to three additional trade marks that include the word 'SCORE' that have previously been registered in the UK for goods in class 25. The applicant's point in respect of these other marks is that the opponent did not oppose them. He then suggests reasons as to why this was the case but goes on to state why the opponent is now opposing the applicant's mark. These reasons are purely speculative and cannot speak to the intention or motivation of the opponent. In any event, the decision to oppose or not oppose other marks is a decision for the opponent to make for whatever reasons he sees fit. The fact that he failed to oppose three other trade marks that included the word 'SCORE' in them for class 25 goods is of no consequence to the assessments I must make here and I will say no more about it.

13. In addition to the above and on a similar point, I note that there is also reference to a decision of this Tribunal (being BL O/219/06) wherein the opponent in the present case acted as an applicant for invalidity in another. An excerpt of the decision is provided at DM4. While this decision is noted, it was an invalidity action brought in reliance upon section 47(1) of the Act, citing sections 3(1)(b), 3(1)(c) and 3(6). Such grounds have no relevance here. Further, that application related to an entirely different trade mark which was said to be the former badge of the Brazil national football team. I fail to see how this has any relevance to the present case whatsoever. I will, therefore, say no more about it.

Comparison of the goods actually sold by the parties.

14. At DM6 of his evidence, the applicant discusses a comparison of the shirts produced by the two separate parties. The shirts shown are both West Ham shirts, with the SCORE DRAW version being labelled as 'unbranded' and the 'SCORELINE' version being branded as the 'authentic' version. The applicant then runs through the differences between the actual shirts, including the difference in fabric and colours used. While noted, this is not an issue for me to consider in the present case. The comparison between the goods at issue is to be based, in fact, on the concept of 'notional and fair use' which involves carrying out the comparison of the goods and services as they appear in the specifications before me, not the actual goods sold by the parties' themselves (and certainly not in relation to the quality or differing details of said goods).[3]

15. I note that this same exhibit goes on to discuss a hypothetical situation where the applicant claims that if West Ham, in 2024, were offered the applicant's branded shirts, they would, "100 times out of 100", select the 'SCORELINE' shirt over the 'SCORE DRAW' shirt. The applicant also claims that "100 times out of 100", the fans would reach the same conclusion. In short, this argument is purely speculative

[3] *O2 Holdings Limited & Anor v Hutchison 3G UK Limited,* Case C-533/06, paragraph 66

and has absolutely no relevance to the decision I must make in the present proceedings.

The average consumer of the parties being different.

16. In his narrative evidence, the applicant sets out that he sells directly to football clubs and not direct to the consumer.[4] As such, the applicant argues that there would never be an issue or an occasion where a consumer would be confused between the marks. While this may be the applicant's intention in how he retails his goods, it has no bearing on the decision I must make here. Similar to the point I have made above, the assessment of the average consumer must be based on the concept of 'notional and fair use' which involves carrying out an assessment based on the goods as they appear in the specifications before me. As there is nothing in the specification to suggest that the applicant's goods are those that will be aimed at certain consumers (and not others), this argument carries no weight. Instead, I will treat the goods in the applicant's specification as ordinary consumer goods that will reach the consumer in the usual way. I will discuss this in further detail when considering my average consumer assessment below.

DECISION

Proof of use

17. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

> "(6)(1) In this Act an "earlier trade mark" means –

[4] While not expressly stated, it is implied that this means that the opponent only sells direct to the consumer.

(a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired.

[…]

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered."

18. Section 6A is also relevant. It reads:

"(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."

19. Section 100 of the Act is also relevant. It reads:

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

20. As the opponent's mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

"7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A to the United Kingdom include the European Union".

21. Given its earlier filing date, the opponent's mark qualifies as an earlier trade mark under the above provisions. The opponent's mark completed its registration process over five years prior to the filing date of the applicant's mark. As set out above, the applicant requested that the opponent provide proof of use in respect of his mark. As a result, the opponent's mark is subject to the proof of use assessment.

22. 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]."

23. Section 6A of the Act (cited above) confirms that the relevant period for the present assessment is the five-year period prior to the filing date of the applicant's mark, being 14 February 2023. The relevant period is, therefore, 15 February 2018 to 14 February 2023 ("the relevant period").

24. As the opponent's mark is a comparable mark based upon an earlier EUTM, use of the same in the EU prior to IP Completion Day (being 31 December 2020) is relevant to the present assessment.[5] As a result, the relevant territory between 15 February 2018 and 31 December 2020 is the EU (which includes the UK as, at that time, it was a Member State) and between 1 January 2021 and 14 February 2023, the relevant territory is the UK only. On this point, I refer to the case of *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, wherein the Court of Justice for the European Union ("CJEU") noted that:

"It should, however, be observed that … the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase 'in the Community' is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use."

