BL O-0347-24

TRADE MARKS ACT 1994

IN THE MATTER OF CONSOLIDATED PROCEEDINGS

UK TRADE MARK NO 3307858 IN THE NAME OF SPORTICA INC LTD
IN RESPECT OF THE TRADE MARK:

ALPHA FORCE

AND

AN INVALIDATION THEREOF UNDER NO 504628
BY THOMAS JOHN WHITBY

Background and pleadings

1. On 1 May 2018, Sportica Inc Ltd (hereinafter 'the proprietor') applied to register **ALPHA FORCE** as a trade mark under no. 3307858. It was subsequently registered on 24 August 2018, for the following goods and services:[1]

Class 6

Metal swivels for boxing, Martial arts and MMA apparatus; metal swivels for speed bags or punch bags; metal key rings; parts and fittings for all the aforesaid goods.

Class 9

Protective clothing, mouth guards, sports helmets and protective gloves all for use in relation to boxing, MMA (Mixed martial arts), Martial Arts and Taekwondo; Knee-pads for workers.

Class 10

Knee bandages [supportive]; Knee guards in the nature of supports [other than sports articles]; Knee supports for medical use; Elasticated supports for the knee; Medical knee braces; Elasticated supports for the ankle; Elasticated supports for the elbow; Elasticated supports for the wrist; Elasticated bandages for supportive use; Wrist supports for medical use; Foot bandages [supportive]; Ankle supports for medical use; Socks (Elasticated -) for medical purposes; Compression socks for medical or therapeutic use.

Class 18

All-purpose athletic bags; Gym bags.

[1] International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

Class 28

Games and playthings, gymnastic and sporting articles; sporting equipment and apparatus; apparatus, articles and equipment for use in relation to boxing, martial arts, MMA, Taekwondo, bodybuilding and weight-training; sporting articles (padding) for protective purposes for use in relation to boxing, martial arts, MMA and Taekwondo; shaped padding for protecting parts of the body (specifically made for use in sporting activities); shields for use in Boxing, MMA, martial arts and Taekwondo; punch bags, punching balls, boxing pads; sporting hand guards; boxing hand guards; martial arts hand guards; boxing pads; hand protecting wraps; knuckle guards, body protectors, groin protectors, abdominal protectors, rib protectors, sports gloves, boxing gloves, skipping ropes, gym balls; Taekwondo mitts; Abdomen protectors for Taekwondo; Chest protectors adapted for playing the sport of taekwondo; Protective paddings for Taekwondo; Martial arts training equipment; Abdomen protectors for athletic use; Chest protectors for athletic use; Arm pads adapted for use in sporting activities; Weight lifting belts; Weight lifting gloves; Lifting grips for weight lifting; Chest protectors for sports use; Body training apparatus [exercise]; Gloves for sports; Shin guards; Shin guards [sports articles]; Shin pads; Shin pads [sports articles]; Karate shin pads; Pads for use in sports; Medicine balls; Back supports [belts] for weightlifters.

Class 35

Retail services and online retail services all connected with the sale of clothing, footwear, headgear, sporting equipment and apparatus, articles and equipment for use in relation to boxing, martial arts, MMA, Taekwondo, body-building and weight-training, sporting articles (padding) for protective purposes for use in relation to boxing, MMA, Taekwondo and martial arts, shaped padding for protecting parts of the body (specifically made for use in sporting activities), shields for use in martial arts, punch bags, punching balls, boxing pads, sporting hand guards, boxing hand guards, martial arts hand guards, boxing pads, hands wraps, knuckle guards, body protectors, groin protectors, abdominal protectors, rib protectors, sports gloves, mouth

guards, boxing gloves, boxing shoes, gym bags, skipping ropes, gym balls, weight lifting gloves, Weightlifting Belts.

2. Thomas John Whitby (hereinafter 'the cancellation applicant') seeks invalidation of the registration under the provisions of section 47 of the Trade Marks Act 1994 (the Act). He does so on grounds under section 5(2)(b) of the Act.

3. The applicant relies on UK trade mark 3237154 for the mark **Alpha Boxing** against all of the goods and services contained in the specification of the contested trade mark.

4. It relies on the following goods and services in its own registered specification:

Class 25
Clothing.

Class 28
Sporting articles and equipment.

5. In summary, the grounds are that the proprietor's use of its contested mark **ALPHA FORCE** would cause confusion with the cancellation applicant's earlier registration **Alpha Boxing**, for identical and similar goods and services.

6. The proprietor filed a counterstatement in which he denies the grounds of invalidation.

7. The proprietor filed evidence in the form of a witness statement by Ehtesham Akhtar and exhibits EA1–EA2. The applicant did not file evidence but filed submissions. Both sides filed skeleton arguments in advance of the hearing, which took place before me by video conference.

8. The applicant was represented by Robert Furneaux of Sipara Ltd. The proprietor was self-represented.

Preliminary issues

Validity of the earlier mark

9. It should be noted that after the hearing the earlier mark relied on by the applicant was cancelled. This was the result of separate proceedings under invalidation number 505360.

10. The earlier mark 'Alpha Boxing' was registered on 8 September 2017. The effective date of cancellation was 9 September 2022, this being the day after the first five years of registration.

11. Consequently, when the contested mark in this case was filed, on 1 May 2018, the earlier mark was in force and not subject to proof of use.

