

**O/023/22**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF INTERNATIONAL  
REGISTRATION NO. 1514695  
DESIGNATING THE UNITED KINGDOM  
IN THE NAME OF MCKIVEY BEVERAGES LLC:**

**MCKIVEY**

**AS A TRADE MARK IN CLASSES 9, 21, 25, 29, 30, 32 & 33**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 420078 BY  
IIC-INTERSPORT INTERNATIONAL CORPORATION GMBH**

## BACKGROUND AND PLEADINGS

1. On 7 January 2020, McKivey Beverages LLC (“the holder”) applied to register the International Registration shown on the cover page of this decision (“the IR”). With effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the term of the Protocol to the Madrid Agreement. The priority date for the IR is 3 January 2020. The holder seeks protection for the following goods:

Class 9:           Sunglasses.

Class 21:          Beverage glassware, cups, mugs, corkscrews, cocktail shakers.

Class 25:          Clothing, namely, t-shirts, sweatshirts, hooded shirts and sweatshirts, bandanas, caps and hats.

Class 29:          Milk, chocolate milk and milk based beverages; oat milk, coconut milk, almond milk, soy milk, nut milk, rice milk, lactose-free milk.

Class 30:          Hot chocolate and frozen hot chocolate; coffees, teas.

Class 32:          Beer, ale, lager, stout and porter; non-alcoholic beverages, namely, carbonated beverages and non-carbonated soft drink, fruit juices, water, coconut water.

Class 33:          Wine; alcoholic coffee-based beverages; alcoholic chocolate-based beverages; alcoholic beverages, except beer, containing milk, chocolate milk, oat milk, coconut milk, almond milk, soy milk, nut milk, rice milk, lactose-free milk; spirits and liqueurs; alcoholic beverages, except beer.

2. The request was published for opposition purposes on 28 February 2020 and, on 28 April 2020, it was opposed by IIC-INTERSPORT International Corporation

GmbH (“the opponent”). The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following marks:

**McKINLEY**

International Registration no. 1063819 designating the EU<sup>1</sup>

International registration date 15 December 2010; date protection granted in the EU 15 December 2010

Relying on some goods, namely:

Class 9: Protective helmets for sports and leisure activities; spectacles, sunglasses, including sunglasses for hiking in the mountains and mountaineering; directional compasses, magnifying glasses; walkie-talkies; binoculars.

Class 21: Lunch boxes, drinking bottles, crockery for use in camping, bottles.

Class 25: Clothing, footwear, gloves and caps (headwear), fishing boots; clothing for hiking, for mountain use, for climbers, for hunting, for fishing, for horse riding, for winter sports and for skiing.

(“the opponent’s first mark”); and



International Registration no. 1499642 designating the EU:

International registration date 4 October 2019; date protection granted in the EU 4 October 2019

Priority date: 16 April 2019

Relying on some goods, namely:

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<sup>1</sup> Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – please see Tribunal Practice Notice 2/2020 for further information.

Class 9: Protective helmets for sports and leisure; spectacles, sunglasses, including sunglasses for mountain hiking and mountaineering; directional compasses, magnifying glasses; walkie-talkies; binoculars.

Class 21: Mess-tins, canteens, crockery for camping, bottles.

Class 25: Clothing, footwear, gloves and caps, boots for fishing; clothing articles for hiking, for mountain treks, for mountaineering, for hunting, for fishing, for horseback riding, for winter sports and skiing.

("the opponent's second mark")

3. The opposition is aimed at the holder's class 9, 21 and 25 goods only. The opponent submits that as a result of the identity and similarity between the goods and the similarities between the marks, there exists a likelihood of confusion on the part of the public including a likelihood of association. The holder filed a counterstatement denying that there is a likelihood of confusion and argues that the marks are only visually and aurally similar to a low degree and conceptually different. The holder partially denied that the goods were similar but admitted that its class 9 goods were similar to the opponent's class 9 goods. The holder also requested that the opponent provide proof of use of its first mark.
4. The opponent filed evidence in chief; while the holder did not file evidence, it did file written submissions in response, being a document it refers to as its written observations. The opponent filed evidence in reply. A hearing took place before me on 25 November 2021 by video conference. The opponent was represented by Mr Julius Stobbs of STOBBS IP Limited, who have represented the opponent throughout these proceedings. The holder was represented by Ms Clare Cornell of Finnegan Europe LLP, who have represented the holder throughout these proceedings. Both parties filed skeleton arguments in advance of the hearing.
5. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in

accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

## **EVIDENCE**

6. As set out above, only the opponent has filed evidence in these proceedings. The opponent's evidence in chief came in the form of the witness statement of Mr Sebastian Baumann dated 23 December 2020 and was accompanied by 11 exhibits. Mr Baumann is the Legal Counsel of the opponent, a position he has held since 2008. As above, the holder filed submissions in response to the evidence in chief.
7. The opponent also filed evidence in reply in the form of the witness statement of Kasongo Swana dated 31 August 2021, also accompanied by 11 exhibits. Ms Swana is a trainee trademark attorney of the opponent's representative.
8. While I do not intend to summarise the evidence and submissions at this stage, I have considered them in detail and will, where necessary, refer to them below.

## **DECISION**

### **Proof of use**

9. 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 –

- (a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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,

(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.”