And

[5] See paragraph 4 of Tribunal Practice Notice 2/2020

"50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as 'genuine use', it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark."

25. Proven use of a mark which fails to establish that "the commercial exploitation of the mark is real"[6] because the use would not be "viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark" is, therefore, not genuine use.

26. I am of the view that I can deal with the issue of genuine use briefly. I say this because, in his own evidence (during his closing summary), the applicant states the following:

"Mr Phillips has a great business, which he has grown over the years and he has been in a very [privileged] position of having enjoyed a monopoly on this type of product for many years, within the lucrative top tier of English Football, with no real competition at all. He was the first company to introduce this type of programme into the football industry and on that basis has built a reputation that they were the go-to place for Retro shirts."

27. In my view, the above passage is a concession that the opponent has used his mark for retro football shirts for a number of years and that, as a result, he enjoys

[6] *Jumpman* BL O/222/16

a reputation in the mark relied upon. While the issue of reputation is not the same as the issue of genuine use, the assessment for considering reputation is significantly more onerous than the one for genuine use.[7] Therefore, if reputation is accepted, then it follows that genuine use is also accepted.

28. I appreciate that the above concession relates to football shirts as opposed to "clothing" at large, being the term relied upon under the section 5(2)(b) ground. However, in considering the evidence as a whole, it is clear that this is the sole focus of the opponent's business. On this point, I will say that the overwhelming majority of goods shown as being provided by the opponent in the evidence are football shirts.[8] While one image does include other goods (being a jacket and a jumper displayed in the window of the Chelsea Megastore),[9] the image itself also includes two retro football shirts, seemingly being those of the opponent. On this point, there is nothing before me to suggest that the goods shown in this display, other than the football shirts, are those of the opponent. Even if they were, this is just one example of use beyond football shirts which, in light of the clear focus of the remaining evidence, is not sufficient to warrant a finding that genuine use extends to any other goods.

29. Even if I was wrong to take the comments reproduced above as a concession, I am of the view that the opponent's evidence is, in any event, sufficient to warrant a finding of genuine use. I say this mainly because the evidence is clear in that the opponent has been selling football shirts throughout the relevant period and has provided turnover in respect of the same for the years 2018 to 2023. These are as follows:

[7] On this point, I remind myself that a finding of genuine use only requires a sufficient level of use (as per the case of *easyGroup* this need not be quantitively significant) whereas a finding of a reputation requires that the marks relied upon are known by a significant part of the relevant public in the relevant territory.
[8] See MRP2 and 3, MRP7 to 9 and MRP12 to 16
[9] See MRP11

Year	Turnover
2018 to 2019	3,839,450
2019 to 2020	5,020,180
2020 to 2021	7,441,437
2021 to 2022	11,117,887
2022 to 2023	11,753,551
Total:	**39,172,505**

30. While these figures are noted, there are two points I wish to raise. First, the narrative evidence of the opponent, at paragraph 32, confirms that he distributes licensed retro football shirts extensively in the UK, EU and worldwide. On this point, I note that the turnover referred to above is not confirmed as being UK or EU only (the latter being relevant prior to IP Completion Day) so I consider it plausible to suggest that it covers global sales figures. With no breakdown of the figures provided, it is not possible for me to determine how the turnover can be accurately attributed to the UK or the EU (prior to IP Completion Day). The second issue is that some of the figures provided from the years 2018 and 2023 are likely to have fallen outside of the relevant period and, therefore, a proportion of the totals for those years will be irrelevant for the present assessment. This is on the basis that the opponent has provided no indication as to what point in 2018 the turnover referred to above started accruing and what point in 2023 it ends. As such, it is reasonable to infer that some of the figures provided fall before 15 February 2018 and after 14 February 2023.

31. Even taking the issues in the preceding paragraph into account, I consider that even if only a proportion of the above turnover is attributable to the relevant territories during the relevant period, it will still be sufficient to demonstrate genuine use. On this point, I remind myself that, as set out above, use need not be quantitatively significant in order for it to be genuine. In my view, the turnover

provided, despite its deficiencies, is sufficient in order to demonstrate that the opponent, during the relevant period, had a clear intention to create or preserve a market share for the goods at issue.

32. Overall, if it cannot be said that the comments of the applicant in his evidence amount to a concession of genuine use, then the evidence I have briefly summarised above is sufficient to give rise to a finding that the opponent has genuinely used his mark in respect of "football shirts".

