

O/0363/24

CONSOLIDATED PROCEEDINGS

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION
NO. UK00003776427 BY NASSER SADDIQ
TO REGISTER:**



IN CLASS 25

AND

**IN THE MATTER OF THE OPPOSITION
THERE TO UNDER NO. 435292
BY 1661, INC.**

AND

**IN THE MATTER OF REGISTRATION
NO. UK002359645 IN THE NAME OF 1661, INC.
FOR THE FOLLOWING TRADE MARK:**

GOAT

IN CLASS 25

AND

**AN APPLICATION FOR A DECLARATION
OF INVALIDITY UNDER NO. 505701 BY
NASSER SADDIQ**

BACKGROUND AND PLEADINGS

1. These are consolidated proceedings between Mr Nasser Saddiq (“Mr Saddiq”) and 1661, Inc. (“1661”) wherein each party has brought proceedings against the other. I will begin by summarising the nature of those proceedings in turn.

1661’s opposition

2. On 11 April 2022, Mr Saddiq applied to register the following trade mark in the UK:



(“Mr Saddiq’s mark”)

3. Mr Saddiq’s mark was filed under UK registration number 3776427 and registration was sought for the following goods:¹

Class 25: Clothing; footwear; headgear; athleisure; articles of sports clothing; anoraks; anoraks; anti-sweat underclothing; articles of clothing; articles of outer clothing; articles of sports clothing; articles of underclothing; athletic clothing; athletic footwear; bandanas; baseball caps and hats; baseball shoes; baseball uniforms; bathing suits; beach clothing; beach hats; beachwear; belts; blazers; boots; caps; chemises; childrens' clothing; children's footwear; children's headwear; clothes; clothing; clothing for sports; coats; dresses; footwear; footwear for sports; gilets; gloves; hats; headgear; hooded tops; hoodies; jackets;

¹ I note that during these proceedings, a TM21B was filed to amend the specification. This is a point that requires further discussion as a preliminary issue below.

jeans; jerkins; jerseys; jumpers; leather clothing; men's clothing; outerwear; parkas; pyjamas; scarfs; shirts; shoes; shorts; sleepwear; sneakers; sportswear; socks; sweaters; sweatshirts; ties; trousers; t-shirts; underclothes; wind coats; wind jackets; wind pants; windcheaters; women's clothing; tracksuit bottoms; tracksuit tops; tracksuits; trainers; parts and fittings for all the aforesaid goods.

4. Mr Saddiq's mark was published for opposition purposes on 29 April 2022 and, on 29 July 2022, it was opposed by 1661. 1661's opposition is based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act") and is aimed at all of Mr Saddiq's goods. The section 5(2)(b) and 5(3) grounds are reliant upon the following marks:

GOAT

UK registration no. 2359645

Filing date 29 March 2004; registration date 18 August 2006

Relying on all goods, namely:

Class 25: Clothing and knitwear; fashion clothing; ladies' clothing, coats, frocks, skirts, dresses, jackets, jerseys, sweaters, trousers, tops, evening wear; all being woven or knitted.

("1661's first mark");

KID BY GOAT

UK registration no. 917880484²

Filing date 26 March 2018; registration date 4 August 2018

Relying on all goods, namely:

² The second mark relied upon by 1661 is a comparable trade mark based on a pre-existing EUTM. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing EUTMs.

Class 25: Clothing; children and ladies' clothing, coats, skirts, dresses, jackets, jerseys, sweaters, trousers, tops, evening wear; knitwear [clothing]; belts for wear; footwear.

("1661's second mark"); and

GOAT

UK registration no. 3592499

Filing date 8 February 2021

Relying on all goods and services, being those set out in the Annex to this decision. ("1661's third mark").

5. Under the 5(2)(b) ground, 1661 claims that because of the high similarity between the marks and goods at issue, there exists a likelihood of confusion on the part of the public in the UK.
6. Turning to the 5(3) ground, 1661 claims that the similarity between the marks at issue are such that the relevant public will believe that they are used by the same undertaking or that there is an economic connection between them. Further, 1661 claims that its marks enjoy a reputation and that due to this reputation, use of Mr Saddiq's mark will benefit from an unfair advantage. Further, 1661 claims that use of Mr Saddiq's mark may tarnish 1661's reputation and/or erode the distinctiveness of 1661's marks.
7. Lastly, in respect of its reliance upon the 5(4)(a) ground, 1661 relies on the sign 'GOAT' that it claims to have been using in the UK since at least 2004 in respect of the following goods and services:

"Clothing and knitwear; fashion clothing; ladies' clothing, coats, frocks, skirts, dresses, jackets, jerseys, sweaters, trousers, tops, evening wear, headgear, footwear, retail services and online retail services in connection with the retail of clothing, footwear, headgear and bags."

8. Under this claim, 1661 argues that it enjoys goodwill as a result of the use of its sign and that use of Mr Saddiq's mark in relation to the goods applied for could

constitute a misrepresentation that Mr Saddiq's goods are connected with 1661's goodwill. 1661 claims that this misrepresentation could cause damage to the opponent by means of diversion of sales, tarnishment of reputation or erosion of distinctive character to 1661's sign.

9. Mr Saddiq filed a counterstatement wherein he made some concessions as to the similarity of the goods in class 25. However overall, Mr Saddiq denied the claims against his mark and put 1661 to proof of use for its first mark.

Mr Saddiq's declaration for invalidity

10. On 10 January 2023, Mr Saddiq applied to have 1661's first mark (the details of which are set out above) declared invalid under section 47 of the Act. The application is reliant on sections 3(1)(b), 3(1)(c), 3(1)(d) and 3(3)(b) of the Act and is targeted at the entirety of the goods in 1661's first mark's specification.
11. In respect of Mr Saddiq's reliance upon section 3(1)(b), he claims that when consumers are greeted with 1661's first mark, being the word 'GOAT', they will not attribute any trade mark significance to it because it simply serves to indicate that the goods on offer are, for example, products which are made from or contain the skin, hair or other parts of a goat, or that the goods represent a goat or apply to a goat.
12. Turning to the section 3(1)(c) claim, I note that for the most part, Mr Saddiq's pleadings are a reproduction of the arguments raised under 3(1)(b). The only point of difference comes in the additional argument that 'GOAT', when viewed on the goods at issue, represents or applies to an individual or product commonly regarded as the 'Greatest Of All Time'.
13. As for the claim under section 3(1)(d), Mr Saddiq argues that 1661's first mark consists exclusively of the sign 'GOAT' (Greatest of All Time) which has become customary in the current language or in the bona fide and established practices of the trade to apply to class 25 goods.