10. Given their filing dates, the opponent’s marks qualify as earlier trade marks under the above provisions. In its counterstatement, the holder sought to put the opponent to proof of use of its first mark on the basis that it had completed its registration process more than 5 years before the international registration date of the IR. Therefore, the opponent’s first mark is subject to proof of use pursuant to section 6A of the Act. As for the opponent’s second mark, it had not completed its registration process more than 5 years before the international registration date of the IR. It is not, therefore, subject to the proof of use provisions. The opponent may, therefore, rely on all of the goods for which its second mark is registered.

11. The relevant statutory provisions are as follows:

“Raising of relative grounds in opposition proceedings in case of non-use

6A-(1) This section applies where –

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) 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 period of five years ending with the date of publication.

(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 mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application 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) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(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.”

12. Section 100 of the Act is also relevant, which 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.”

13. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, 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] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases 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]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(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]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(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] and [22]. 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]; *Reber* at [29].

(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]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(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] and [76]-[77]; *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].”

14. Pursuant to Section 6A of the Act, the relevant period for assessing whether there has been genuine use of the opponent’s first mark is the 5-year period ending with the priority date of the IR. I note that in their written submissions, the parties have referred to the relevant period as being 3 January 2015 to 3 January 2020. However, at the hearing, the opponent referred to the relevant period as being 4 January 2015 to 3 January 2020. For the avoidance of doubt, it is necessary to point out that the relevant period is as the opponent set out during the hearing.

15. As the earlier mark is an international registration designating the EU, the opponent must show use in the EU. In *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the Court of Justice of 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.”<sup>2</sup>

16. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real”<sup>3</sup> 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”<sup>4</sup> is, therefore, not genuine use.

### Form of the Mark

17. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the CJEU found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot

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<sup>2</sup> Paragraph 36.

<sup>3</sup> *Jumpman* BL O/222/16

<sup>4</sup> *Ibid*

be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35 Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)". (emphasis added)

18. The opponent's mark as registered is used throughout the evidence. Clearly, this is use upon which the opponent can rely. I also note that the opponent has used the mark in the following way:



19. Firstly, the opponent's first mark is a word only mark that is registered in black and white. This means that it can be used in any colour and in any standard typeface. In my view, use of the word shown above is in line with the notional fair use of the mark as registered. As per the case of *Colloseum*, use of a mark generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark. In my view, the addition of the device element in the use shown above means that the use of the opponent's first mark is as part of a composite mark. While used as part of a composite mark, I consider that the word 'McKINLEY' will be perceived independently and continued

to be viewed as indicative of the primary origin of the goods at issue. As a result, and in accordance with *Colloseum*, I consider the use shown above to be an example of use of the opponent's first mark as registered.

### Sufficient Use

20. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.<sup>5</sup>

21. While I have written submissions from the holder on the issue of sufficient use, particularly regarding the vague nature of the turnover and advertising evidence, I note that the holder has also proposed a fair specification for the opponent's goods (that I will discuss below). It is possible that, from this, I could infer that the holder accepts that the opponent has genuinely used its mark. However, for the avoidance of doubt, I consider it necessary to undertake a full assessment on the issue of sufficient use.

22. In the opponent's evidence, I note that:

- a. A wide range of import invoices and purchase orders have been provided that show a range of goods being shipped to the opponent's subsidiary in Germany.<sup>6</sup> These invoices/purchase orders show a range of goods, such as long sleeve t-shirts, hiking boots, softshell jackets and multifunctional shoes. I note that some of these invoices are dated outside the relevant period but, for the most part, they are dated within it. While there is no evidence or confirmation that these goods were eventually sold on, I will consider them on the basis that they contribute to the overall evidential picture;
- b. A range of selected extracts from prospectuses, catalogues and flyers are provided from within the relevant period.<sup>7</sup> The opponent confirms that these have been distributed in various countries in the EU, specifically Austria, Czech

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<sup>5</sup> *New York SHK Jeans GmbH & Co KG v OHIM*, T-415/09

<sup>6</sup> Exhibit SB6 of the Witness Statement of Sebastian Baumann

<sup>7</sup> Exhibit SB7 of the Witness Statement of Sebastian Baumann

Republic, Denmark, Finland, France, Germany, Hungary, Slovakia and Spain. Having reviewed these extracts, I note that they show a wide range of goods such as different types of clothing, outerwear, footwear, socks, hats, gloves, cutlery, pans, plates, mugs, compasses, penknives, cooler boxes and bags, picnic blankets, backpacks, sleeping bags, walking poles, camping chairs and tables, first aid kits, headlamps and lanterns. I note that all of these are sold under the opponent's first mark;

- c. A number of voucher books<sup>8</sup> and advertisements<sup>9</sup> have been provided that the opponent confirms were available to retail consumers in Austria in 2019. I note that these show, amongst other goods, a range of clothing and footwear.
- d. In respect of advertising and marketing, I note that the opponent has spent the following in promoting its MCKINLEY brand:
  - i. In excess of 800,000 euros for the year 2019/2020 in Austria;
  - ii. Nearly 500,000 euros in 2016 in Germany;
  - iii. Nearly 50,000 euros between August 2015 and August 2020 in Italy; and
  - iv. Over 60,000 euros in Greece in 2018 and 2019.