12. In short, the applicant can rely on the claimed earlier mark 'Alpha Boxing', for all of the goods in classes 25 and 28 of its specification.

Use of Alpha by third parties

13. In his witness statement for the proprietor, Ehtesham Akhtar provides evidence that he claims shows, "…*the word Alpha is commonly used by other parties and some top UK brands in the UK in the same classes covered by the alpha boxing trade mark in the UK, further showing as the word alpha is non distinctive for these classes it is registered for it is not capable of functioning as an indicator of trade origin."*

14. The evidence provided at EA2 shows prints taken from Amazon for sporting goods that include the word 'alpha' in the listing and sometimes on the goods themselves, such as T-shirts. These can be divided into the following categories:

a. T-shirts with the word Alpha on the front, often with large logos and outlines of men (presumably referring to the phrase 'alpha male'). These

are provided by brands such as GYMTIER and do not show brand use of the word 'alpha'.[2]

b. Listings from well-known brands of sporting goods that include the word 'alpha' in the style name. These examples do not show brand use of 'alpha' for the relevant goods and the witness has not provided any explanation as to why the consumer of these goods would think they were buying an 'alpha' product rather than a product from, inter alia, Nike,[3] Puma,[4] Red Bull[5] or Castelli.[6]

c. Evidence from companies outside the UK.

d. Evidence outside the relevant date.

15. Taken as a whole, the evidence filed by the proprietor does not show that 'alpha' is not capable of functioning as a trade mark in the sports sector.

Goodwill in the proprietor's mark

16. In its skeleton argument the proprietor makes reference to the money it has spent on advertising and promoting its trade mark and seeks to rely on *Smart Planet Technologies, Inc v Rajinda Sharm (RECUP*)[7] and the conclusions in that case concerning trivial goodwill.

17. This is not relevant to the case before me because the *RECUP* case concerns a decision in relation to a 5(4)(a) ground and the goodwill necessary to get a passing off case off the ground. This claim by the proprietor appears to be an attempt to rely on a defence based on use of the contested registered trade mark under attack which precedes the date of use or registration of the cancellation applicant's earlier mark.

[2] See, for example, page 15 of exhibit EA2.
[3] See page 16 of exhibit EA2.
[4] See page 3 of exhibit EA2.
[5] See page 38 of exhibit EA2.
[6] See page 29 of exhibit EA2.
[7] BL O/304/20.

18. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton and Another*,[8] Ms Carboni rejected the defence as being wrong in law.

19. As a consequence of that decision the UKIPO issued a tribunal practice notice (TPN) which included the following:[9]

> *"5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker's mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark."*

20. In other words, if the proprietor wanted to rely on a right claimed to be senior to that relied on by the cancellation applicant, the correct course of action was to seek to invalidate the earlier right relied on by the cancellation applicant.

<u>How the proprietor is using its mark</u>

21. The proprietor also seeks to rely on the significant use it has made of its mark in the UK. In *Devinlec Développement Innovation Leclerc SA v OHIM,*[10] the Court of Justice of the European Union (CJEU) stated that:

> "59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and

[8] BL O-211-09.
[9] See TPN 4/2009.
[10] Case C-171/06P.

depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks."

22. In other words, the way in which the proprietor is actually using its trade mark at this point is not a factor that is relevant to the decision. Rather, I must consider all normal and fair uses of the contested mark. The same applies to the cancellation applicant's earlier mark.

No confusion in the market

23. The proprietor makes the following submission in its skeleton argument:

"4. …The applicant mark and proprietor mark co-existed in the market with NO confusion for well above 5 years."

24. In *The European Limited v The Economist Newspaper Ltd*[11] Millett LJ stated:

"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark."

25. Further, in Compass Publishing BV v Compass Logistics Ltd,[12] Laddie J held:

"22. It is frequently said by trade mark lawyers that when the proprietor's mark and the defendant's sign have been used in the market place but no confusion has been caused, then there cannot exist a likelihood of confusion under Article 9.1(b) or the equivalent provision in the Trade Marks Act 1994 ("the 1994 Act"), that is to say s. 10(2). So, no confusion in the market place means no infringement of the registered trade mark. This is, however, no more than a rule of thumb. It must be borne in mind that the

[11] [1998] FSR 283.
[12] [2004] RPC 41

provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place."

26. In short, this submission does not help the proprietor and I will say no more about it.

DECISION

27. 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 that predate the UK's withdrawal from the EU.

28. The relevant part of section 47 reads:

"47. - (2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground –

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain,
or

(b) …

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration."

29. Section 5(2)(b) of the Act states:

"5. - (2) A trade mark shall not be registered if because -

(a)…

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

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

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods and services

31. When making the comparison, all relevant factors relating to the goods and services in the specification should be taken into account. In *Canon*, the CJEU stated at paragraph 23 of its judgment:

> "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".

32. Guidance on this issue has also come from Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Ltd* (the *Treat* case), [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

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

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

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

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

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

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

33. In *Gérard Meric v OHIM,*[13] 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".

34. The services must be given their ordinary and natural meanings. In *YouView Ltd v Total Ltd*,[14] Floyd J. stated:

"...Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question".

[13] *Case T- 133/05*
[14] [2012] EWHC 3158 (Ch) at [12].

35. 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 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".

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

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

37. Whilst on the other hand:

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

38. The cancellation applicant has made submissions regarding the terms in each of the classes in the contested mark. I will refer to these as necessary throughout the comparison.