14. Lastly, Mr Saddiq's reliance upon section 3(3)(b) is on the basis that the consumers will consider that 1661's first mark is descriptive/non-distinctive for the reasons set out under the section 3(1)(b) and (c) grounds above. However, insofar as the goods are not made from goat, represent a goat, do not apply to a goat or an individual or product commonly regarded as the 'Greatest Of All Time', then the mark is of such a nature so as to deceive the public.
15. 1661 filed a counterstatement wherein it denied the claims against it.
16. Upon the filing of 1661's counterstatement in Mr Saddiq's invalidity application, the above proceedings were consolidated in accordance with Rule 62(1)(g) of the Trade Marks Rules 2008. This was communicated to the parties by way of correspondence from the Tribunal dated 26 April 2023.
17. Both parties filed evidence in chief and 1661 elected to file evidence in reply. A hearing took place before me on 15 January 2024, by video conference. 1661 was represented by Ms Victoria Jones, Counsel at 3PB, acting upon the instructions of Fieldfisher LLP, who have represented 1661 throughout these proceedings. Mr Saddiq was represented by Mr Philip Hannay of Cloch Solicitors, who have represented Mr Saddiq throughout these proceedings.
18. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

PRELIMINARY ISSUES

Mr Saddiq's mark's specification

19. On 9 January 2023, Mr Saddiq filed a Form TM21B wherein he sought to amend the specification of his mark. I note that the proposed amendment removed a range

of goods from the specification, being “footwear” (twice), “athletic footwear”, “baseball shoes”, “boots”, “children’s footwear”, “footwear for sports”, “shoes”, “sneakers” and “trainers”. He also sought to introduce a limitation at the end of the specification of “none of the foregoing in relation to footwear”. On 10 January 2023, the Tribunal confirmed to the parties that the class 25 specification was to be amended in accordance with the Form TM21B and that if 1661 considered that this amendment allowed the opposition to be withdrawn, it should confirm the same by way of response. On 24 January 2023, 1661 confirmed that it would not withdraw the opposition and that the proceedings were to be maintained.

20. In proceedings before the Tribunal, the events described above are in no way uncommon and would ordinarily be reflected in paragraph one of this decision. However, I raise this as a preliminary issue because the Trade Marks Register and the Tribunal’s file still reflect the specification as it was prior to the filing of the TM21B. Further, throughout the course of these proceedings, the parties continued to refer to the previous specification. For example, I note that 1661, in its skeleton argument, and Mr Saddiq, in an email from his representative (wherein he offered a fallback specification), both referred to the specification as it stood prior to the filing of the Form TM21B.

21. Having considered the present issue, it is my view that the appropriate course of action is to proceed in considering this decision on the basis of the amended specification. I consider that the present issue stems from an administrative oversight wherein the Register has not been amended to reflect the position. Further, I note that the official letter from the Tribunal dated 10 January 2023 duly confirmed to the parties that the specification would be amended accordingly and it is this confirmation that is, in my view, an indication of how the Tribunal would treat Mr Saddiq’s specification.³

³ As above, 1661 maintained its opposition against the amended specification.

Mr Saddiq's fallback specification

22. On 12 January 2024, Mr Saddiq's representative filed an email requesting that, subject to Mr Saddiq's primary position, he wished for the opposition to also be assessed in relation to a proposed fallback specification. This fall back specification was limited to the following goods only:

“Athleisure; baseball caps and hats; beachwear; caps; gilets; hats; headgear; hooded tops; hoodies; jackets; men's clothing; sweaters; sweatshirts; t-shirts; tracksuit bottoms; tracksuit tops; tracksuits.”

23. The nature of this proposal was subject to discussion at the hearing. I do not intend to go over the arguments raised on this point in full but I do wish to briefly discuss 1661's position. At the hearing, Ms Jones stated that the Tribunal did not give Mr Saddiq an opportunity to offer a fallback specification. Ms Jones also stated that Mr Saddiq is not at liberty to hedge his bets depending on the outcome of an opposition. While Ms Jones' arguments are noted, I refer to the wording of the Tribunal's letter dated 22 August 2023 wherein it states that:

“The Hearing Officer will decide the case based on the specification(s) currently before him. If, however, the applicant considers it has a fall-back position in the form of a limited specification, it should make this clear to the Hearing Officer as part of written submissions or the hearing process, as applicable. A limited specification should not be submitted for the first time at any appeal hearing. A fall-back specification will not represent a binding restriction and no inference will be made by the Hearing Officer, if such a limitation is, or is not, offered.”

24. In light of the above, I consider that it was entirely appropriate for Mr Saddiq to offer an alternative fallback position. In respect of the claim that Mr Saddiq was 'hedging his bets', I am not convinced that this was what he intended to do. In my view, the wording of the email simply offered a secondary position without prejudice to his primary position that his mark should proceed to registration for all goods. In my view, such a proposal is not controversial. Put simply, if it transpires that those

highlighted goods survive the opposition, this would have been the case regardless of the existence of the proposed fallback position.

25. For the avoidance of doubt, I will proceed to consider Mr Saddiq's specification in line with the amended specification discussed at paragraphs 18 to 21 above whilst also bearing in mind the comments of Mr Hannay in his email to the Tribunal dated 12 January 2024.

EVIDENCE

26. 1661's evidence in chief came in the form of the witness statements of Josh Webman dated 11 November 2022 and the witness statement of Kishen Karia dated 26 June 2023. Mr Webman is the Associate Vice President of 1661 and his statement is accompanied by 14 exhibits, being those labelled JW1 to JW14. Mr Webman's statement was provided in support of 1661's opposition. Turning to Mr Karia's evidence, I note that he is a Chartered Trade Mark Attorney at 1661's legal representative firm and is, therefore, duly authorised to give evidence on 1661's behalf. Mr Karia's statement is accompanied by four exhibits, being those labelled KKC1 to KKC4, and speaks only to the invalidity application brought by Mr Saddiq.

27. Mr Saddiq's evidence came in the form of two witness statements, both of which were given by Mr Philip Hannay who, as above, is Mr Saddiq's legal representative and is, therefore, duly authorised to give evidence on his behalf. Mr Hannay's first witness statement is dated 13 January 2023 and discusses the opposition proceedings (though I appreciate that some of the evidence can be said to point to the issues raised under the invalidation application). This statement is accompanied by eight exhibits, being those labelled APP-01 to APP-08 and was filed alongside a set of written submissions. Mr Hannay's second witness statement is dated 26 May 2023 and speaks to the invalidation application. His second statement is accompanied by four exhibits, being those labelled PH-01 to PH-04.

28. As above, 1661 filed evidence in reply. This came in the form of the second witness statement of Kishen Karia dated 13 March 2023 who, as above, is employed by

1661's legal representative. Mr Karia's statement in reply focuses on the opposition only and is accompanied by two exhibits, being those labelled KK1 and KK2.

29. I do not propose to summarise the evidence or submissions here. However, I have taken them all into consideration in reaching my decision and will refer to them below, where necessary.

MY APPROACH

30. Technically, the invalidation action brought by Mr Saddiq impacts upon 1661's opposition. This is because the mark for which invalidation is sought is relied upon by 1661 as part of its opposition. Having said that, I do not consider that the success or failure of the invalidation application is of any consequence to the opposition. I say this for the following reasons:

- a. Success of the invalidation application in its entirety will not result in 1661's opposition falling away. As above, 1661 relies upon three earlier marks and only one is subject to invalidation; and
- b. The existence of 1661's first mark is, in my view, of no real assistance to 1661's opposition. This on the basis that 1661's first mark offers no real advantage above and beyond its third mark. On this point, I note that 1661's third mark is subject to an ongoing opposition, however, that opposition is partial and is aimed only at some goods and services within classes 9, 35, 38 and 42 of the third mark's specification. Despite all goods and services being relied upon by 1661 in the present opposition, I do not consider that those opposed in the separate proceedings are of any relevance.⁴

31. At the hearing, I explained the effect of the above and set out to the parties that I did not consider that it was necessary to consider the proof of use point because 1661's third mark is identical to its first mark and is registered for highly similar goods in class 25 (being those that are relevant here).⁵ I had no objections to this

⁴ I say this because the class 25 goods of 1661's third mark are not opposed and, in the present case, these are clearly the relevant goods.

⁵ Given the limitation of the goods in 1661's first mark's specification (being woven or knitted goods), it can be said that 1661's third mark's specification consists of a broader range of goods.

approach from either party and will, therefore, proceed with this decision as if 1661's first mark is not at issue in the opposition.