I note that some of the advertising figures for Austria and Italy will inevitably fall outside the relevant period;

- e. The total wholesale value of all MCKINLEY branded products in 2016 throughout twelve EU countries was in excess of 100 million euros;
- f. The opponent states that between 2015 and 2020, it sold an approximate total of 269 million euros worth of goods bearing the MCKINLEY branding throughout the EU. The opponent provided individual country breakdowns in respect of these figures, which are as follows:
  - i. Over 40 million euros in Bulgaria, Cyprus, Greece and Romania;

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<sup>8</sup> Exhibit SB8 of the Witness Statement of Sebastian Baumann

<sup>9</sup> Exhibit SB9 of the Witness Statement of Sebastian Baumann

- ii. Over 70 million euros in Denmark;
  - iii. Over 17 million euros in Italy;
  - iv. Nearly 100 million euros in Austria;
  - v. Over 21 million euros in Czech Republic;
  - vi. Over 6 million euros in Hungary; and
  - vii. Over 15 million euros in Slovakia.
- g. The opponent has assessed the overall wholesale market in twelve key European countries for key items (being apparel, footwear, backpacks, sleeping bags and tents) and has determined that the MCKINLEY brand enjoyed a 3.26% market share; and
- h. The opponent has undertaken its own online research surveys that shows that in 2016, the MCKINLEY brand had an awareness of 69% in Slovenia, 63% in Austria, 54% in Croatia, 51% in Sweden, 47% in Germany and Finland, 36% in Romania, 30% in Greece, 27% in Denmark, 26% in Turkey, France and Ireland, 25% in Bulgaria, 23% in Italy, 21% in Spain, 14% in England and 12% in Netherlands.

23. As previously mentioned, the holder has taken issue with the sales and advertising figures and has argued that these are vague and not accompanied by any supporting data. While noted, I have no reason to doubt the accuracy of the information provided on the basis that it was (1) provided by an employee of the opponent who confirms that the information provided was from within his own knowledge and (2) the evidence was accompanied by a validly sworn statement of truth. Further, I am mindful that I am required to take the entire evidential picture into account and while the figures may not be broken down, the supporting evidence (such as the catalogues and advertisements) shows a wide range of goods available under the mark. In my view, when this evidence is taken together with the significant sales figures, it is reasonable to conclude that the whole range of goods evidenced attracted at least a reasonable level of sales during the relevant period.

24. In determining whether the opponent has shown genuine use, I note the following:

- a. The opponent's turnover figures of 269 million euros are significant. However, while the bulk of the evidence shows use on goods relied upon in these proceedings, I note that it also shows use on a wide range of goods that are not (such as sleeping bags, rucksacks and headlamps, to name a few). Further, the figures cover 2015 to 2020 generally, meaning that they are likely to include figures from outside the relevant period (which concluded on 3 January 2020). I appreciate that there is no forensic way for me to analyse the turnover figures in line with these issues. However, even if I were to take a broad-brush approach and appropriately reduce the figures in light of these issues, I am satisfied that the turnover figures would remain significant;
- b. While I have set out above that some of the goods covered by the sales figures may fall outside the opponent's relied upon specifications, I am content to conclude that the evidence does cover a wide range of the relied upon goods. This is supported by the invoice, catalogue and advertising evidence that has been provided;
- c. The nature of the goods at issue means that they will range in price from inexpensive to fairly expensive. However, for the most part I am of the view that they will be relatively inexpensive goods that are purchased relatively frequently. The significant level of sales suggests a frequent level of use at a reasonably high volume;
- d. The evidence of use provided covers a number of countries from across the EU resulting in a significant geographical spread of the McKINLEY brand across the relevant territory; and
- e. Even taking into account that some figures relating to expenditure in Italy and Greece fall outside the relevant period, the total advertising and marketing expenditure of approximately 1,410,000 euros by the opponent across a number of EU countries demonstrates a significant effort to market/promote goods sold under the mark.

25. Taking all of the evidence into account, I am of the view that the opponent's use of the mark across the EU has been quantitatively significant and it is clear that the opponent has attempted to create and maintain a market for its goods under its mark. Therefore, I am satisfied that the opponent has demonstrated genuine use

of its first mark during the relevant period in the EU. While genuine use has been shown, this does not cover all goods upon which the opponent relies. I will now proceed to consider this point when addressing a fair specification.

### Fair Specification

26. As above, I must now consider whether, or the extent to which, the evidence shows use of the opponent's mark in relation to the goods relied upon.

27. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular

goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

28. I remind myself that the goods relied upon by the opponent are as follows:

Class 9: Protective helmets for sports and leisure activities; spectacles, sunglasses, including sunglasses for hiking in the mountains and mountaineering; directional compasses, magnifying glasses; walkie-talkies; binoculars.

Class 21: Lunch boxes, drinking bottles, crockery for use in camping, bottles.

Class 25: Clothing, footwear, gloves and caps (headwear), fishing boots; clothing for hiking, for mountain use, for climbers, for hunting, for fishing, for horse riding, for winter sports and for skiing.

29. I have detailed submissions from both parties in respect of what constitutes a fair specification. In its written observations in reply to the opponent's evidence, the holder submitted that the opponent's first mark should only be considered in relation to the following goods:<sup>10</sup>

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<sup>10</sup> Paragraph 30 of the holder's observations in reply to the opponent's evidence

Class 9: Directional compasses

Class 21: Lunch boxes, drinking bottles, crockery for use in camping.