39. The proprietor submits the following, with regard to the goods and services comparison (reproduced as written):[15]

> *"3. The applicant assertion that they share same nature or purpose or use is factually not true and is denied. Even if only some of the goods does, this is not a ground for confusion. Neither applicant goods are in direct competition with Proprietor goods and services. Just as an example, some of the proprietor goods are special safety equipment which are sold mostly in medical stores or specialised safety retail stores. The respective goods are not sold through same channels and the applicant for cancellation has NOT provided any evidence for that."*

40. The goods and services to be compared are as follows:

Cancellation Applicant's Goods	**Proprietor's goods and services**
	Class 6 Metal swivels for boxing, Martial arts and MMA apparatus; metal swivels for speed bags or punch bags; metal key rings; parts and fittings for all the aforesaid goods.
	Class 9 Protective clothing, mouth guards, sports helmets and protective gloves all for use in relation to boxing, MMA (Mixed martial arts), Martial Arts and Taekwondo; Knee-pads for workers.

[15] See the proprietor's skeleton argument, dated 11 August 2023.

	Class 10 Knee bandages [supportive]; Knee guards in the nature of supports [other than sports articles]; Knee supports for medical use; Elasticated supports for the knee; Medical knee braces; Elasticated supports for the ankle; Elasticated supports for the elbow; Elasticated supports for the wrist; Elasticated bandages for supportive use; Wrist supports for medical use; Foot bandages [supportive]; Ankle supports for medical use; Socks (Elasticated -) for medical purposes; Compression socks for medical or therapeutic use.
	Class 18 All-purpose athletic bags; Gym bags.
Class 25 Clothing.	
Class 28 Sporting articles and equipment.	Class 28 Games and playthings, gymnastic and sporting articles; sporting equipment and apparatus; apparatus, articles and equipment for use in relation to boxing, martial arts, MMA, Taekwondo, bodybuilding and weight-training; sporting articles (padding) for protective purposes for use in relation to boxing,

	martial arts, MMA and Taekwondo; shaped padding for protecting parts of the body (specifically made for use in sporting activities); shields for use in Boxing, MMA, martial arts and Taekwondo; punch bags, punching balls, boxing pads; sporting hand guards; boxing hand guards; martial arts hand guards; boxing pads; hand protecting wraps; knuckle guards, body protectors, groin protectors, abdominal protectors, rib protectors, sports gloves, boxing gloves, skipping ropes, gym balls; Taekwondo mitts; Abdomen protectors for Taekwondo; Chest protectors adapted for playing the sport of taekwondo; Protective paddings for Taekwondo; Martial arts training equipment; Abdomen protectors for athletic use; Chest protectors for athletic use; Arm pads adapted for use in sporting activities; Weight lifting belts; Weight lifting gloves; Lifting grips for weight lifting; Chest protectors for sports use; Body training apparatus [exercise]; Gloves for sports; Shin guards; Shin guards [sports articles]; Shin pads; Shin pads [sports articles]; Karate shin pads; Pads for use in sports; Medicine balls; Back supports [belts] for weightlifters.
	<u>Class 35</u>

	Retail services and online retail services all connected with the sale of clothing, footwear, headgear, sporting equipment and apparatus, articles and equipment for use in relation to boxing, martial arts, MMA, Taekwondo, body-building and weight-training, sporting articles (padding) for protective purposes for use in relation to boxing, MMA, Taekwondo and martial arts, shaped padding for protecting parts of the body (specifically made for use in sporting activities), shields for use in martial arts, punch bags, punching balls, boxing pads, sporting hand guards, boxing hand guards, martial arts hand guards, boxing pads, hands wraps, knuckle guards, body protectors, groin protectors, abdominal protectors, rib protectors, sports gloves, mouth guards, boxing gloves, boxing shoes, gym bags, skipping ropes, gym balls, weight lifting gloves, Weightlifting Belts.

Class 6

41. The proprietor's goods in class 6 are metal swivels, metal keyrings and parts and fittings for the same. Having carried out the relevant tests concerning users, uses, nature, trade channels, whether the goods are in competition and whether they have a complementary relationship, there is clearly no similarity between these goods and the cancellation applicant's 'clothing' in class 25.

42. In addition, I do not find the proprietor's metal keyrings to be similar to any of the goods in the cancellation applicant's specification in class 28.

43. With regard to metal swivels, the cancellation applicant has sporting articles and equipment in class 28, which will include goods such as punch bags and speed bags that may be attached to the proprietor's metal swivels in class 6. However, the users of the goods are likely to be different - the metal goods are parts that are likely to be used primarily by the manufacturers of the sporting goods or someone who is setting up the relevant piece of sporting equipment, rather than the end users of punch bags or speed bags. The uses are different. A consumer using a punch bag will use it for training and exercise. A person buying the proprietor's class 6 metal goods will be using them to support or attach a punch bag or similar. The nature of the goods is different as are the trade channels. The goods are unlikely to be sold in the same areas of shops or on websites and the goods are not in competition. There is complementarity to the extent that a swivel may be needed in order to use a punch bag. Overall, I find these goods to be dissimilar.