32. Even though the opposition was brought first and will proceed regardless of the success of Mr Saddiq's invalidation application, I will bring my decision with the invalidation application.

DECISION

Mr Saddiq's invalidation application

33. Sections 3(1) and 3(3) of the Act have application in invalidation proceedings because of the provisions of section 47(1) of the Act, which states as follows:

"47. –

(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

[...]

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

Section 3(1): legislation and case law

34. Section 3(1) of the Act provides as follows:

“3(1) The following shall not be registered –

(a) [...]

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

35. The relevant date for determining whether 1661’s first mark is objectionable under the above provisions is its deemed filing date, being 29 March 2004.

36. I bear in mind that the above grounds are independent and have differing general interests. As such, it is possible, for example, for a mark not to fall foul of section 3(1)(c) but still be objectionable under section 3(1)(b).⁶ While noted, I do not consider that this principle applies here. I say this because, in the present case, Mr Saddiq's arguments under section 3(1)(b) are that 'GOAT' will indicate that the goods are made from or contain the skin, hair or other parts of a goat or that the goods represented a goat or apply to a goat. This is an argument that points to a claim that 'GOAT' is descriptive of various characteristics of the goods at issue. Further, these exact pleadings have been reproduced in their entirety under the section 3(1)(c) ground. As such, I am of the view that the outcome of the section 3(1)(b) ground is bound to follow the outcome of the section 3(1)(c) ground.

37. The position under the above grounds must be assessed from the perspective of the average consumer, who is deemed to be reasonably observant and circumspect.⁷ The goods subject to the invalidation application are class 25 goods. The average consumer for such goods are members of the general public at large. The consumers will select the goods at issue via predominantly visual considerations, after having considered them on racks or shelves in retail environments or, if selecting them online, after seeing images of them on websites. The goods are not particularly expensive goods (though I do appreciate some may sit towards the higher end of the scale) and they will be selected at a reasonably frequent rate. The consumer is likely to consider factors such as fit, style and materials used. The consumer is, therefore, likely to select the goods whilst paying a medium degree of attention.

Section 3(1)(c)

38. Given my comments at paragraph 36 above, I will begin my consideration with the application based on section 3(1)(c). Section 3(1)(c) prevents the registration of marks which are descriptive of the goods and services, or a characteristic of them. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold

⁶ See paragraph 25 of *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P

⁷ *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04

J. (as he then was) in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461, paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods

or services (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94 , it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie* , paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland* , paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94 , the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it

will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56).”

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].”

39. Mr Saddiq claims that when consumers are greeted with the sign ‘GOAT,’ they will not attribute any trade mark significance to it because it simply serves to indicate that the goods on offer are (1) made from or contain the skin, hair, or other parts, of a goat and/or (2) represent a goat or apply to a goat and/or (3) that the goods represent to apply to an individual or product commonly regarded as the ‘Greatest of All Time’.

40. The evidence before me in respect of the alleged descriptiveness of the word ‘GOAT’ is as follows:

- a. Dictionary definitions for the word ‘goat’ taken from the Cambridge Dictionary website.⁸ The definitions shown are ‘*an animal related to sheep that usually has horns and a beard*’, ‘*a man who is very active sexually, or would like to be and makes it obvious*’ and as an abbreviation for ‘*Greatest Of All Time*’. The printout is dated 9 January 2023;
- b. A printout of the Wikipedia page for the entry, ‘cashmere wool’, which is dated 13 January 2023.⁹ The article describes ‘cashmere wool’ as a fiber obtained from cashmere goats, pashmina goats and some other breeds of goat.
- c. A printout from Dictionary.com dated 9 January 2023 which briefly discusses the history of ‘GOAT’ meaning the ‘Greatest Of All Time’, with reference to

⁸ APP-03

⁹ APP-04

Muhammed Ali using the term to describe himself in the 1990s and LL Cool J naming an album 'G.O.A.T – Greatest Of All Time' in 2000;¹⁰

- d. Historic articles from the BBC website, dated from 12 July 2004 onwards, which use the term 'GOAT' in the context of meaning the 'Greatest of All Time'.¹¹ I note that these articles refer to athletes such as Maurice Greene, Serena Williams and Michael Phelps;
- e. A printout of the Wikipedia page for the animal, the goat.¹² The printout is undated and while I do not intend to discuss its content in full, it appears to me to be a fairly standard Wikipedia information page that covers the etymology and history of the goat as well as the goat's use as a pet and its use in mythology and folklore;
- f. A printout dated 26 May 2023 from MMGuardian.com which provides the definition of 'GOAT' in the context of standing for the 'Greatest of All Time' or simply as an internet slang initialism used to compliment athletes, musicians or other celebrities;¹³
- g. A printout that appears to have been taken on 26 May 2023 from the retail websites RedBubble.com and Etsy which shows a range of clothing and other items (listed in British pounds) that are emblazoned with the word 'GOAT', images of goats or images/references to athletes/musicians such as 'Kerser', Michael Jordan and Tom Brady;¹⁴ and
- h. Printouts taken from goatorganicapparel.com, softgoat.com and younggoat.co.uk (all dated 26 May 2023) which shows third parties using the word 'GOAT' as a brand name.

41. In addition to the above, I note that Mr Saddiq has also provided evidence of an interview with Jane Lewis, the founder of Goat Fashion (being the predecessor in title of 1661's first mark).¹⁵ I raise this here because it was a point of contention at the hearing. In his evidence, Mr Hannay referred to the interview and, for context, I reproduce the way in which it was presented below.

¹⁰ APP-05

¹¹ APP-06

¹² PH-01

¹³ PH-02

¹⁴ PH-03

¹⁵ APP-07

“It is highly noteworthy that in APP-07 the writer note [sic] the lack of distinctive character: “When Lewis launched as Goat, it was because her material of choice was cashmere...” and the founder of Goat Fashion Limited is quoted admitting “‘Truthfully, I was young and inexperienced,’ said Lewis when discussing how she came up with Goat as her brand name at launch.”

42. The above evidence was introduced because it is Mr Saddiq’s position that Ms Lewis launched her brand as ‘GOAT’ because cashmere was her material of choice and, as such, descriptive of the actual materials and garments. At the hearing, Ms Jones argued that what one person may have thought or may not have thought is irrelevant. This is a point I agree with. Whether Ms Lewis considered her mark descriptive or not is not the issue here. Despite this, I wish to set out that, in my view, the quote regarding Ms Lewis’ ‘inexperience’ has been presented out of context.¹⁶ Having considered the article, I note that the entirety of the relevant quote is as follows:

“When Lewis launched as Goat, it was because her material of choice was cashmere, and while cashmere is still present in her collection, there is much more focus on jersey in her upcoming collections.

‘Truthfully, I was young and inexperienced,’ said Lewis when discussing how she came up with Goat as her brand name at launch. ‘I’m not classically trained and this was my first foray into fashion and I didn’t feel confident to call it after my own name, but now after being in the business for 20 years, building a reputation and a company, I feel now is the time.’”

43. It is clear to me that the quote is not in relation to her inexperience in naming her brand something descriptive but to the fact that she was inexperienced to the point that she did not feel confident to label her brand with her own name. As above, this argument put forward by Mr Saddiq is of no relevance, especially in light of the fact that the argument did not reflect the actual position.

¹⁶ This is a point that Ms Jones also mentioned in her submissions at the hearing.