Class 25: Gloves and caps (headwear), clothing for hiking, for mountain use, for climbers, for winter sports and for skiing; hiking boots; hiking shoes; sports sandals.

30. I note that “hiking boots”, “hiking shoes” and “sporting sandals” were not originally included in the relevant paragraph of the holder’s observations. However, I note that at the hearing, the holder submitted that:

“In terms of the footwear for hiking and sports sandals, I believe that this was an error in that this was missed off in the final conclusion of our first specification.”

31. At the hearing, the opponent accepted that it had not shown use of a number of goods in its specification and referred to its skeleton argument wherein it proposed its own list of goods that it considered to constitute a fair specification. This is as follows:

Class 9: Directional compasses

Class 21: Lunch boxes, drinking bottles, crockery for use in camping.

Class 25: Gloves and caps (headwear), clothing for hiking, for mountain use, for climbers, for hunting, for fishing, for horse riding, for winter sports and for skiing; footwear for hiking; sports sandals.

32. The opponent submitted that the above concession regarding a fair specification would still result in identity and/or similarity between the parties’ goods. While the opponent claimed that its evidence did indeed show use for “clothing” in class 25, it accepted that such an argument did not further its position i.e. the extent of the full specification was not necessarily important for the purposes of this opposition.

However, at the hearing the opponent invited me to find that the use of its class 25 goods extended to “clothing” as a whole if I considered it appropriate to do so.

33. Given the holder’s concession in respect of a fair specification, I am content to accept the proposal made as a starting point for this assessment. As for the opponent’s proposals, I note that aside from the issue with the term “clothing”, the only difference between the parties’ proposed specifications is the inclusion of clothing for hunting, fishing and horse riding in the opponent’s proposals. Having reviewed the evidence, I do not consider that the evidence shows any use of clothing for these specific purposes.

34. Despite the opponent’s submissions that it does not further its case, I shall consider whether to permit the opponent to rely upon the use of the term ‘clothing’. While the turnover evidence provided by the opponent is not broken down into the types of goods sold, there is additional evidence which shows what goods have been sold by the opponent, i.e. the invoice/purchase order evidence and the catalogue and advertising evidence. While I have no evidence as to the reach or distribution of the catalogue/advertising materials, I am content to conclude that they assist in painting a picture of the goods sold under the mark.

35. At the hearing, the opponent took me through some examples of clothing within its catalogue evidence, including t-shirts, shorts, trousers, waterproof jackets, socks, sweaters, leisurewear, vests, gilets and shirts. Having reviewed this evidence, I can see that there are indeed a number of examples of what I consider the average consumer would describe as clothing. On balance with the significant turnover figures during the relevant period, it is my view that those general clothing goods shown in the catalogues and on the advertising materials attracted a reasonable level of sales during the relevant period. Given the wide range of clothing shown, I am content to conclude that the opponent has shown use of “clothing” in general.

36. As a result of the above, I consider a fair specification of the opponent’s goods to be as follows:

Class 9:            Directional compasses

Class 21: Lunch boxes, drinking bottles, crockery for use in camping.

Class 25: Clothing; gloves and caps (headwear), clothing for hiking, for mountain use, for climbers, for winter sports and for skiing; footwear for hiking; sports sandals.

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

37. 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.”

38. 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.”

39. 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**

40. In light of my finding above, the competing goods are as follows:

| <b>The opponent's goods</b>   | <b>The holder's goods</b>  |
|---|--|
| <p><i>The opponent's first mark</i></p> <p><u>Class 9</u><br/>Directional compasses</p> <p><u>Class 21</u><br/>Lunch boxes, drinking bottles, crockery for use in camping.</p> <p><u>Class 25</u><br/>Clothing; gloves and caps (headwear), clothing for hiking, for mountain use, for climbers, for winter sports and for skiing; footwear for hiking; sports sandals.</p> | <p><u>Class 9</u><br/>Sunglasses.</p> <p><u>Class 21</u><br/>Beverage glassware, cups, mugs, corkscrews, cocktail shakers.</p> <p><u>Class 25</u><br/>Clothing, namely, t-shirts, sweatshirts, hooded shirts and sweatshirts, bandanas, caps and hats.</p> |

|   |  |
|---|--|
| <p><i>The opponent's second mark</i></p> <p><u>Class 9</u><br/>Protective helmets for sports and leisure; spectacles, sunglasses, including sunglasses for mountain hiking and mountaineering; directional compasses, magnifying glasses; walkie-talkies; binoculars.</p> <p><u>Class 21</u><br/>Mess-tins, canteens, crockery for camping, bottles.</p> <p><u>Class 25</u><br/>Clothing, footwear, gloves and caps, boots for fishing; clothing articles for hiking, for mountain treks, for mountaineering, for hunting, for fishing, for horseback riding, for winter sports and skiing.</p> |  |
|---|--|

41. When making the comparison, all relevant factors relating to the goods 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:

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

42. 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.

43. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

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

44. The GC confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, that, even if goods or services are not worded identically,

they can still be considered identical if one term falls within the scope of another or (vice versa):

“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 für 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”.