Class 9

44. The proprietor's 'protective clothing and protective gloves all for use in relation to boxing, MMA, Martial Arts and Taekwondo', are, for the most part, different from the cancellation applicant's 'clothing' in that the proprietor's goods are primarily worn for protection rather than for their aesthetic purpose. That said, the high point of similarity is between protective clothing (used for the sports named above) in class 9 of the proprietor's specification and clothing (worn for the same sports) in class 25 of the cancellation applicant's earlier mark. In this example the users and uses may be the same, namely people engaging in Boxing, MMA, Martial Arts or Taekwondo. Furthermore, the same undertaking may manufacture a range of sport-specific equipment and sportswear. These goods may be made available via the same specialized shops, online or in bricks and mortar stores. They may also reach the market through the same trade channels, such as suppliers or manufacturers of products for contact sports. The nature of the goods will be different, one being primarily to protect the body and the other being aesthetic or simply covering the body. Overall, I find these goods to be similar to a low degree.

45. The cancellation applicant's sporting articles in class 28 will include goods such as hand wraps, guards and various types of padding for sports. The users of these goods

may be the same as the users for the proprietor's protective goods in class 9. The uses will also be similar, being for participation in contact sports. The nature of the goods are similar to the extent that they are protective, but differ in the fact that the cancellation applicant's goods are the pads themselves and the proprietor's goods are items of protective clothing with padding/armour built into the garment. There may well be an overlap in trade channels and the goods may be in competition. A user could choose padding to wear under non-protective clothing, or may select clothing with built-in protection. There is also a complementary relationship between the goods to the extent that the proprietor's protective clothing may include padding of the type included within the cancellation applicant's sporting articles. I find these goods to be similar to a low-to-medium degree.

46. The proprietor's mouth guards all for use in relation to boxing, MMA, Martial Arts and Taekwondo are not similar to the cancellation applicant's clothing, which has different users, uses, nature, trade channels, is not in competition and does not have a complementary relationship with those goods that are for the protection of the users' mouth during contact sports. I find these goods dissimilar. I also find the same in respect of the cancellation applicant's 'sporting articles' in class 28, which are articles used for sport that do not include protective equipment of the type contained in class 9.

47. The proprietor has 'sports helmets' in class 9, while the cancellation applicant has 'clothing' in class 25, which does not include headgear. Sports helmets are used for protection of the user's head during sport. Clothing is worn to cover the body and in class 25 does not include protective clothing. The users, uses, natures and trade channels are different. They goods are not in competition and are certainly not complementary. I find these goods to be dissimilar.

48. The cancellation applicant's 'sporting articles' in class 28 will include some items of sports padding for the body. Both the proprietor's 'sports helmets' and 'padding' will be used to protect the body during sport. However, the nature of the goods is different. Sports helmets are specialist purchases with specific performance and fit requirements. Padding for sports is more likely to be an 'off-the-shelf' purchase. There may be some overlap in trade channels. The goods are not in competition, and I do

not find them to be complementary in the sense that either is necessary for the other nor do I find that the consumer of such goods could reasonably expect them to be provided by the same undertaking. I have borne in mind that helmets will include padding but this will be very different in nature to body padding. I find these goods dissimilar.

49. The proprietor has 'knee pads for workers' in class 9. These goods are protective goods to pad the knees of someone carrying out work. There is no similarity between these goods and the cancellation applicant's clothing in class 25 (protective clothing which may include reinforced knee areas is proper to class 9 and is not included within the broad term 'clothing' in class 25). In addition, whilst the cancellation applicant has sport's padding within 'sporting articles' in class 28, the users and uses of the goods is different, as is their nature. Sports padding will be light and comfortable to wear whilst engaging in sporting activities, whereas knee pads will be worn to reduce pressure on the knees whilst carrying out physical work and are likely to be made from hard-wearing materials. The trade channels will be different for specialist sports equipment and workwear. The goods are not in competition, and they are not complementary. I find these goods to be dissimilar.

Class 10

50. The proprietor's goods in this class are medical supports, braces and compression socks. They will be used by someone with a weakness or injury in a particular part of their body that needs support, rest or rehabilitation. Such goods may be used by people who engage in sporting activity, but the goods could not be said to be 'sporting articles or apparatus' that are used to enable someone to take part in a particular sport. The nature of the goods is likely to be different, the trade channels will also differ and the goods are unlikely to be sold in close proximity, either online or in stores. The proprietor's goods in class 10 have a medical purpose and will be bought from specialist medical retailers or the medical areas of larger stores or websites. The goods are not in competition and are not complementary to any extent that would be relevant in a finding of similarity. Someone engaging in sport may require a medical brace or support at some point, but that does not mean that sporting goods and medical goods have a complementary relationship. I find the proprietor's class 10 goods to be dissimilar to the cancellation applicant's goods in classes 25 and 28.

Class 18

51. The proprietor has ‘all purpose athletic bags’ and ‘gym bags’ in this class. The cancellation applicant has ‘sporting articles’ in class 28, which includes specially adapted sports bags, such as, inter alia, golf bags and tennis racket bags.