44. Moving on to the relevant assessment, I will first say that I do not consider it to be controversial to suggest that consumers would have (as at the relevant date) considered that the word 'GOAT' was a reference to the animal. As for the argument in respect of 'GOAT' standing for 'Greatest Of All Time', I am not convinced. It is my understanding that, in recent years, the word 'GOAT' as a reference to the 'Greatest of All Time' has become an increasingly popular term used when referring to musicians or athletes and would likely be known by a significant proportion of average consumers in the UK.¹⁷ However, the present assessment is to be based on the position as at the filing date for the mark, being 29 March 2004. The only evidence I have from before this date is a brief reference to Muhammed Ali using the term in the 1990s and LL Cool J referring to it as the name of his album in the year 2000. I appreciate that both of these personalities are well-known celebrities, however, I have nothing to suggest UK average consumers' knowledge of these individuals using this term prior to the relevant date. For example, I have no UK sales figures to suggest the popularity of LL Cool J's album by the relevant date. In short, there is nothing sufficiently solid before me to suggest that consumers in the UK, as at the relevant date, would recognise 'GOAT' as anything other than a reference to the animal. Without such, I am not willing to infer that they would and, therefore, I do not consider that, as at the relevant date, 'GOAT' would have been understood by a significant proportion of consumers in the UK as meaning 'Greatest Of All Time'. Any such argument on this basis must, therefore, fail and I will say no more about it.

45. While my comments above in relation to 'GOAT' being understood as an animal are noted, the question I must consider here is whether this is capable of being considered descriptive of a characteristic of the goods at issue. In considering this ground in light of what I have said above, the only arguments that remain at issue are (1) whether 'GOAT' describes goods made from or containing the skin, hair, or other parts, of a goat and (2) whether 'GOAT' describes goods that represent a goat or apply to a goat. I will deal with these arguments in turn below.

¹⁷ In making this statement, I remind myself that, as per the case of *Chorkee Ltd v Cherokee Inc.*, (BL O/048/08), Hearing Officers must take care not to assume that their own personal knowledge is more widespread than it is. However, I make this statement on the basis that I do not consider it to be a fact that is subject to serious dispute.

46. The first argument can, in my view, be broken down into three separate parts, namely whether 'GOAT' describes products made from (a) the skin of a goat, (b) the hair of a goat or (c) other parts of a goat. My comments in respect of each point are as follows:

- a. I do not consider that the consumers will consider 'GOAT' to be a reference to the fact that the goods are made from the skin of a goat. I appreciate that skins of animals may be used in clothing, however, this is referred to as leather and not by the name of the animal from which the leather derives. As an example, leather made from a cow is not, as far as I understand it, ever referred to in the UK simply as 'cow'. Further, and perhaps more important to the current assessment I must make, the goods for which invalidation is sought are expressly limited to being knitted or woven goods so will not cover leather goods. I, therefore, see no scenario wherein 'GOAT' would be viewed as being descriptive of goods made of goat skin.

- b. I appreciate that goat hair is a product that is used in clothing. However, it is my understanding that such material is commonly described as either wool or cashmere (when taken from certain breeds of goat). While such a product may be a popular material used in knitwear, I have nothing before me to suggest that consumers would describe clothing products that derive from animals by using the name of that animal itself.¹⁸ As such, I see no scenario wherein a consumer would use the word 'GOAT', *solus*, to describe the kind of goods that they are wearing. For example, if a consumer was wearing a knitted jumper made of goat's fur or wool, they would not describe it solely by using the word 'goat'. Instead, they would be more likely to describe it as a garment made from cashmere, goat's wool or goat's fur. I appreciate that a trade mark making reference to the name of an animal in such an instance would be allusive to the fact that the goods contain, or are made from products, from that animal. However, this is not the same as the mark being directly descriptive. While it may effect a mark's inherent distinctiveness,¹⁹ it

¹⁸ I appreciate that there may be scenarios where it may be, such as the word 'CHICKEN' on chicken meat, for example. However, that is not the issue at hand.

¹⁹ Allusive marks tend to possess a lesser degree of inherent distinctiveness.

does not make it objectionable under section 3(1)(c) of the Act. Taking all of this into account and absent any further arguments from Mr Saddiq which demonstrates that such an outcome would occur in respect of the word 'GOAT', I do not consider that the argument that 1661's first mark is directly descriptive of clothing made from the fur of a goat is sustainable.

- c. Dealing with the last point, I see no merit in the claim insofar as it relates to 'other parts of a goat'. In my view, there are no other parts of goats that would reasonably be envisaged as being used in clothing. For example, a consumer would not consider that 'GOAT', on clothing goods, would describe an organ or bone of a goat. Absent any specific argument on this point, I do not consider that this it carries any weight and is, therefore, dismissed.

47. I turn now to consider the second part of Mr Saddiq's argument; being that the term 'GOAT' represents a goat or applies to a goat. I see no merit in either aspects of this argument. Firstly, the goods at issue are clothing goods, not livestock or animal toys/dolls. As such, the word 'GOAT' on clothing would, plainly, not be seen as representative of a goat in the same way as it would for the other goods described.²⁰ Secondly, the goods at issue are in class 25 and, therefore, intended to be clothing for humans. Clothing for animals is reserved for class 18. While I note that there is evidence before me of one example of clothing for goats,²¹ the goods at issue are not capable of covering this type of clothing. Therefore, they cannot be said to be goods that are applied to a goat. As a result, I consider that Mr Saddiq's reliance upon this argument fails.

48. Taking all of the above into account, I find that Mr Saddiq's claim under the present ground fails in its entirety. 1661's first mark is, therefore, not objectionable under section 3(1)(c) of the Act.

²⁰ I make this specific point as I note that at page 24 of PH-03, an image is shown of a knitted goat toy/doll.

²¹ See page 24 of PH-03 which shows a product referred to as a 'lamb dog goat coats jackets fleeces...'

Section 3(1)(b)

49. Moving to consider Mr Saddiq's section 3(1)(b) ground, I am of the view that I can deal with this swiftly. This is on the basis that, as I have set out above, his pleaded case under this ground is so closely aligned (or, arguably, nigh on identical) with his section 3(1)(c) ground that the failure of that ground means that the reliance upon the section 3(1)(b) ground must also fail.

Section 3(1)(d)

50. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*, Case T-322/03, the General Court ("GC") summarised the case law of the Court of Justice under the equivalent of s.3(1)(d) of the Act, as follows:

"49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma (BSS)* [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public's perception of the mark (*BSS*, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and *BSS*, paragraph 40)."

51. In light of the case law above, the relevant question is whether, on the relevant date (29 March 2004), the word 'GOAT' had become customary in the current language or in the bona fide and established practices of the trade to designate the goods for which the mark is registered, being clothing goods in class 25. That question must be based on the perception of the average consumer of the goods in the UK, who I have identified at paragraph 37 above.

52. The issue for Mr Saddiq here is that his reliance upon the present ground is solely on the basis that 'GOAT' will be understood as 'Greatest Of All Time'. This is an issue because the relevant date for this assessment is 29 March 2024 and, as set out above, I am not convinced that significant proportion of consumers in the UK would have known this meaning at that time. Given that a significant proportion of consumers would not have known that 'GOAT' stood for 'Greatest Of All Time' at that point, Mr Saddiq's argument cannot succeed. Even if such a meaning was understood, there is no evidence that, at that time, 'GOAT' had become customary in the language or in the bona fide and established practices of the trade for clothing goods. I say this because the only evidence from prior to the relevant date is that which I have described at point (d) of paragraph 40 above. The evidence as to the phrase 'GOAT' in the context of 'Greatest Of All Time' on actual clothing

goods is all dated May 2023²² and is, therefore, not capable of pointing to the position as at the relevant date.