Section 5(2)(b): legislation and case law

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

> "(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 or association with the earlier trade mark."

34. Section 5A of the Act states as follows:

> "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."

35. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) ("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

36. The applicant's goods can be found at paragraph 1 above. The opponent's goods are simply "football shirts" in class 25.

37. 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 CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

"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".

38. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

39. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court 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 fur Lernsysteme*

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

Soccer shirts.

40. Put simply, the above term of the applicant is another word for "football shirts", being the opponent's term. As such, I consider that these goods are self-evidently identical.

Sportswear; casualwear; ready-to-wear clothing; sports clothing; sports garments; athletic clothing; men's clothing; menswear; leisurewear; sports clothing [other than golf gloves]; moisture-wicking sports shirts; leisure clothing; clothes for sports; clothing; clothing for sports; jerseys [clothing]; sports shirts; casual clothing; clothes for sport; clothing for leisure wear; articles of sports clothing; embroidered clothing; loungewear; sports jerseys; sport shirts.

41. All of the above goods of the applicant can, in my view, be interpreted broadly enough so as to cover the opponent's "football shirts". I say this because football shirts can be worn for sporting activity but can also be worn casually or leisurely. As a result, I find that these goods are identical under the principle outlined in *Meric*.

Outerwear; jackets being sports clothing; triathlon clothing; clothing for cycling; gymwear; surfwear; shorts [clothing]; clothing for gymnastics; swimwear; jackets [clothing]; moisture-wicking sports pants; sports jackets; windproof clothing; parts of clothing […] and headgear; golf clothing, other than gloves; water-resistant clothing; jogging bottoms [clothing]; dance clothing; tennis pullovers; jogging sets [clothing]; clothing for cyclists; garments for protecting clothing; rainwear; sports pants; tennis shirts; moisture-wicking sports bras; linen clothing; clothing for wear in judo practices; breeches for sports.

42. The above goods of the applicant are all used during sport or recreational activities. While they may not cover "football shirts" in the opponent's specification, they are similar. I say this because while their natures will differ (with the applicant's goods all likely made of different materials), they are all clothing goods that will be worn on the person for various reasons, be that for participation in sport (albeit different ones), protection from the elements or for style purposes.[10] Therefore, there is a degree of overlap in method of use and purpose. Further, I consider that the producer of "football shirts" is also likely to produce a wide range of other clothing goods, such as those covered by applicant's terms. Lastly, the goods will be selected by the same user. Taking all of this into account, I find that these goods are similar to between a medium and high degree.

Knitwear [clothing]; denims [clothing]; knitwear; woolen clothing; quilted jackets [clothing]; knitted clothing; woven clothing; maillots [hosiery].

43. I find that these goods differ in nature with the opponent's "football shirts" on the basis that while they are clothing goods, they are likely made from different materials. That being said, there is some overlap in method of use (clothing worn on the body) and purpose (clothing for style/protection from the elements). The user will overlap on the basis that the goods will be selected by the general public at large. Lastly, in respect of trade channels, I appreciate that these goods will all be available in larger clothing stores. However, they will not necessarily be available in close proximity to one another. Further, I accept that producers of football shirts will also produce a wide range of other clothing goods and while that may be the case, I do not consider that a producer of football shirts commonly provides the above goods, or vice versa. On this point, I note that I have no evidence before me to suggest otherwise. Taking all of this into account, I find that these goods are similar to a medium degree.

[10] I appreciate that football shirts may be worn to show an allegiance to a certain team, however, they are still items of clothing that will, at their core, be worn for the same purposes.

Leisure footwear; sports footwear; footwear for sport; athletic footwear; beach footwear; sport shoes; parts of […] footwear.

44. The above goods will all, plainly, differ in nature, method of use and purpose with the opponent's term of "football shirts". That being said, I consider that the user and trade channels for these goods all overlap. I say this because the producer of football shirts will also produce and sell a range of different types of footwear goods that will be selected by the same user.[11] As such, I find that these goods are similar to a low degree.

The average consumer and the nature of the purchasing act

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

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

[11] For the avoidance of doubt, it is my understanding that beach footwear such as flip flops or sandals are still capable of being provided by these same undertakings.

46. The goods at issue are ordinary consumer goods that will be selected by the general public at large. The goods will be selected via general retailers and their online equivalents. In physical stores, the goods will be displayed on shelves or racks where they will be self-selected by the consumer. When the purchase takes place online, the goods will be selected after viewing an image on a webpage. Clearly, the visual component will dominate the selection process, though I do not discount the aural component entirely as suggestions may come via word of mouth recommendations or advice from sales assistants. The goods at issue are likely to be selected on a relatively frequent basis and at a moderate cost. When selecting the goods, consumers are likely to consider factors such as the materials used, suitability, style and fit. In my view, these are ordinary factors that will attract a medium degree of attention.