45. At the hearing, both parties made submissions in relation to the comparison of goods. I do not intend to reproduce those in full here but I have taken them all into account when making the following comparison.

46. I note that there is some overlap between the opponent's marks' specifications. Where appropriate, I will deal with the opponent's identical terms together.

#### Class 9 goods

47. “Sunglasses” in the holder's specification has a direct counterpart in the opponent's second mark's specification meaning that they are self-evidently identical.

48. As for the opponent's first mark's specification, I am of the view that there is some level of similarity between “sunglasses” and “clothing for hiking, for mountain use, for climbers, for winter sports and for skiing”. At the hearing I was referred to a decision of the GC, being *Compagnie des montres Longines, Francillon SA v OHIM*<sup>11</sup> wherein the GC found no similarity between ‘optical sunglasses’ and ‘clothing and footwear’. While this case is noted, I am not bound by it. Further, I note that the comparison made in that decision is not the same as the one I must make here. For example, it is my view that optical sunglasses cover more specific types of sunglasses, being those with prescription lenses that will be available most commonly via opticians. As for the clothing goods that sunglasses are to be compared with, I note that these are specific types of clothing that are for outdoor

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<sup>11</sup> Case T-505/12

use, such as skiing or hiking, for example. I am of the view that a producer of skiing jackets may also produce sunglasses specifically manufactured for use while skiing.

49. While I accept that these goods differ in nature, they share a general overlap in method of use as they are goods that are worn on the body, albeit different parts. These goods are also likely to overlap generally in respect of users on the basis that skiers or hikers, for example, are likely to wear clothing designed specifically for those activities and, in sunny conditions, are also likely to wear sunglasses. As for purpose, I am of the view that both goods can be used for protecting the user from the sun. Further, I consider there to be an overlap in trade channels in that sunglasses may be found in the same specialist stores that also sell ski jackets or hiking clothing, for example. I also consider that, for the reasons already discussed at paragraph 48 above, manufacturers of clothes for skiing, hiking or mountain use may also produce their own sunglasses. Overall, given the overlaps discussed, I consider these goods to be similar to a medium degree.

#### Class 21 goods

50. “Beverage glassware” in the holder’s specification is a broad term that can, in my view, cover bottles for drinking. “Drinking bottles” and “bottles” are present in the opponent’s first and second marks’ specifications, respectively. I consider that the opponent’s goods covers bottles made of glass and can, therefore, fall within the holder’s broader terms. As a result, these goods are identical under the principle outlined in *Meric*.

51. “Cups” and “mugs” in the holder’s specification are types of crockery and, while not specifically for camping use, the terms are broad and can cover goods for such purposes. As a result, I consider that the holder’s goods covers “crockery for use in camping” and “crockery for camping” in the opponent’s first and second marks’ specifications, respectively. These goods are, therefore, identical under the principle outlined in *Meric*. In the event that I am wrong in my finding of identity between these goods, they are highly similar on the basis that they overlap in

users, nature, method of use and purpose (on the basis that they can all be used for camping purposes).

52. “Corkscrews” in the holder’s specification does not, in my view, share any level of similarity with the opponent’s goods in either mark. At the hearing, the opponent referred me to the catalogue evidence that shows penknives which have corkscrews, however, I note that these goods are not included in the opponent’s specifications. I have given consideration to any similarity with “drinking bottles” and “bottles” in the opponent’s marks’ specifications but the nature, method of use and purpose all differ. I accept that there is an overlap in users and that corkscrews may be found in the same homeware sections of supermarkets as bottles but I do not consider this sufficient to warrant a finding of similarity between them. Further, I do not consider that these goods have a complementary relationship. These goods are, therefore, dissimilar.

53. “Cocktail shakers” in the holder’s specification are not, in my view, commonly considered goods that are used for camping purposes. I do not consider that these goods share any level of similarity with the goods in the opponent’s marks. As with paragraph 52 above, I have considered a level of similarity with “drinking bottles” and “bottles” in the opponent’s marks’ specifications but for the same reasons set out above, I do not consider them to be similar to any degree.

#### Class 25 goods

54. “Clothing, namely, t-shirts, sweatshirts, hooded shirts and sweatshirts” in the holder’s specification covers a range of clothing goods. These are limited specifically to the type of clothes following the word ‘namely’. In my view, these are goods that fall within the broader term of “clothing” that is included within both of the opponent’s marks’ specifications. These goods are, therefore, identical under the principle outlined in *Meric*. In the event I am wrong to have allowed the opponent to rely upon “clothing” in its first mark, I have also considered the holder’s term against “clothing for hiking, for mountain use, for climbers, for winter sports and for skiing” in the opponent’s first mark. As the holder’s goods have no limitation, they can all be used for hiking purposes, for example. Therefore, I find that the

holder's terms falls within the opponent's first mark's terms. As a result, these goods are identical under the principle outlined in *Meric*.

55. "Caps and hats" in the holder's specification covers a wide range of headwear, including "caps (headwear)" and "caps" that are present in the opponent's first and second marks' specifications, respectively. These goods are, therefore, identical under the principle outlined in *Meric*.