53. As a result of the above, the opposition based on section 3(1)(d) fails in its entirety.

Section 3(3)(b)

54. Section 3(3)(b) of the Act states:

“A trade mark shall not be registered if it is—

(a) [...]

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).”

55. In *Elizabeth Florence Emanuel v Continental Shelf 128 Ltd*, Case C-259/04, the Court of Justice of the European Union (“CJEU”) stated:

“47. Nevertheless, the circumstances for refusing registration referred to in Article 3(1)(g) of Directive 89/104 presuppose the existence of actual deceit or a sufficiently serious risk that the consumer will be deceived (Case C-87/97 *Consorzio per la tutela del formaggio Gorgonzola* [1999] ECR I-1301, paragraph 41)”.

56. Mr Saddiq’s pleadings under this ground follow the arguments highlighted above, namely that the goods on offer under 1661’s first mark (1) are made from or contain the skin, hair or other parts of a goat, or that the goods represent a goat or (2) apply to a goat and/or (3) represent or apply to an individual commonly regarded as the ‘Greatest Of All Time’. Insofar as the goods are not made from goat, represent a

²² See, for example, the range of printouts taken from RedBubble and Etsy showing a range of class 25 goods for sale. Even ignoring these issues, the goods shown are not actually branded as ‘GOAT’ but simply bear images or make reference to athletes such as Michael Jordan and Tom Brady. Without anything further, I consider it reasonable to infer that their appearances on these search results are down to keywords and search phrases for ‘GOAT’ as opposed to actual use on the goods themselves.

goat, do not apply to a goat or represent an individual or product commonly regarded as the 'Greatest Of All Time', then the mark is of such a nature so as to deceive the public. Mr Saddiq has not provided evidence of actual deceit taking place and I must, therefore, consider whether there is a sufficiently serious risk of the consumer being deceived.

57. Given how the present ground has been pleaded, it must follow that if the objection under the section 3(1)(c) ground above failed then 1661's first mark is also free from objection under section 3(3)(b). This is on the basis that as I have found that 1661's first mark will not be perceived as descriptive of a characteristic of the goods then it cannot be deceptive. Therefore, I find that there is not a sufficiently serious risk that members of the relevant public will be deceived by 1661's first mark. As a result, the opponent's reliance upon 3(3)(b) fails.

Conclusion of Mr Saddiq's invalidation application

58. Mr Saddiq's invalidation application has failed in its entirety. As a result, 1661's first mark is to remain registered for all goods for which it is registered.

1661's opposition

59. I have explained above that the opposition would proceed without reliance upon 1661's first mark. At this stage, I also consider it necessary to set out that 1661's reliance upon its second mark is of no real assistance here either. I say this because I do not consider that 1661's second mark offers any advantage over its third mark. In considering the marks just briefly, 1661's third mark plainly offers 1661 a greater prospect of success over its second mark. This is on the basis that the second mark contains additional material, being the words 'KID BY' before the word 'GOAT' (which is the sole element of the third mark). These additional points have no counterpart in Mr Saddiq's mark and, clearly, take it further away in terms of visual, aural and conceptual similarity. Further, the second mark is, arguably, registered for goods in class 25 that are more limited than those included in the

third mark's specification.²³ In my view, it follows that if there is confusion in respect of the third mark, the position is not furthered by the presence of the second mark. Alternatively, if no confusion is found in respect of the third mark, the second mark is highly unlikely to put 1661 in a better position.

60. In respect 1661's third mark, I remind myself that it is subject to an ongoing opposition. However, the goods and services subject to that opposition are in classes 9, 35, 38 and 42. These goods and services offer no advantage to 1661's opposition as the goods at issue in Mr Saddiq's specification are in class 25 only. Given that 1661's third mark is not opposed for its class 25 goods, they will proceed to registration regardless of the outcome of that decision.²⁴ As such, I do not consider the fact that 1661's third mark is pending is of any relevance to the decision I must make.

61. In light of the above, I will proceed to consider the opposition in reliance upon 1661's third mark and relation to those goods in class 25 only. Only if I consider it appropriate to do so will I return to discuss the remaining marks further. Lastly, for the avoidance of doubt, I will simply refer to 1661's third mark as '1661's mark' going forward.

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

62. 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,

²³ I say this because while the second mark consists of the term “clothing” at large, the remaining terms can be said to be more limited than those present in 1661's third mark.

²⁴ On this point, I note that, as a technicality, any success in respect of the third mark would be provisional pending the outcome of those proceedings.

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

63. 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.”

64. 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.”

65. While 1661’s mark is not registered, it does have an earlier filing date than Mr Saddiq’s mark and, therefore, qualifies as an earlier trade mark under the above provisions. Given that it is not yet registered, it is not subject to proof of use pursuant to section 6A of the Act as it is not capable of having been registered for more than five years prior to the filing date of Mr Saddiq’s mark. In such circumstances, 1661 is entitled to rely upon all of the goods and services highlighted in its notice of opposition, some of which are subject to an ongoing

opposition. On this point, I remind myself that I am considering this opposition in reliance upon the class 25 goods only, which are not opposed under the separate proceedings.

66. 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

67. The competing goods are as follows:

1661's goods	Mr Saddiq's goods
<u>Class 25</u> Clothing; footwear; headwear; apparel; shoes; athletic footwear; athletic shoes; basketball shoes; casual footwear; casual shoes; hiking shoes; jogging	<u>Class 25</u> Clothing; headgear; athleisure; articles of sports clothing; anoraks; anoraks; anti-sweat underclothing; articles of clothing; articles of outer clothing;

<p>shoes; leisure shoes; running shoes; sports footwear; sports shoes; track shoes; training shoes; sneakers; sandals; flip flops; boots; track suits; athletic apparel; athletic clothing; casual clothing; casual wear; sports clothing; sports wear; shorts; athletic shorts; running shorts; pants; casual pants; jogging pants; track pants; jeans; trousers; casual shirts; short sleeve shirts; long sleeve shirts; sweatshirts; sweaters; hoodies; jerseys; formal wear; dresses; gowns; skirts; jackets; coats; suits; vests; women's wear; men's wear; children's wear; babies' wear; men's clothing; women's clothing; children's clothing; baby clothing; socks; intimate wear; underwear; boxers; briefs; bras; panties; lingerie; swimwear; bathing suit; swimming trunks; belts; ties; pyjamas; lounge wear; scarves; gloves; mittens; face masks; face shields; headbands; ear muffs; hats; helmets; sports caps; baseball caps; clothing accessories; accessories.</p>	<p>articles of sports clothing; articles of underclothing; athletic clothing; bandanas; baseball caps and hats; baseball uniforms; bathing suits; beach clothing; beach hats; beachwear; belts; blazers; caps; chemises; childrens' clothing; children's headwear; clothes; clothing; clothing for sports; coats; dresses; gilets; gloves; hats; headgear; hooded tops; hoodies; jackets; jeans; jerkins; jerseys; jumpers; leather clothing; men's clothing; outerwear; parkas; pyjamas; scarfs; shirts; shorts; sleepwear; sportswear; socks; sweaters; sweatshirts; ties; trousers; t-shirts; underclothes; wind coats; wind jackets; wind pants; windcheaters; women's clothing; tracksuit bottoms; tracksuit tops; tracksuits; parts and fittings for all the aforesaid goods; none of the foregoing in relation to footwear.</p>
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68. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment 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”.

69. 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.

70. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the GC stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut 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.”