Comparison of the marks

47. It is clear from *Sabel v Puma AG* (particularly paragraph 23) 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.

48. 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."

49. 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.

50. The respective trade marks are shown below:

The opponent's mark	The applicant's mark
SCORE DRAW	

51. I have comments from both parties in respect of the comparison of the marks. While I do not intend to reproduce those here, I can confirm that I have taken them into account in making the following comparison. That being said, there is one submission I do wish to address, being that of the opponent. This relates to the following submission:

> "Overall, the Opponent reiterates that the Applicant has failed to demonstrate, throughout their submissions and evidence submitted, the dissimilarities between the two trade marks. Therefore, the Opponent maintains that the marks are highly similar."

52. While this is noted, it is not for the applicant to demonstrate via submissions or evidence that the marks are dissimilar. Therefore, the opponent allegation that the applicant has failed to demonstrate that the marks are dissimilar is of no

assistance. On this point, I will say that submissions or evidence may be of assistance to a Hearing Officer when conducting a marks comparison. However, the assessment is ultimately a notional one based on the marks as they appear on the trade marks register.

Overall Impression

53. The opponent's mark is a word only mark that consists of two words, being 'SCORE DRAW'. There are no other elements that contribute to the overall impression which lies across these words equally. As for the applicant's mark, this is a figurative mark that consist of the word 'SCORELINE' presented in a black, standard typeface. Surrounding the letters 'INE' is a device element that appears to be half of a diamond shape (made up of three separated black lines) lying on its side. I will refer to this as simply a figurative embellishment. While 'SCORELINE' is presented as one word, consumers will readily identify it as the conjoining of two ordinary dictionary words, being 'SCORE' and 'LINE'. As consumers are drawn to elements of marks that can be read, it is this word that will play the greater role in the overall impression of the mark. As for the device element, this will play a lesser role.

Visual Comparison

54. Visually, the marks share the word 'SCORE', being their beginning elements. On this point, I remind myself that consumers tend to focus on the beginnings of marks.[12] That being said, the marks differ in the fact that this word is followed by the word 'DRAW' in the opponent's mark and 'LINE' in the applicant's. The marks differ further in the figurative embellishment that surrounds the end of the applicant's word element. While this plays a lesser role in the applicant's mark, it is still a point of visual difference between the marks. Taking all of this into account,

[12] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

I find that these marks, due to their shared beginnings but different ends, are visually similar to a medium degree.

Aural Comparison

55. Both marks will be pronounced in the ordinary way, both being two syllables in length. Plainly, their first elements are identical whereas their seconds differ entirely. Aurally, these marks are both short and, on this point, I appreciate that there is no special test for short marks.[13] However, I am of the view that the shortness of the marks in the present case means that the consumer is more likely to notice the differences as while this is just one syllable, it makes up half of each of the marks at issue. That being said, there is no escaping the identical first syllable and, as such, I find that these marks are aurally similar to a medium degree.

Conceptual Comparison

56. I consider that the word elements in both parties' marks form unitary phrases that will have readily identifiable meanings to consumers in the UK. The opponent's mark, being 'SCORE DRAW', will be understood as a reference to a sporting result wherein both teams scored, however, the outcome was that of a draw. For example, 2-2 is a 'score draw'. As for the applicant's mark, the sole conceptual element being 'SCORELINE', will be understood as a reference to the final score of a sporting match. Any score can be considered a scoreline, regardless of whether either team scores or not. I appreciate that a score draw is a score line but this does not, in my view, result in a finding of conceptual identity between the marks. That being said, there is clearly some conceptual overlap between the marks on the basis that both will be understood as a final score result of a sporting event. In my view, these marks are conceptually similar to a medium degree.

[13] *BOSCO*, BL O/301/20

Distinctive character of the opponent's mark

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

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see Windsurfing Chiemsee, paragraph 51)."

58. Registered trade marks possess varying degrees of inherent distinctive character, perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods or services for which it is registered, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made

of it. In the present case, the opponent has not expressly pleaded that its mark enjoys an enhanced degree of distinctive character. However, it has filed evidence of use and it is, therefore, necessary for me to consider whether the same can be said to point to an enhanced degree of distinctive character. Before doing so, however, I will consider the inherent distinctiveness of the mark.