52. The cancellation applicant submits:[16]

> *“The Cancellation Applicant's ‘Sporting articles and equipment’ would include bags adapted for sporting articles and so are identical or highly similar to the Proprietor's goods in class 18 ‘all purpose athletic bags; Gym bags’. The class 28 goods are the same in nature, purpose, channels of trade, retail circumstances and consumer to the gym bags in Class 18 of the opponents' specification, and are similar goods. Examples would be bags that are specially adapted, e.g. to carry wet swimming gear, to carry footballs or rugby balls, bags adapted to carry rock climbing kit, cricket, tennis or hockey bags adapted to carry the respective items for that sport. The products are they are likely to be of the same material and the specially adapted bags and the unadapted bags could be substituted for one another. They are, therefore in competition, and both types of bags could be for sale in the same specialist shops or in the same areas of non-specialist shops and are similar goods.”*

53. The users and uses of the bags may overlap to some extent, though specially adapted bags will be of little use for carrying a variety of bulky items, as they are shaped for the specific sporting item they are designed to carry. The natures of the bags will be different. The proprietor’s bags are likely to have a fairly large compartment with added pockets for small items, water bottles and so on. The cancellation applicant’s bags will be in many forms specific to a particular sport, for example a golf bag, a ski bag or a tennis racket bag. None of these sport-specific bags are likely to be used as a gym or general purpose bag. The goods are not in competition, nor are they complementary. I find these goods to be dissimilar.

[16] See paragraph 6 of the cancellation applicant’s skeleton argument, dated 10 August 2023.

Class 28

54. The proprietor has, ‘gymnastic and sporting articles’ and ‘sporting equipment and apparatus’. The cancellation applicant has, ‘sporting articles and equipment’. Clearly the terms ‘sporting articles’ and ‘sporting equipment’ are identical. The proprietor’s ‘gymnastic articles’ falls within the broader term, ‘sporting articles’ in the earlier specification, in accordance with the principle in *Meric*. The same is true with regard to ‘sporting apparatus’ and ‘gymnastic articles’ in the proprietor’s specification, as they also fall within the broader term in the earlier specification. These goods are identical.

55. The proprietor’s ‘apparatus, articles and equipment for use in relation to boxing, martial arts, MMA, Taekwondo, bodybuilding and weight-training’ and ‘sporting articles (padding) for protective purposes for use in relation to boxing, martial arts, MMA and Taekwondo’, are included in the cancellation applicant’s general term, ‘sporting articles and equipment’.

56. I also find the following specific items of sporting equipment to be included in the cancellation applicant’s broad term, ‘sporting articles and equipment’:

> ‘Shaped padding for protecting parts of the body (specifically made for use in sporting activities); shields for use in Boxing, MMA, martial arts and Taekwondo; punch bags, punching balls, boxing pads; sporting hand guards; boxing hand guards; martial arts hand guards; boxing pads; hand protecting wraps; knuckle guards, body protectors, groin protectors, abdominal protectors, rib protectors, sports gloves, boxing gloves, skipping ropes, gym balls; Taekwondo mitts; Abdomen protectors for Taekwondo; Chest protectors adapted for playing the sport of taekwondo; Protective paddings for Taekwondo; Martial arts training equipment; Abdomen protectors for athletic use; Chest protectors for athletic use; Arm pads adapted for use in sporting activities; Weight lifting belts; Weight lifting gloves; Lifting grips for weight lifting; Chest protectors for sports use; Body training apparatus [exercise]; Gloves for sports; Shin guards; Shin guards [sports articles]; Shin pads; Shin pads [sports articles]; Karate shin pads;

Pads for use in sports; Medicine balls; Back supports [belts] for weightlifters.'

57. With regard to the similarity between the proprietor's 'games and playthings' and its own specification, the cancellation applicant submits:[17]

> *"'Games and playthings' would include electronic games (including those games based upon a range of sports), board games such as table football, games such as darts and playthings for children such as mini rugby balls, soft play equipment based on various sports (e.g. bowls) etc. These goods are identical or highly similar to the Cancellation Applicant's "sporting articles and equipment", the respective users may be the same, the games may utilise similar accessories (such as hockey sticks and footballs) and as both may involve varying degrees of physical activity, there is a medium to high degree of similarity."*

58. I agree that 'games and playthings' include electronic games and that those games may have a sporting theme. However, the users will only overlap at the highest level, being members of the general public, the uses are different, sporting articles being used for fitness and competition and electronic games being used for entertainment. The nature of an electronic game and a sporting article are different. I note the cancellation applicant's point concerning game accessories that may be in the shape of a sporting article, but these will have electronic components that enable them to interact with an electronic game and would be unlikely to be suitable for use in the particular related sport. The trade channels are different, and the goods are unlikely to be sold in the same areas of stores or websites. The goods are clearly not in competition and are not complementary. I find these goods to be dissimilar.

59. The same is true of board games and table-top games with sporting themes. These goods are used for entertainment and not to take part in sport. Their natures are clearly different, as are the trade channels by which they reach the market. They are not in competition, nor are they complementary. I find these goods to be dissimilar.

[17] See paragraph 6 of the cancellation applicant's skeleton argument, dated 10 August 2023.

60. ‘Playthings’ are for entertainment and not for sport. With regard to toy versions of sporting articles, the users will be different as will the uses. Playthings are more likely to be bought in the toy area of a large store of from a specific toy shop, either online or in a store. Sporting articles, on the other hand, will be bought from sports shops or specialist retailers. The goods are not in competition and they are not complementary. I find these goods to be dissimilar.

Class 35

61. With regard to the proprietor’s retail services, the cancellation applicant relies on *XL Groups Ltd v YOOX Net-A-Porter Group S.p.A.* and submits:[18]

> *“…the Proprietor’s retail services in class 35 are complementary to the Cancellation Applicant’s goods in class 28. This is because the Applicant’s goods, ‘Sporting articles and equipment’ cover the goods listed in the retail services.”*

62. Goods and services are different in nature, purpose and method of use. The General Court in *Oakley, Inc v OHIM*[19] stated that retail services for particular goods may be complementary to those goods and distributed through the same trade channels, making them similar to a degree.