71. "Clothing", "children's clothing" (albeit categorised as "childrens' clothing" in Mr Saddiq's mark), "belts", "ties", "gloves" and "scarves" (albeit categorised as "scarfs" in Mr Saddiq's specification) all appear in both marks' specifications. They are, therefore, self-evidently identical. In addition, I note that Mr Saddiq's goods include the term "headgear" and that 1661's goods include the term "headwear". While worded differently, I am of the view that these goods are still self-evidently identical. I say this because, as far as I understand it, headgear and headwear are interchangeable terms. On this point, I note that "clothing" and "headgear" appear twice in Mr Saddiq's specification.

72. The following goods of Mr Saddiq all describe various types of clothing goods and are, therefore, identical under the principle outlined in *Meric* with "clothing" in 1661's mark's specification:

"Athleisure; articles of sports clothing; anoraks; anoraks; anti-sweat underclothing; articles of clothing; articles of outer clothing; articles of sports clothing; articles of underclothing; athletic clothing; baseball uniforms; bathing suits; beach clothing; beachwear; blazers; chemises; clothes; clothing for sports; coats; dresses; gilets; hooded tops; hoodies; jackets; jeans; jerkins; jerseys; jumpers; leather clothing; men's clothing; outerwear; parkas; pyjamas; shirts; shorts; sleepwear; sportswear; socks; sweaters; sweatshirts; trousers; t-shirts; underclothes; wind coats; wind jackets; wind pants; windcheaters; women's clothing; tracksuit bottoms; tracksuit tops; tracksuits."

73. "Hats", "bandanas", "baseball caps and hats", "beach hats", "caps" and "children's headwear" in Mr Saddiq's specification are all terms that describe different types of headwear. They are, therefore, identical under the principle outlined in *Meric* with "headwear" in 1661's mark's specification.

74. "Parts and fittings for all the aforesaid goods" is a term that appears towards the end of Mr Saddiq's mark's specification and covers all of the goods assessed above. While no such term exists in 1661's mark, I remind myself that I have found Mr Saddiq's goods identical to 1661's mark's goods. As such, I am of the view that there exists some degree of similarity between this term and the goods of 1661.

Clearly, the goods differ in nature and method of use. As for purpose, I appreciate that the parts and fittings for clothing and headgear goods will eventually be worn by the user, resulting in some degree of overlap. However, their purpose is not on all fours with the finished clothing/headgear products themselves meaning that any overlap is limited. As for user, I consider that someone looking to repair their own clothing/headgear goods may look to purchase the goods of Mr Saddiq. In addition, I am of the view that a user who is looking to make their own clothing/headgear is likely to select the parts and fittings of clothing/headgear instead of the finished article itself meaning that the goods also share a competitive relationship.²⁵ Turning to trade channels, I am of the view that clothing and headgear manufacturers are also likely to sell items such as those covered by Mr Saddiq's term and, further, they may be available via the same distribution channels. On this point, I refer to collarless shirts which, for example, can be purchased and fitted with different types of collars (being a part of the shirt) that are used for different occasions/levels of formality. It is my understanding that these goods are produced by the same undertakings. Lastly, in terms of complementarity, I consider the clothing and headgear goods are important to the parts and fittings for the same. Further, I consider it likely that this connection will likely lead consumers to believe that the parts and fittings are the responsibility of the undertaking that also provides the finished products themselves.²⁶ Taking all of this into account, I am of the view that "clothing" and "headwear" in 1661's mark's specification are similar to a medium degree with Mr Saddiq's goods.

75. I note that at the end of Mr Saddiq's specification is the term "none of the foregoing in relation to footwear". As none of the terms assessed above can be said to relate to footwear, I do not consider that this term has any effect on the comparisons made. Further, in the event that there exists confusion for all of the above goods, there will be no 'foregoing' goods that this term can be said to apply to.

76. For the sake of completeness, I will briefly consider those terms that were removed from Mr Saddiq's term by his Form TM21B. I do so in case the approach discussed

²⁵ While that may be the case, I consider that those users would still select the goods of both parties, maintaining the aforementioned overlap in user.

²⁶ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

at paragraph 21 above was incorrect. I remind myself that the removed terms were “footwear” (twice), “athletic footwear”, “baseball shoes”, “boots”, “children’s footwear”, “footwear for sports”, “shoes”, “sneakers” and “trainers”. These goods are either self-evidently identical or identical under the principle outlined in *Meric* with “footwear” in 1661’s specification. As for the term “parts and fittings for all the aforesaid goods”, insofar as it relates to parts and fittings for footwear,²⁷ I consider that it shares a medium degree of similarity with “footwear” in 1661’s specification. In making this finding, I rely on similar reasons to those given in my assessment at paragraph 74 above.

The average consumer and the nature of the purchasing act

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

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

78. I have made findings as to the identity, purchasing process and level of attention of the average consumer at paragraph 37 above. Given that the goods at issue under the opposition cover the same type of goods assessed at that point in my decision, I consider that my findings there apply here also. For completeness,

²⁷ Which, in this scenario, it would as the term ‘none of the foregoing in relation to footwear’ is not present in the pre-amended specification.

those findings were that the average consumer base will be made up of members of the general public at large who will select the goods via primarily visual means (though not discounting an aural component playing a role) whilst paying a medium degree of attention.

Comparison of the marks


79. 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.

80. 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.”

81. 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.

82. The respective trade marks are shown below:

1661's mark	Mr Saddiq's mark
GOAT	

83. At the hearing, both parties made submissions in respect of the similarity between the marks at issue. I do not intend to discuss these here but confirm that I have taken them into account in making the following comparison.

Overall Impression

1661's mark

84. 1661's mark is a word only mark consisting solely of the word 'GOAT'. There are no other elements that contribute to the overall impression of the mark which lies in the word itself.

Mr Saddiq's mark

85. Mr Saddiq's mark is a figurative mark that consists of the words 'GOAT TEE' presented in a standard black typeface that sit arched and towards the top of the mark. Beneath this is a black graphical representation of a goat with horns. To the left of the goat device are the words 'EST.' and, to its right, are the numbers '2017'. These will be considered together as meaning 'established 2017'. Surrounding all elements is a black circular border. In respect of the overall impression of Mr Saddiq's mark, I remind myself that consumers tend to focus on elements of marks that can be read. While this would ordinarily mean that 'GOAT TEE' dominates the overall impression of the mark, I consider that 'TEE' will play varying roles for different groups of consumers. I consider that some consumers will view it as a shorthand reference to a t-shirt and, as such, it will play a considerably lessened role. However, it is also possible that, when viewed as a whole, 'GOAT TEE' may,

for some consumers, be seen as a reference to/play on the word 'goatee', being a style of facial hair. In this scenario, the words 'GOAT' and 'TEE' play an equal role and form somewhat of a unit. Both sets of consumers will, in my view, form a significant proportion. For the purpose of this decision, I will focus on those that see 'TEE' as a shorthand reference to a t-shirt.²⁸

86. In light of the approach indicated above, I consider that 'GOAT' plays the strongest role in the overall impression of the mark, followed by the device element which will then be followed by the word 'TEE'. As for the 'EST. 2017' element, this will have very limited impact due to its role of denoting the establishment date of the brand, a point that is often overlooked by consumers. As for the black circular border, I consider that this will also play a negligible role due to its purpose as a banal border element.

Visual Comparison

87. Visually, the marks share the word 'GOAT'. While this is the only point of similarity between the marks, it does lie in the sole element of 1661's mark and the strongest element of Mr Saddiq's mark. All other elements differ and while they all play lesser roles, they are numerous and still act as points of visual difference between the marks. Taking all of this into account and bearing in mind the marks' overall impressions, I consider that the marks are visually similar to no more than a medium degree.