59. As discussed above, the opponent's mark will be seen as a reference to a result of a sporting event wherein both teams scored but the outcome was that of a draw. In the present assessment, it is necessary to consider the goods upon which the opponent relies, being "football shirts". In the context of such goods, the sporting event referred to will clearly be understood as a football match. While the message of a 'score draw' is not descriptive of the goods at issue, it is allusive to some degree as it will be seen directly as a reference to a football result so the connection to football shirts is somewhat obvious. As a result, I find that the distinctiveness of the opponent's mark lies on the lower end of the scale. That being said, it is not directly descriptive so I do not consider that it is outright low. Instead, I consider that the opponent's mark is inherently distinctive to between a low and medium degree.

60. Before turning to the issue of enhanced distinctiveness, I consider it necessary to briefly discuss the applicant's concession as to a reputation, being that which I have set out at paragraph 26 above. In proceedings before the Tribunal, it is often the case that the outcomes in respect of an assessment of enhanced distinctiveness and that of a reputation render the same or similar results. That being said, this is not always the case as the tests, technically, differ. This is relevant to the present case as it could be argued that, because of what I have said in respect of the outcomes often being the same or similar, the concession of the applicant can also be read as a concession as to the existence of an enhanced distinctive character. In short, I do not consider that it does. I say this because the territory for the reputation assessment of the opponent's comparable mark is based on the EU prior to IP Completion Day and the UK only thereafter. The territory for

the present assessment, however, is the UK only. As such, the assessment required cannot be said to be like for like with the assessment for a reputation. Therefore, I do not consider it appropriate to infer that the concession made in respect of the test that covers the broader territory of the EU applies to the test which applies to the UK consumer only.

61. The evidence filed by the opponent has been very briefly summarised above in respect of the issue of genuine use. I do not intend to repeat that evidence here but remind myself that the opponent's turnover for the five years prior to the relevant date stood at approximately £39 million. Having said that, I have set out that this turnover covers global use. This presents an issue for the opponent as the relevant consumer for the test of enhanced distinctiveness is the UK consumer. Therefore, it is not possible for me to determine the actual level of turnover relevant to the present assessment. This renders the present assessment somewhat difficult.

62. I appreciate that turnover is not the only evidence that points towards an enhancing of distinctive character. However, the remaining evidence provided leaves a lot to be desired. I say this because the majority of the evidence before me is simply a wide range of reproductions of images from the opponent's own website. While such evidence is noted, I fail to see how printouts from the opponent's own website can be said, without anything further, to contribute to the level of awareness of the opponent's brand across the UK consumer base. That being said, there is some evidence that I consider necessary to discuss in further detail. I will do so below.

63. In respect of the opponent's website, being 'www.scoredraw.com, his narrative evidence sets out that the website records 'current monthly traffic' of 40,000 online visitors and that this peaked at 400,000 visits. While this is noted, the witness statement of the opponent is dated 6 November 2023, being some 10 months after the relevant date. As such, it is not clear to me whether these figures can be said to cover a time or period prior to the relevant date or not. Further, the nature of

internet activity is such that this could also include visitors from countries other than the UK which would be of no assistance to the present ground. On this point, I note that (1) the opponent's website is a '.com' domain and (2) the opponent sets out that he distributes his goods to the UK, EU and worldwide from said website. Therefore, it is reasonably to infer that some of these visitors are from territories that are not relevant to this assessment.

64. I note that there are some pages taken from the website of Italian football club AC Milan[14] but none of these actually refer to the opponent's brand and, instead, refer to the products as 'AC MILAN RETRO COLLECTION'.

65. In addition, the evidence shows social media posts regarding the 2021 release of the opponent's retro 1990 'blackout' England shirt, which it released in collaboration with the English FA.[15] I note that the posts come from accounts of well-known personalities or companies, such as English footballer, Raheem Sterling, Sky Sports, BR Football and Football Joe. I note that one of these posts, being that from BR Football, attracted almost 44,000 likes and over 200 comments. On the face of it, this would appear significant. However, the BR Football post does not mention the opponent at all and there is no use of the opponent's mark on the shirt shown in the post. Therefore, there is no indication whether this level of exposure can be said to have made its way to the opponent directly. As for the posts that do mention the opponent's brand, I note that the level of engagement is, generally, rather low with the most successful post attracting 2,736 likes. In the context of the football shirt market at large, this is likely to be considered low.[16]

66. While on the topic of social media evidence, the opponent has provided adverts on Instagram that were posted by 'JD Football', being a sporting goods retailer.[17]

[14] MRP17
[15] MRP9
[16] On this point, I appreciate that I have no evidence to suggest the size of the market but this assumption is made on the basis that the UK market for football shirts is likely to be a sizeable one.
[17] MRP16

These posts show the opponent's England football shirts. While these posts refer to the opponent's brand, they are undated and the information regarding engagement is very vague and seemingly limited. I note that in respect of this same retailer, a printout of the opponent's goods listed for sale is provided in evidence.[18] While noted, this is confirmed as being a printout taken from a search undertaken on 5 November 2023, being after the relevant date. As such, this printout is not capable of showing the position prior to the relevant date meaning that it is of no assistance here.