63. In *Tony Van Gulck v Wasabi Frog Ltd (“Miss Boo”)*, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, cautioned that “selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35”.[20] The objective of retail services as set out in Oakley, “includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction” and “those services play, from the point of view of the relevant consumer, an important role when he comes to buy the goods offered for sale.” On the basis of the European courts’ judgments in *Sanco SA v OHIM*, and *Assembled*

[18] BL O-206-22, pages 41 and 42.
[19] Case T-116/06, at paragraphs 46-57.
[20] BL O/391/14.

Investments (Proprietary) Ltd v. OHIM, upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*, Mr Hobbs concluded that:[21]

> i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;
>
> ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;
>
> iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;
>
> iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

64. I note the cancellation applicant's submission that its goods, '*Sporting articles and equipment'* cover the goods listed in the proprietor's retail services. This is not the complete picture, as the proprietor's retail services include other goods as well as sporting articles.

65. However, I will begin with the assessment of goods that are in class 28 ('*Sporting articles and equipment')* and feature as retailed goods in the proprietor's specification.

66. The goods are self-evidently different in nature to retail services. The intended purpose of sporting articles is to enable the consumer to take part in sporting activities.

[21] Case C-411/13P; Case T-105/05, at paragraphs [30] to [35] of the judgment; and, Case C-398/07P.

67. The intended purpose of retail services is to encourage the sale of sporting articles, which means that the purpose of the goods/services is different. The goods are not in competition with the services and their method of use also differs.

68. As the intended purpose of the proprietor's retail services connected to the sale of sporting articles is to encourage the sale of the same, I find that the proprietor's retail services for the listed sporting articles are complementary to the cancellation applicant's sporting articles in class 28 because goods included in the cancellation applicant's broad term 'sporting articles' are specified as the subject of the retail services. The goods are indispensable to the retail services relating to them. In addition to the complementary relationship between the goods and the retailing thereof, there is an overlap in the trade channels through which the goods and services reach the average consumer and the goods and the retail service will be directed at the same consumers (people who want to buy sporting articles). I find that there is a medium degree of similarity between the cancellation applicant's sporting articles in class 28 and the proprietor's retail services for the following:

> *Retail services and online retail services all connected with the sale of sporting equipment and apparatus, articles and equipment for use in relation to boxing, martial arts, MMA, Taekwondo, body-building and weight-training, sporting articles (padding) for protective purposes for use in relation to boxing, MMA, Taekwondo and martial arts, shaped padding for protecting parts of the body (specifically made for use in sporting activities), shields for use in martial arts, punch bags, punching balls, boxing pads, sporting hand guards, boxing hand guards, martial arts hand guards, boxing pads, hands wraps, knuckle guards, body protectors, groin protectors, abdominal protectors, rib protectors, sports gloves, boxing gloves, boxing shoes, gym bags, skipping ropes, gym balls, weight lifting gloves, Weightlifting Belts.*

69. I apply the same reasoning to the cancellation applicant's 'clothing' in class 25 compared with the proprietor's retail of clothing in class 35. I find these goods and services to be similar to a medium degree.

70. The proprietor also has '*Retail services and online retail services connected with the sale of footwear and headgear'.* The cancellation applicant does not have any footwear or headgear goods in its specification. Consequently, there is no similarity between the proprietor's retail services relating to footwear and headgear and anything in the cancellation applicant's specification. The same is true of the proprietor's '*Retail services and online retail services connected with the sale of mouth guards'.*

The average consumer and the nature of the purchasing act

71. 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*[22], 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 word 'average' denotes that the person is typical. The term 'average' does not denote some form of numerical mean, mode or median."

72. The cancellation applicant submits that the average consumer is a 'general consumer' who pays a medium degree of attention. It further submits:[23]

> *"The goods involved are all sports-related goods and mostly revolved around purchases walking through a store or online although products can also be ordered on the telephone or advice obtained verbally from shop assistants. They are relatively inexpensive goods. The goods (and*

[22] [2014] EWHC 439 (Ch).
[23] See paragraph 7 of the cancellation applicant's skeleton argument.

services) do not require extensive research by the consumer, the main focus is price, and some consideration of function and style."

73. I agree that the average consumer is a member of the general public for a large number of the goods and services at issue. However, some of the goods such as, inter alia, punch bags and martial arts pads may also be bought by gyms or other professionals for use by their customers. Most of the goods will be bought online from a website or instore from a sports shop or general retailer and will be a primarily visual purchase. However, I do not rule out an aural element where advice is sought or word of mouth recommendation plays a part. The same is true of the retail services. The majority of goods and services will require no more than a medium degree of attention to be paid to their purchase, although when buying for a business or when buying safety equipment, such as sports helmets, the level of attention paid will be a little higher.