Aural Comparison

88. In considering the aural impact of Mr Saddiq's mark, I remind myself of the case of *Purity Hemp Company Improving Life as Nature Intended*,²⁹ wherein Mr Phillip Harris, sitting at the Appointed Person, set out that just because an element may be descriptive, it does not render it aurally invisible. As such, while 'TEE' is

²⁸ I do so whilst bearing in mind the case of *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41 wherein Kitchin LJ found that if a court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention, then it may properly find infringement. This principle applies equally to oppositions brought under section 5(2)(b) of the Act.

²⁹ BL O/115/22

descriptive of a t-shirt, it will still be pronounced. As for 'EST. 2017', I do not consider that this will be pronounced. I say this because, as far as I understand it, consumers do not seek to articulate information about the establishment dates of trade marks/brands. As a result, I consider that Mr Saddiq's mark will be pronounced as 'GOAT TEE'. This will consist of two syllables that will be pronounced in the ordinary way. Turning to 1661's mark, this consists of one syllable that will pronounced in the ordinary way.

89. The entire aural element of 1661's mark is identical to the first syllable of Mr Saddiq's mark. While the word 'TEE' has no aural counterpart in 1661's mark, I remind myself that it does play a lesser role to the 'GOAT' element. Lastly, I remind myself that average consumers tend to focus on the beginnings of marks,³⁰ being where the point of identity in Mr Saddiq's aural element lies. Taking all of this into account, I am of the view that the marks are aurally similar to a higher than medium degree.

Conceptual Comparison

90. The concept of 1661's mark will derive solely from the word 'GOAT' which will be understood as being a reference to the animal. I am also of the view that 'GOAT' may be understood as an initialism of the phrase 'Greatest of all Time'.³¹ In my view, those consumers that understand the mark in different ways make up significant proportions. For the purposes of my assessment, however, I will focus on those that view it as a reference to the animal.³² Turning to the use of 'GOAT' in Mr Saddiq's mark, I am of the view that it will be viewed solely as a reference to the animal. I say this because the device element in Mr Saddiq's mark is a graphical representation of a goat and will only serve to reinforce this meaning. As for 'TEE', I have set out above that the relevant section of consumers will view it as being a shorthand term for 't-shirt'. The wording 'EST. 2017' will simply refer to the fact that

³⁰ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

³¹ While I have found that this was not the case as at the relevant date of the invalidation application assessed above, the relevant date for the present assessment is 11 April 2022. At this point in time, I consider that the meaning of 'GOAT' as standing for 'Greatest Of All Time' was considerably more popular than it was nearly 20 years prior.

³² I do so on the same basis that I have above and in reference to the case of *Comic Enterprises*

the brand was established in 2017 and will, therefore, have no real impact on the concept of the mark itself.

91. In comparing the marks, the concept of a goat (being the animal) will dominate both. While 'TEE' will act as a point of conceptual difference between them, it is only slight due to its descriptive nature as a shorthand reference to a 't-shirt'. The goat device will do nothing to counteract the shared concept of a goat and neither will the letters 'EST. 2017'. Taking all of this into account, I am of the view that the marks are conceptually similar to a high degree.

Distinctive character of 1661's mark

92. 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).”

93. Registered trade marks possess varying degrees of inherent distinctive character, perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods and services, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. 1661 has not specifically pleaded that its mark enjoys an enhanced degree of distinctive character. That being said, 1661 has filed evidence of use and it is ordinary in cases before the Tribunal that, even if the point has not been specifically pleaded, enhanced distinctiveness is considered in light of any evidence of use filed. Before doing so, however, I will first consider the inherent position.

94. While my assessment of the section 3 grounds of Mr Saddiq's invalidation application related to a different mark, that mark is identical to the one at issue here. While my present assessment is not on all fours with the one made under the section 3(1)(c) ground above, I consider that my finding regarding 'GOAT' being allusive to the fact that the goods at issue are made from the hair/fur of a goat is applicable here. While that may be the case, use of the word 'GOAT' is not directly descriptive and, therefore, I do not consider its distinctiveness falls to a low degree. As such, when the mark is viewed on goods that may reasonably be said to be made from the hair/fur of a goat (such as knitwear, for example), 1661's mark possesses between a low and medium degree of inherent distinctive character. However, unlike my assessment above, the goods at issue here are not limited to woven or knitted clothing meaning that the mark may be encountered on clothing made from other materials. In such a scenario, I do not consider that the mark would be considered allusive. Having said that, even in this scenario, I do not consider the use of the name of an animal is particularly remarkable from a trade mark perspective. As a result, I consider that 1661's mark possesses a medium degree of inherent distinctive character.

95. I turn now to the position in respect of enhanced distinctive character. While evidence has been filed in relation to the broad range of goods and services, it is only those class 25 goods that I will consider relevant during the present assessment. 1661's evidence sets out that between the years of 2015 and 2020,

the GOAT and KID BY GOAT brands achieved the following levels of turnover in the UK:

Year	Revenue (£)
2015/2016	2,205,925
2016/2017	2,651,552
2017/2018	2,747,204
2018/2019	3,478,907
2019/2020	3,246,977
Total:	14,330,565

96. While these figures are noted, there is no breakdown as to how the figures relate to the brands that they cover. As above, the figures include the KID BY GOAT branding which is not at issue here. Having said that, however, I note that elsewhere in 1661's narrative evidence, it sets out that sales under the GOAT brand between 2015 and 2021 in the UK were "well in excess of £8 million".³³ In my view, it is reasonable to infer that this provides confirmation as to how much of the above figures provided can be said to cover the 'GOAT' branding, i.e. at least £8 million.

97. In support of the turnover figures provided, I note that a range of order confirmations have been provided showing the shipment of products to various locations across the UK.³⁴ I note that these include copies of email confirmations to customers or packing slips, both of which show the recipient's address.

98. Screenshots showing GOAT branded apparel being available for purchase from Goatfashion.com between 2015 and 2020 have been provided.³⁵ I note that these show a range of women's clothing such as dresses, skirts, coats, knitwear, tops, blouses, trousers and girl's dresses. While a '.com' website, the pages include several references to the UK, be that reference to a flagship store in London or information regarding orders placed before 12:30pm in the UK being delivered the

³³ See paragraph 11 of the witness statement of Mr Josh Webman

³⁴ JW11

³⁵ JW7

next working day. As such, I am satisfied that it is a website targeted at the UK market wherein customers can make purchases of goods. I note that none of the goods themselves appear to be emblazoned with the 'GOAT' branding but note that the websites all include the relevant branding. Further, I note that photographs have been provided that show 'GOAT' on tags, labels and boxes.³⁶ While undated, the narrative evidence confirms that customers would come across these when purchasing the goods.

99. I note that evidence of press coverage has been provided by way of articles taken from various UK-wide publications.³⁷ This evidence is voluminous and covers a range of articles that were published prior to the relevant date. I do not intend to discuss each one but note that they include a range of articles from the Mail Online, the Daily Telegraph, The Telegraph's Lifestyle/Fashion website, The Times, Marie Claire, Vogue and HELLO Magazine. Amongst some of the online articles provided, information as to monthly unique visitors and advertising value equivalency is shown. I do not intend to discuss each and every instance where this information has been provided but note that the figures provided are significant, thereby pointing to a sizeable viewership for such articles.