56. "Bandanas" in the holder's specification covers a specific type of headwear. As it is not a cap, I do not consider it to be identical to "caps (headwear)" and "caps" that are present in the opponent's first and second marks' specifications, respectively. However, I do consider that these goods are similar on the basis that they are all worn on the head for either stylistic purposes or with the aim of protecting the user from the elements. In my view, these goods overlap in nature, method of use, purpose and trade channels. While there is also an overlap in users, I bear in mind that this may differ in that a wearer of a cap may not be a wearer of a bandana. As a result, I consider that they also share a competitive relationship in that the user may choose to wear a cap instead of a bandana, or vice versa. They are, therefore, similar to a high degree.

57. As some degree of similarity between goods is necessary to engage the test for likelihood of confusion, my findings above mean that the opposition aimed against those goods I have found to be dissimilar will fail.<sup>12</sup> For ease of reference, the opposition fails against the following goods in the holder's specification:

Class 21: Corkscrews, cocktail shakers.

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

58. 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*,

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<sup>12</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

*Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

59. Both parties have submitted that the average consumer is a member of the general public. I agree.

60. The goods at issue are most likely to be sold through a range of retailers, be that specific clothing or homeware retailers or supermarkets. They will also be selected via those retailers’ online or catalogue equivalents. In physical retail premises, the goods at issue will be displayed on shelves or racks, where they will be viewed and self-selected by the consumer. A similar process will apply to websites and catalogues, where the consumer will select the goods having viewed an image displayed on a webpage or in a catalogue. The selection of the goods at issue will, therefore, be primarily visual. While the visual aspect plays a greater role in the selection process, I do not discount aural considerations in the form of advice sought from sales assistants, word of mouth recommendations or telephone queries with retailers.

61. The price and frequency of purchase of the goods at issue may vary. Even where the goods are of low cost and purchased relatively frequently, a number of factors will still be considered by the average consumer during the purchasing process. For example, the consumer may consider current fashion trends, fabrics/materials used and suitability when selecting class 9 or 25 goods. However, for the class 21 goods, the average consumer will consider factors such as materials used and durability. Both parties have submitted that the average consumer will pay an

average degree of attention during the selection process. I agree with these submissions and find that the attention paid will be of an average, or medium, degree.

### Comparison of marks

62. 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.

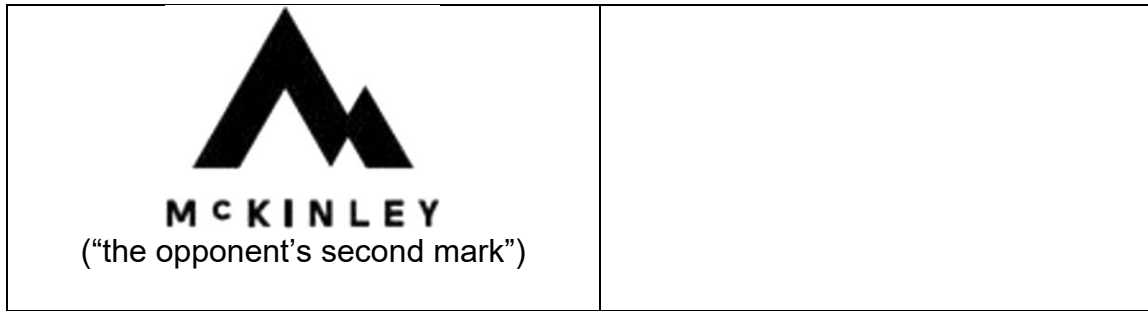
63. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“... 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.”

64. 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.

65. The respective trade marks are shown below:

| The opponent's marks                      | The IR         |
|---|----------------|
| McKINLEY<br>("the opponent's first mark") | <b>MCKIVEY</b> |



66. I have detailed submissions from both parties regarding the comparison of the marks. While I do not intend to reproduce them in full, there are some submissions that I consider necessary to address directly and I will do so where appropriate.

### Overall Impression

67. Firstly, I note that the holder submits that the common prefix ‘McK’ across the marks would be given less emphasis given how the relevant consumer perceives Scottish and Celtic-style names. On this point, the holder referred me to the decision of the GC in *Intersport International Corporation GmbH v OHIM*.<sup>13</sup> The holder referred to a point within that case wherein the GC stated “the relevant public is accustomed to the presence of Scottish and Irish family names in daily life, and is able to distinguish these marks”. While these submissions are noted, the case referred to was in respect of a comparison between MCKINLEY (stylised mark) and MCKENZIE (word mark). Firstly, this decision is not binding upon me and, secondly, the comparison of marks discussed in that case relates marks that are not subject to these proceedings. While noted, this decision will not factor into my decision.

68. As for the submissions in respect of the prefix ‘McK’, I do not agree that this element will be given less weight by the average consumer. While I appreciate that the average consumer will understand names with the prefix ‘Mc’ to be common in Scottish or Irish surnames, the names will still be viewed as wholes. In my view, to make such a finding would be to artificially dissect the marks and to essentially render the comparison between ‘INLEY’ and ‘IVEY’. As stated in the case law cited above, the average consumer normally perceives marks as wholes. Further, I do

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<sup>13</sup> Case T-502/07

not consider that the average consumer would artificially dissect the marks to the point where 'McK' would be given less weight than the remaining elements.

### *The IR*

69. The IR is a word only mark that consists of the word 'MCKIVEY'. There are no other elements that contribute to the overall impression of the IR that lies in the word itself.