67. In terms of advertising, I note that there is reference to a September 2022 edition of the football magazine 'FourFourTwo' which features footballer Harry Kane on the cover wearing one of the opponent's retro England shirts. A copy of the front cover for this magazine is provided in evidence.[19] While I do not doubt that this is one of the opponent's shirts, there is no relevant branding that the consumer would be able to identify in order to recognise as such. The narrative evidence sets out that in this magazine, there was a double-page 'SCORE DRAW' advertorial and a 'SCORE DRAW' sponsored World Cup Wallchart. I do not doubt that these items featured within the magazine, however, they are not shown in evidence and I have nothing to suggest how the opponent's brand would be shown to the consumer. Further, I have nothing to suggest the level of readership that this issue of the magazine attracted in order to determine how many consumers in the UK may have potentially become aware of the brand in this way.

68. In considering all of the above, I am of the view that while I appreciate that I was satisfied to find that the turnover alone was sufficient to warrant a finding of genuine use, the evidence, as a whole, falls short of the threshold for proving an enhanced degree of distinctive character. In short, there are just far too many discrepancies within the evidence itself and even where I am able to pinpoint some use or attempts at marketing, it is very vague and imprecise. For example, the turnover

[18] MRP15
[19] MRP10

covering global scales has rendered it impossible for me to determine the level of use that actually occurred prior to the relevant date in the UK. Further, I appreciate that the opponent has sought to advertise his brand, however, the evidence is not compelling with just one example of a 'SCORE DRAW' shirt appearing on the cover of a magazine. As such, I do not have enough evidence before me to demonstrate that a significant proportion of the relevant public would, because of the opponent's use of its mark, have become aware of the opponent's brand.

Likelihood of confusion

69. 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 opponent's marks, the average consumer for the goods and the nature of the purchasing process. 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 or she has retained in his or her mind.

70. I have found the parties' goods to be identical or similar to varying degree, including low. I have found the average consumer for the goods to be members of the general public at large who will select the goods via visual means (though I do not discount an aural component playing a role) and after having paid a medium degree of attention. In respect of the similarity of the marks at issue, I have found

the marks to be visually, aurally and conceptually similar to a medium degree. Lastly, I have found the opponent's mark to be inherently distinctive to between a low and medium degree. On this point, I remind myself that a finding of a weaker distinctive character of an earlier mark does not preclude a finding of confusion.[20]

71. On the point of confusion, I remind myself that the opponent's pleaded case is that a consumer "with imperfect recollection would struggle to differentiate between the two trade marks". To me, this appears to be a pleading focused solely on direct confusion. On this point, I note that there is nothing else in the opponent's pleading under the present ground that indicates any argument in respect of indirect confusion. As a result, I only have direct confusion to consider.[21]

72. Taking all of the above into account and even bearing in mind the principle of imperfect recollection, I am of the view that consumers will be able to clearly identify the differences between the marks at issue and use those differences to accurately recall which mark was which. I appreciate that there is a degree of similarity between the marks, however, consumers would not overlook the fact that the marks consist of different second words, being 'DRAW' in the opponent's mark and 'LINE' in the applicant's. Regardless of the identical beginnings of the marks' verbal elements, both words across the parties' marks combine to form unitary meanings. As such, I have found that these additional (and different) words play equally dominant roles across the marks. Therefore, I see no reason why they would be overlooked, even taking into account that, as I have set out above, consumers tend to focus on the beginnings of marks. Lastly, while there is a shared conceptual hook in relation to a final result of a sporting event, this is not a particularly compelling point. I say this because, in the context of clothing goods (especially

[20] *L'Oréal SA v OHIM*, Case C-235/05 P

[21] I appreciate that in its written submissions, the opponent has sought to argue that the consumer would believe that the goods offered under the marks are from the same economically linked undertaking, being an argument in favour of indirect confusion. However, the opponent has not sought to amend its pleaded case. Even if such an application was made at the time of filing these submissions, I would have rejected it on the basis that (1) it would have caused inconvenience or prejudice to the applicant (due to being filed at such a late stage) and (2) the opponent could reasonably have been expected to have fully particularised his case at an earlier stage.

sporting or football relates goods), this will not be viewed as remarkable and the shared concept (being one relating to football or sports) will, therefore, be seen as coincidental. Consequently, I do not consider that there exists a likelihood of direct confusion between the marks at issue, even on identical goods.