Comparison of marks

74. The marks to be compared are as follows:

The cancellation applicant's mark	**The proprietor's mark**
Alpha Boxing	ALPHA FORCE

75. In making a comparison between the marks, I must consider the respective marks' visual, aural and conceptual similarities with reference to the overall impressions created by them, bearing in mind their distinctive and dominant components but

without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.[24]

Overall impression

76. The cancellation applicant submits that ALPHA is the more dominant and distinctive element of the marks, being placed at the beginning. With regard to the 'FORCE' and 'Boxing' parts of the marks the cancellation applicant says:

> *12. Further, when considering the secondary elements of the mark, Boxing is self-evidently descriptive or non-distinctive for the goods concerned. Especially when considering the combat sports field, the term "FORCE" would also be seen as descriptive or non-distinctive e.g. the force from a strike or the force from a judo throw.*

77. The proprietor submits that the 'ALPHA' element in both parties' marks is non-distinctive. This is based on the evidence that I have already considered as a preliminary matter and have determined to be insufficient to draw the conclusions made by the proprietor. The proprietor concludes (reproduced as written):

> *"The word FORCE in proprietor mark is very distinctive and dominates the overall impression and will draw more of the consumer's attention."*

78. The cancellation applicant's mark is the two words 'Alpha' and 'Boxing'. The words are presented in title case, in black and in a standard typeface, with no other elements or stylisation. Given that 'Boxing' describes the nature of the business and purpose of the goods, the word 'Alpha' plays the larger role in the overall impression of the mark.

79. The proprietor's mark is made up of the two words 'ALPHA' and 'FORCE'. The mark is presented in upper case, in black and in a standard typeface, with no other elements or stylisation. I disagree with the proprietor's view that 'FORCE' is the dominant element of its mark. The word 'ALPHA' does qualify the word 'FORCE' and

[24] *Sabel v Puma AG,* para.23.

I find that the overall impression rests in the whole mark with no single element being dominant.

Visual similarity

80. Visually, both marks begin with the word ALPHA. The difference between the marks is in their second words, 'FORCE' in the contested registration and 'Boxing' in the earlier mark. Nothing turns on the difference in case between the contested mark and the cancellation applicant's earlier mark because fair and notional use of a mark registered in plain text would include use in upper or lower case. Visually, I find these marks to be similar to a medium degree.

Aural similarity

81. The proprietor submits:

> *"8. The conspicuous differences in length and in the number of sounds and in syllables between the signs at issue which clearly affect the rhythm and intonation in their respective pronunciations, have a significant impact on the …aural impression that the public has of them. Hence, the signs are …aurally similar to a very low degree."*

82. Aurally, both marks begin with the word ALPHA. In both marks this will be pronounced as two syllables, AL-FA. The second word in the contested mark is FORCE, which is a common dictionary word and will be pronounced as one syllable. The second word in the cancellation applicant's earlier mark is Boxing, which is a common word and will be pronounced as two syllables, Box-ing. The earlier mark is four syllables in length, one syllable longer than the contested mark and they share the first two syllables. Overall, I find the marks aurally similar to a medium degree.

Conceptual similarity

83. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.[25]

84. With regard to conceptual similarity, the cancellation applicant submits:

> *15. …the word "ALPHA" means the first letter in the Greek alphabet. It can also mean "the highest grade or mark, as in an examination" or less commonly and in context, it may "denote the dominant person or animal in a group". The second words in the marks, "Boxing" and "FORCE", both suggest the concept of fighting. As such, the two elements are similar and the perceived meanings of both marks are highly similar.*
>
> *17. In summary, there is a medium to high degree of similarity between the Contested Mark and the Earlier Mark.*

85. The proprietor submits:

> *9. Conceptually the applicant mark and proprietor mark are completely dissimilar as proprietor mark/term alpha FORCE is used worldwide in armed forces or military as an elite Force to respond to emergencies. Whereas the applicant mark has no meaning to relevant consumers leading to the fact that the applicant and proprietor marks are completely dissimilar. There is absolutely no confusion between the applicant mark and proprietor mark.*

86. There is no evidence to support the proprietor's view that 'ALPHA FORCE' means an elite military emergency force and, in order to be relevant, the conceptual message a trade mark conveys must be capable of immediate grasp by the average consumer. I agree with the cancellation applicant that 'ALPHA' will likely be seen as meaning the

[25] This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM [2006]* e.c.r.-I-643; [2006] E.T.M.R. 29.

highest grade, the best or primary, which when used with the word 'Boxing' for sports goods will be seen to mean some form of premium or ultimate boxing brand. 'ALPHA' will have the same meaning in the proprietor's mark and when combined with 'FORCE' may be seen a premium group or as the best or highest level of force. Given that the proprietor's goods are all related to boxing and martial arts, the word 'FORCE' will likely allude to power. To the extent that both marks contain the word 'ALPHA' with a second word that relates to the relevant sport and to the power used in the relevant sports, there is at least a medium degree of conceptual similarity between these marks.

Distinctive character of the earlier mark

87. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the services for which it has been used as coming from a particular undertaking and thus to distinguish those services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger.*[26]

88. The proprietor has made many comments concerning the lack of distinctiveness of the 'ALPHA' element in the earlier mark and I have explained why the evidence provided falls short of demonstrating that to be the case. I must, in any case, in accordance with the decision in *Formula One*, give the earlier mark at least a minimal level of distinctiveness, as it was validly registered during the relevant period. Whilst the 'Boxing' element of the earlier mark is descriptive of the purpose of the goods, in combination 'Alpha' Boxing' is a normal trade mark that is distinctive to a little lower than medium degree.

Likelihood of confusion

89. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled

[26] Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

perfectly, the consumer relying instead on the imperfect picture of them that they have kept in mind.[27] I must also keep in mind the average consumer for the services, the nature of the purchasing process and have regard to 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 services and vice versa.