### *The opponent's first mark*

70. The opponent's first mark is a word only mark that consists of the word 'McKINLEY'. Once again, there are no other elements that contribute to the overall impression of the mark that lies in the word itself.

### *The opponent's second mark*

71. The opponent's second mark consists of a word and device element. The word element reads 'McKINLEY' and the device element, that sits above the word, will, in my view, be seen as a stylised mountain peak. As the eyes are naturally drawn to the parts of marks that can be read, I am of the view that the word element plays a greater role in the overall impression of the mark with the device element playing a lesser role.

## Visual Comparison

### *The opponent's first mark and the IR*

72. These marks both start with the letters 'M-C-K-I' and end with 'E-Y'. The middle letters are different, being 'N-L' in the opponent's mark and 'V' in the IR. While the second letter in the opponent's mark is in lowercase, I note that registration of word only marks cover their use in upper and lower case letters.<sup>14</sup> Given that the average

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<sup>14</sup> *Migros-Genossenschafts-Bund v EUIPO*, Case T-189/16

consumer tends to focus of the beginnings of marks, together with the fact that the ends are also identical, I consider that these marks are similar to a high degree.

*The opponent's second mark and the IR*

73. While the opponent's second mark is not a word only mark, the word elements of these marks share the same similarities and differences as outlined at paragraph 72 above. However, an additional point of visual difference lies in the device element of the opponent's second mark. While this plays a lesser role in that mark's overall impression, it still constitutes a point of visual difference between the marks. Overall, I am of the view that these marks are visually similar to a medium degree.

Aural Comparison

74. The device element in the opponent's second mark carries no aural impact, meaning that both of the opponent's marks' aural component lies solely in the word 'McKINLEY'. This word consists of three syllables that will be pronounced 'MUH-KIN-LEE'. The IR also consists of three syllables that will be pronounced as either 'MUH-KAIV-EE' or 'MUH-KIVV-EE'. Given the identity of their beginnings and highly similar sounding endings, I consider that the marks are aurally similar to a high degree.

Conceptual Comparison

*The opponent's first mark and the IR*

75. I have submissions from both parties regarding the concept of the words 'McKINLEY' and 'MCKIVEY' on the basis that they will both be understood as a Scottish or Irish surname. The opponent argues that the use of two Scottish or Irish surnames results in a high degree of conceptual similarity whereas, on the other hand, the holder argues that while they may both be Scottish or Irish surnames, that does not automatically mean that they are conceptually similar. I also note from the parties' submissions and the evidence that the name 'McKINLEY' is taken

from the largest mountain in North America, being Mount McKinley. While noted, I do not consider that the average consumer in the UK will be aware of this.

76. While I do accept that 'McKINLEY' and 'MCKIVEY' will both be understood as surnames of Scottish or Irish origin, I have no evidence as to either names' popularity across the UK. In the absence of such, I am of the view that use of either name is not particularly widespread across the UK, especially 'McKivey'. In my view, the average consumer will understand some shared concept between them as a result of their shared use of Scottish or Irish surnames. Overall, I consider the marks are conceptually similar to a medium degree.

#### *The opponent's second mark and the IR*

77. The same findings between 'McKINLEY' and 'MCKIVEY' that I have made above apply here also. However, the opponent's second mark introduces a device element that will be seen as a stylised mountain. This will act as a further point of conceptual difference between the marks and, as a result, I consider that the marks are conceptually similar to between a low and medium degree.

#### **Distinctive character of the opponent's marks**

78. 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).”

79. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. At the hearing, the opponent did not argue that its marks had an enhanced level of distinctive character as a result of its use. Despite filing evidence, the evidence was not aimed at the UK market so the opponent submits that it is only the inherent distinctiveness of the marks that is relevant here. I agree with these submissions and, as a result, I only have the inherent position to consider.

80. At the hearing, the opponent gave detailed submissions in respect of the distinctiveness of the word ‘McKINLEY’. I do not intend to reproduce those in full save to say that the opponent submits that the marks are distinctive to between a medium and high degree. The holder did not make any submissions as to the level of distinctiveness of the opponent’s marks. It did however note that there was no claim as to whether or not there was any enhanced level of distinctive character for the opponent’s marks.

81. While I accept the holder’s position that there are a number of clothing brands that are solely a surname, I do not consider that this necessarily reduces the distinctiveness of the opponent’s mark in any way. I have set out above that I have no evidence as to the popularity of the name ‘McKinley’. In my experience its use

is not particularly widespread across the UK. As a result, when it is used on clothing, I do not consider it to be descriptive of those goods and neither do I consider it to be non-distinctive. Having said that, I do not consider that it is particularly remarkable either on the basis that it will still be recognised as a surname. In my view, the word 'McKINLEY' on the goods at issue enjoys a medium degree of inherent distinctiveness. As this is the only element of the opponent's first mark, it follows that the opponent's first mark enjoys a medium degree of inherent distinctive character.

82. As for the opponent's second mark, I do not consider that the addition of the device element of a stylised mountain, especially on outdoor clothing goods or camping crockery, for example, is particularly remarkable. While it will no doubt contribute to the distinctiveness of the character, I find that it is only to a minimal degree and not enough to elevate the distinctiveness of the mark to any higher than a medium degree. Consequently, I find that the opponent's second mark also enjoys a medium degree of inherent distinctive character.