73. As above, the opponent has not pleaded that there exists a likelihood of indirect confusion between the marks at issue. That being said, even if I were to consider this point, I do not consider that a likelihood of confusion exists in any event. For the sake of completeness, I have set out my detailed reasoning below.

74. In considering indirect confusion, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, wherein 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)".

75. While the above examples in *L.A. Sugar* are noted, they are not intended to be treated as an exhaustive list of the only instances wherein indirect confusion occurs.

76. Further, I note the case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, wherein Arnold LJ referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at paragraph 16 that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

77. I appreciate that the marks share the identical word 'SCORE' which sits at both of their beginnings. However, I do not consider that this alone is sufficient to give rise

to a finding that consumers would believe that the marks originate from the same or economically connected undertakings. I say this because, in the first instance, 'SCORE' is not very distinctive from a trade mark perspective, especially when considered on the goods at issue. As such, the common element of the marks cannot be said to be so strikingly distinctive that consumers would believe that only one undertaking would use it (in accordance with category (a) of *L.A. Sugar*). In respect of the concept of the marks, I appreciate that a 'SCORE DRAW' is a specific 'SCORELINE'. However, even taking this into account, I do not consider that consumers would consider it logical for an undertaking that uses 'SCORE DRAW' (being a specific scoreline) as the basis of its brand to extend its brand or create a sub-brand by removing the second part of its distinctive element (being 'DRAW') and replacing it with a different word (being 'LINE') to create a separate reference to 'scorelines' generally.[22] In short, I do not consider that replacing 'DRAW' with the word 'LINE' simply adds a non-distinctive element to the mark to the point that it would be seen as a sub-brand or brand extension (in accordance with category (b) of *L.A. Sugar*). Additionally, I do not consider that the change from 'SCORE DRAW' to SCORELINE' is indicative of a logical or consistent with a brand extension (in accordance with category (c) of *L.A. Sugar*). Lastly, as I have set out above the categories set out in *L.A. Sugar* are not exhaustive examples, however, I do not consider that any other logical examples of how the marks would be confused exist. On this point, I note that the opponent has not suggested any alternative scenarios.

78. Taking all of the above into account, I do not consider that there exists a likelihood of indirect confusion between the marks, even on identical goods. As a result, the opposition reliant upon the section 5(2)(b) ground fails in its entirety.

79. I will now proceed to consider the section 5(3) ground.

[22] For the avoidance of doubt, I consider that this finding also applies the around way around, namely where the consumer is considering whether 'SCORE DRAW' was a sub-brand or brand extension of 'SCORELINE'.

Section 5(3)

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

> "5(3) A trade mark which –
>
> is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark."

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

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

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

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

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

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

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

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

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

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

82. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the marks are similar.[23] Secondly, the opponent must show that its mark has achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the parties' marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the applicant's mark. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods and services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

Reputation

83. I have set out at paragraph 26 above that the applicant has conceded the existence of a reputation in the opponent's mark in respect of "football shirts". In light of this, it follows that I must conclude here that the opponent's mark enjoys a reputation.

[23] Given my findings under the section 5(2)(b) ground, I am satisfied that there is a degree of similarity between all of the marks at issue.

Saying that, the applicant has not mentioned the strength of said reputation. Therefore, this is a something that I must now determine.

84. I have summarised the evidence of the opponent above at paragraphs 28 to 31 and 62 to 68. Given the number of issues I have identified in the evidence, I am of the view that it is only sufficient to give rise to a finding that the reputation enjoyed by the opponent is only at a minor level.

Link

85. As noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks.

86. I have found above that the marks at issue are visually, aurally and conceptually similar to a medium degree. Those same findings apply here.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public.

87. The goods relevant here are identical to those I have compared under the section 5(2)(b) ground above. As such, those same findings apply, namely that the goods at issue are identical or similar to varying degrees, including low.

The strength of the earlier mark's reputation.

88. I have found that the opponent's mark enjoys a minor reputation.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use.

89. I have found that the opponent's mark is inherently distinctive to between a low and medium degree. While I appreciate that under the present ground, I have found this mark to benefit from a reputation, I do not consider that the use shown before me is sufficient to warrant a finding that the distinctiveness has been enhanced to any degree. On this point, I refer to the reasoning set out when discussing the issue of enhanced distinctiveness at paragraph 60 above.