90. I have made the following findings:

- The average consumer is a member of the general public for most of the goods and services, but does include some professional buyers, for example, gyms.
- The purchase will be primarily visual, though I do not rule out an aural element where word-of-mouth recommendation plays a part.
- The level of attention paid to the purchase will be at least medium, with some goods and services requiring a slightly higher level of attention to be paid, such as safety equipment and sports helmets.
- The parties' marks are visually and aurally similar to a medium degree. They are conceptually similar to at least a medium degree.
- The inherent distinctiveness of the earlier 'Alpha Boxing' mark is a little lower than medium degree of inherent distinctive character.
- There is similarity between some of the goods in classes 9, 28, 35 and the earlier specification.
- Classes 6, 10 and 18 are dissimilar to the goods in the earlier specification.

91. Some similarity of services is essential to engage the likelihood of confusion assessment.[28] In *eSure Insurance v Direct Line Insurance,*[29] Lady Justice Arden stated that:

> "49... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served

[27] *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27.
[28] See *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU).
[29] [2008] ETMR 77 CA.

by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

92. Accordingly, there can be no likelihood of confusion for the following goods and services in the proprietor's specification:

Class 6

Metal swivels for boxing, Martial arts and MMA apparatus; metal swivels for speed bags or punch bags; metal keyrings; parts and fittings for all the aforesaid goods.

Class 9

Mouth guards; sports helmets; knee pads for workers.

Class 10

Knee bandages [supportive]; Knee guards in the nature of supports [other than sports articles]; Knee supports for medical use; Elasticated supports for the knee; Medical knee braces; Elasticated supports for the ankle; Elasticated supports for the elbow; Elasticated supports for the wrist; Elasticated bandages for supportive use; Wrist supports for medical use; Foot bandages [supportive]; Ankle supports for medical use; Socks (Elasticated -) for medical purposes; Compression socks for medical or therapeutic use.

Class 18

All purpose sports bags and gym bags.

Class 28

Games and playthings.

Class 35

Retail services and online retail services connected with the sale of footwear, headgear and mouthguards.

93. The types of confusion were explained in *L.A. Sugar Limited v By Back Beat Inc*,[30] by Mr Iain Purvis Q.C., sitting as the Appointed Person:

> "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'.

94. I also bear in mind *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors*[31], in which Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria*[32], where he said at [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.

95. The proprietor submits the following with regard to the likelihood of confusion:

[30] BL O/375/10.
[31] [2021] EWCA Civ 1207.
[32] BL O/219/16.

10. In Duebros Limited v Heirler Cenovis GmbH, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark.

The fact that the only common element the contested mark and earlier mark share is the term alpha is therefore not enough."

96. Mr Mellor Q.C. (as he then was) concluded that this is mere association, not indirect confusion. With regard to the 'common element', I bear in mind *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

"38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it."

97. That is not to say that weak distinctive character of an earlier trade mark precludes a likelihood of confusion. In *L'Oréal SA v OHIM*,[33] the CJEU found that:

[33] Case C-235/05 P.

> "45. The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders."

98. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

99. In this case, the earlier mark is 'Alpha Boxing'. I have found the mark to have a little lower than medium degree of inherent distinctive character. It is perfectly capable of operating as an effective trade mark in the relevant sector. The Alpha part of the mark is the dominant part, Boxing being descriptive of the sport to which the applicant's goods relate. The contested registration is 'ALPHA FORCE', the common element shared by both parties' marks being 'ALPHA', though as I have already found, FORCE plays a part in the proprietor's mark.

100. A consumer familiar with Alpha Boxing providing a range of boxing-related sports equipment is likely to see the proprietor's ALPHA FORCE for goods relating to, inter alia, Taekwondo or MMA as a brand extension of that business – Alpha Boxing being the boxing arm of the company and ALPHA FORCE being the martial arts part of the company. I find that for goods and services where there is any degree of similarity, the

use of the proprietor's mark will give rise to a likelihood of indirect confusion with the opponent's earlier Alpha Boxing mark.

The opposition partially succeeds under sections 47 and 5(2)(b) of the Act.

Conclusion

101. The proprietor's mark can remain registered for the following goods and services:

Class 6

Metal swivels for boxing, Martial arts and MMA apparatus; metal swivels for speed bags or punch bags; metal key rings; parts and fittings for all the aforesaid goods.

Class 9

Mouth guards; sports helmets; knee pads for workers.

Class 10

Knee bandages [supportive]; Knee guards in the nature of supports [other than sports articles]; Knee supports for medical use; Elasticated supports for the knee; Medical knee braces; Elasticated supports for the ankle; Elasticated supports for the elbow; Elasticated supports for the wrist; Elasticated bandages for supportive use; Wrist supports for medical use; Foot bandages [supportive]; Ankle supports for medical use; Socks (Elasticated -) for medical purposes; Compression socks for medical or therapeutic use.

Class 18

All purpose sports bags and gym bags.

Class 28

Games and playthings.

Class 35

Retail services and online retail services connected with the sale of footwear, headgear and mouthguards.

The remaining goods and services will be cancelled from the date of application.

COSTS

102. The opponent's claim under the 5(2)(b) ground was partially successful, with both parties achieving a measure of success. I find that the parties should bear their own costs except for the official fee of £100.

103. I order Sportica Inc Ltd to pay Thomas John Whitby the sum of £100. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 16th day of April 2024

Al Skilton
For the Registrar,