### **Likelihood of confusion**

83. 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. 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 vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and 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 has retained in his mind.

84. I remind myself of the findings I have made throughout this decision, namely that:

- a. the holder's goods are either identical or similar to at least a medium degree with the opponent's;
- b. the average consumer for the goods at issue are members of the general public who will select them via primarily visual means (although I do not discount an aural component) whilst paying a medium degree of attention;
- c. the IR is visually and aurally similar to a high degree and conceptually similar to a medium degree to the opponent's first mark and visually similar to a medium degree, aurally similar to a high degree and conceptually similar to a between low and medium degree to the opponent's second mark; and
- d. the opponent's marks have a medium degree of inherent distinctive character.

85. In the present case, I am conscious of the fact that the goods at issue will be primarily selected visually. I am reminded of the case of *New Look Limited v OHIM*<sup>15</sup> wherein the GC noted that, when assessing the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight and that it is appropriate to examine the objective conditions under which the marks may be presented on the market. Further, I am also reminded of another GC case, *Quelle AG v OHIM*<sup>16</sup>, wherein it was found that visual similarity is most important in the case of goods that are self-selected or where the consumer sees the mark when purchasing the goods. As I have set out above, the goods at issue will be self-selected by the consumer and the visual comparison dominates the selection process of the goods at issue. As a result, I consider it appropriate to give the visual consideration greater weight when assessing likelihood of confusion.

86. Taking all of the above factors into account together with the principle of imperfect recollection, I consider that the average consumer is likely to mistake the IR and the opponent's first mark for one another. I make this finding on the basis that the marks are visually similar to a high degree meaning that the differences between

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<sup>15</sup> Joined cases T-117/03 to T-119/03 and T-171/03

<sup>16</sup> Case T-88/05

the marks may be overlooked or forgotten by the average consumer. This is particularly the case considering the fact that the beginnings and ends of the marks are identical with the only difference being in the middle of the marks. Even acknowledging the fact that both marks will be seen as surnames, I do not consider that this necessarily means that they are incapable of being misremembered or mistaken for one another. Consequently, I consider there to be a likelihood of direct confusion between the IR and the opponent's first mark in respect of those goods that I have found to be identical and of those that I have found similar to a medium degree or above.

87. Given the visual differences, I do not consider that there is a likelihood of direct confusion between the IR and the opponent's second mark. However, I will proceed to consider the likelihood of indirect confusion between those marks.

88. I bear in mind that it is possible that differences between marks may still be overlooked when it comes to indirect confusion. On this basis, I am of the view that while the device element in the opponent's second mark will be noticed, the differences between the 'McKINLEY' and 'MCKIVEY' elements will be overlooked for the same reasons set out at paragraph 86 above. As a result, I consider that the addition of the device element in the opponent's second mark, being seen as a stylised mountain peak, will be seen as indicative of an alternative mark or sub-brand from the same or economically linked undertaking.<sup>17</sup> This is particularly the case when the mark is seen on clothing for skiing purposes, for example. When comparing the marks, it is likely that the average consumer will consider the mountain device to be indicative that the brand has expanded into producing and selling goods specifically for skiing, which is an activity that commonly takes place on mountains. Consequently, I consider that there is a likelihood of indirect confusion between the opponent's second mark and the IR in respect of those goods that I have found to be identical and of those that I have found similar to a medium degree or above.

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<sup>17</sup> *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10

## CONCLUSION

89. The opposition succeeds against the majority of the goods against which it was aimed. Protection of the IR in the UK is, therefore, rejected for the following goods:

Class 9: Sunglasses.

Class 21: Beverage glassware, cups, mugs.

Class 25: Clothing, namely, t-shirts, sweatshirts, hooded shirts and sweatshirts, bandanas, caps and hats.

90. For those goods that were not opposed and those that I have found to be dissimilar, the IR may proceed to protection in the UK. Those goods are as follows:

Class 21: Corkscrews, cocktail shakers.

Class 29: Milk, chocolate milk and milk based beverages; oat milk, coconut milk, almond milk, soy milk, nut milk, rice milk, lactose-free milk.

Class 30: Hot chocolate and frozen hot chocolate; coffees, teas.

Class 32: Beer, ale, lager, stout and porter; non-alcoholic beverages, namely, carbonated beverages and non-carbonated soft drink, fruit juices, water, coconut water.

Class 33: Wine; alcoholic coffee-based beverages; alcoholic chocolate-based beverages; alcoholic beverages, except beer, containing milk, chocolate milk, oat milk, coconut milk, almond milk, soy milk, nut milk, rice milk, lactose-free milk; spirits and liqueurs; alcoholic beverages, except beer.

## **COSTS**

91. As the opponent has been successful against all but two of the goods against which its opposition was aimed, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of **£1,600** as a contribution towards its costs. The sum is calculated as follows:

|   |               |
|---|---------------|
| Preparing a notice of opposition and considering the holder's counterstatement: | £200          |
| Preparing evidence:   | £500          |
| Preparing for and attending a hearing:  | £800          |
| Official fee:   | £100          |
| <b>Total</b>  | <b>£1,600</b> |

92. I therefore order McKivey Beverages LLC to pay IIC-INTERSPORT International Corporation GmbH the sum of £1,600. This 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 12<sup>th</sup> day of January 2022**

**A COOPER**  
**For the Registrar**