Whether there is a likelihood of confusion

90. I have found that there is neither a likelihood of direct nor indirect confusion between the marks at issue.

Conclusion on link

91. In considering the issue of whether there exists a link or not, I remind myself that the opponent's claim under the present ground is that the marks are confusingly similar and that the relevant person would understand 'SCORELINE' to be the same brand or a brand related to 'SCORE DRAW'. As such, the nature of the opponent's pleaded case is that there exists a link between the marks at issue because the consumer would be confused as to the origin of the marks. In light of my findings in respect of confusion (being those set out under the section 5(2)(b) ground at paragraphs 72 to 78 above), I find that this claim has no merit. Therefore, I find that there is no link between the marks.

92. The above being said, even if I were to consider link based on a claim that the consumer would be caused to wonder if the parties' marks were linked or called to mind for one another, it would offer no advantage to the opponent. I say this because regardless of the existence of a reputation (which is minor) and despite

the identity or similarity of the goods at issue, the differences between the marks, as wholes, are such that the consumer would not be caused to wonder if the marks were connected and neither would they bring the opponent's mark to mind when confronted with the applicant's mark. This is on the basis that any reputation associated with the opponent's mark lies in that mark as a whole and not in the sole word 'SCORE'. As such, I see no reason why an average consumer who is aware of the 'SCORE DRAW' brand would, upon being confronted with the applicant's mark, believe them to be linked. Instead, that consumer would simply regard the shared use of the word 'SCORE' on clothing goods (including sports clothing and football shirts) as being coincidental.

93. Without the existence of a link between the marks, there can be no damage. As a result, I find that the opponent's reliance upon the 5(3) ground fails in its entirety.

Final comments under section 5(3)

94. For the avoidance of doubt, I wish to point out that the finding of there being no link between the marks would have been found regardless of whether it could be said that the opponent enjoyed a stronger degree of reputation in his mark over and above the minor level I have found above. Even if I was wrong to reach such a finding, I fail to see how the evidence (or even the concession of the applicant, for that matter) could justify a strong reputation. Instead, I consider that the opponent's best case would been that his mark enjoyed a reputation at a moderate level. I do not consider that this would have offset the findings I have made throughout this decision, namely that the differences between the marks as wholes and the lack of distinctiveness/reputation in the word 'SCORE', solus, are such that the consumer would not be confused or caused to wonder if they were linked regardless of the opponent's reputation.

CONCLUSION

95. The opposition fails in its entirety and the applicant's mark may, subject to any successful appeal against my decision, proceed to registration for all goods applied for.

COSTS

96. The applicant has been successful and is, therefore, entitled to his costs. The applicant was unrepresented for the entirety of these proceedings. For unrepresented parties to recover their costs in proceedings before the Tribunal, they are required to file a costs pro forma. The applicant's costs pro forma was received on 13 June 2024. The applicant claims that he spent the following amount of time on these proceedings.

Notice of opposition:	1 hour
Notice of defence:	20 hours
Considering forms filed by the other party:	2 hours
Supplying visual and written evidence:	48 hours
Commenting on the evidence:	3 hours
Submissions:	5 hours
Total:	**78 hours**

97. Firstly, the applicant was not required to prepare a notice of opposition and I note that he has separately claims 2 hours for considering the opponent's forms. I have

nothing to suggest what is being claimed in respect of the notice of opposition task. Secondly, turning to the claims generally, I appreciate that the tasks outlined above would have required more of a time commitment by the applicant on the basis that he is unrepresented. That being said, I am of the view that spending 20 hours preparing a notice of defence and 48 hours on preparing the evidence in these proceedings is excessive, especially when you consider that the evidence totaled approximately 14 pages in length.

98. In light of what I have said above, I consider a costs award for the following number of hours to be reasonable:

Notice of defence:	5 hours
Considering forms filed by the other party:	2 hours
Supplying visual and written evidence:	8 hours
Commenting on the evidence:	3 hours
Submissions:	5 hours
Total:	**23 hours**

99. In relation to the hours expended, I note that the Litigants in Person (Costs and Expenses) Act 1975 (as amended) sets the minimum level of compensation for litigants in person in Court proceedings at £19.00 an hour. I see no reason to award anything other than this. I therefore award the opponent the sum of £437.00 (23 hours at £19 per hour) in respect of its costs proforma.

100. I hereby order Michael Roy Phillips trading as Score Draw to pay Darren Moore the sum of £437. The above sum should 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 10th day of March 2025

A COOPER
For the Registrar