100. While I appreciate that the evidence demonstrates that 1661 has used the mark in the UK prior to the relevant date, I remind myself that the market at issue is the clothing market. This is a very large market with a turnover that is likely to be in the billions of pounds per annum. Even taking the evidence at its highest point (a total turnover of £14 million over six years), this is reflective of a low level of use when compared against such a market. Even taking into account the press coverage evidence provided, I am not willing to find that the distinctiveness of 1661's mark has been enhanced to any degree. Therefore, the inherent position applies, namely that 1661's mark is either inherently distinctive to between a low and medium degree or to a medium degree, depending on the goods upon which it is viewed.

³⁶ JW8
³⁷ JW12

Likelihood of confusion

101. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of 1661's 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.

102. I have found the parties' goods to be identical or similar to a medium degree. I have identified the average consumers for the goods at issue to be members of the general public at large who will select the goods after visual considerations (though I do not discount the aural component). I have concluded that the level of attention paid will be medium. The marks are visually similar to no more than a medium degree, aurally similar to a higher than medium degree and conceptually similar to a high degree. I have found that 1661's mark is inherently distinctive to between a low and medium degree when viewed on clothing that can reasonably be said to be made from goat fur/hair and, where it is not, it is inherent distinctive to a medium degree.

103. Taking all of the above into account and even bearing in mind the principle of imperfect recollection, I do not consider that average consumers will inaccurately recall or misremember the parties' marks for one another. While conceptually similar to a high degree, the visual and aural differences will be noticed and are, in my view, sufficient to avoid the risk of the marks being directly confused.

Consequently, I consider that there exists no likelihood of direct confusion between the marks, even when considered on identical goods.

104. I turn now to consider indirect confusion. In doing so, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

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

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

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

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

106. Even bearing in mind the comments of Mr Mellor Q.C. and Arnold LJ in the preceding paragraph, I am of the view that consumers would likely consider the marks at issue to originate from the same or economically connected undertakings. When confronted with the marks at issue, consumers would notice the shared use of the word 'GOAT' and the graphical depiction of the same in Mr Saddiq's mark. This shared element/concept will, in my view, be considered by consumers as the reference to the point of origin of both marks. As for the points of difference, 'TEE' in Mr Saddiq's mark will not be ignored. However, I consider that consumers would, upon seeing it, understand it as a logical indicator that the 'GOAT' brand would use in order to denote a sub-brand or brand extension that produces and sells t-shirts. As for the stylistic elements of Mr Saddiq's mark, I appreciate that these will not be overlooked, however, I am of the view that they will be simply viewed as alternative stylings used by the same or economically linked undertakings. For example, the word only mark is one that would be used in promotional text whereas the figurative mark is one that would be used on packaging or signage. Lastly, I consider that the above applies even where 1661's mark is considered inherently distinctive to between a low and medium degree. I say this because (1) a weaker degree of distinctive character does not preclude a likelihood of confusion³⁸ and (2) 'GOAT', while allusive, is still a somewhat unusual way to refer to a product that uses goat

³⁸ *L'Oréal SA v OHIM*, Case C-235/05 P

fur/hair as a material. As such, I do not consider the shared use of 'GOAT' would be considered coincidental. Consequently, I consider that there is a likelihood of indirect confusion between the marks at issue for all identical/similar goods.

107. As a result of the above, 1661's opposition will succeed in full. However, for the sake of completeness, I will proceed to consider the remaining grounds of this opposition.

Section 5(3)

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

"5(3) A trade mark which –

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

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

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

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

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

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

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

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

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

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

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

110. The conditions of section 5(3) are cumulative. Firstly, 1661 must show that its mark and Mr Saddiq's mark are similar. Given my findings under the section 5(2)(b) ground above, it is clearly my view that they are similar. Secondly, 1661 must show that its mark has achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the parties' marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the later mark. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

Reputation

111. I have already conducted an assessment of 1661's evidence in respect of its class 25 goods at paragraphs 95 to 100 above. While I have no intention of reproducing the evidential summaries in full here, I remind myself that 1661 has provided evidence in respect of a total UK revenue of over £14 million between 2015 and 2020 and I have determined it reasonable to conclude that at least £8 million of this relates to the 'GOAT' brand (as opposed to the KID BY GOAT branding also covered by the evidence). Further, I remind myself that there has

been extensive press coverage since 2016 of the 'GOAT' branding in a range of UK-wide publications. I do not consider it controversial to suggest that some of these publications cover popular newspapers and magazines. As I have set out above, the relevant market for the present consideration is the clothing market which is a very large market with an annual turnover that is likely to sit in the billions of pounds. When compared with such a market, the turnover provided is low.

112. Even taking into account the low turnover, it is still reflective of a respectable level of sales. In addition, I find that the press coverage is sufficient to push 1661's mark over the line in proving that a reputation does exist. That being said, the reputation is, in my view, only moderate in strength and relates to "women's and girl's clothing" only. I limit the reputation in this way because, as I have discussed at paragraph 98 above, the evidence before me covers a wide range of women's and girl's clothing. I appreciate that there is evidence before me regarding American athletes attending 'GOAT' events and possibly wearing 'GOAT' clothing,³⁹ however, there is nothing before me to suggest advertising or sales of men's clothing of any kind in the UK.⁴⁰

Link

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

The degree of similarity between the conflicting marks.

114. Following the findings I have made under the section 5(2)(b) ground, I find that the marks are visually similar to no more than a medium degree, aurally similar to a higher than medium degree and conceptually similar to a high degree.

³⁹ See, for example, the social media evidence at JW5 which shows NBA stars such as James Harden and Kyrie Irving attending such events.

⁴⁰ I appreciate that in the present case, I have found 1661's mark to enjoy a reputation but not an enhanced degree of distinctiveness. I remind myself that while the tests for these assessments are similar, they are not the same. For example, reputation represents a knowledge threshold whereas distinctiveness is a measure of how strongly a mark indicates to consumers that goods/services marketed under that mark must be with the owner's consent. Further, I note the comments of Prof. Phillip Johnson sitting as the Appointed Person in the case of CXO2 (BL O/393/19) wherein he stated that reputation in itself does not make a mark highly distinctive.

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

115. The section 5(2)(b) assessment as to the goods was made in respect of 1661's wider range of goods. These have been limited in the present ground to just "women's and girl's clothing". Given that the majority of Mr Saddiq's clothing goods can cover women's and girl's clothing, I find that they are identical under the principle outlined in *Meric*. Having said that, I do not consider that this can be said to apply to all of the clothing goods in Mr Saddiq's mark's specification. This is because Mr Saddiq's goods include "men's clothing". While not identical, they are still similar to "women's clothing" to at least a medium degree on the basis that they overlap in nature, method of use, purpose and trade channels.

116. As for the goods of Mr Saddiq that cover headwear, I consider that there still exists some similarity between them and "women's clothing". This is because the goods overlap in user and trade channels. Further, while the goods are worn on different parts of the body, there is still some overlap in purpose as all of the goods can be worn for stylistic purposes or to protect the user from the elements. As such, I consider that there exists between a low and medium degree of similarity between them.

117. In respect of the "parts and fittings for all the aforesaid goods" in Mr Saddiq's specification, I consider that insofar as it applies to Mr Saddiq's clothing goods, there exists a medium degree of similarity between them and "women's and girl's clothing". As for the parts and fittings for the various headwear goods, I consider that there exists an overlap in user only. While I consider this would ordinarily render the goods dissimilar under a comparison under 5(2)(b) grounds, I remind myself that, as above, goods do not need to be similar for the present ground to succeed. On this point, I note that the relevant section of the public for these dissimilar goods would be the same meaning that there remains a degree of closeness between them.

The strength of the earlier mark's reputation.

118. 1661's mark enjoys a reputation that is moderate in strength.

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

119. 1661's mark possesses between a low and medium degree of inherent distinctive character when relating to knitwear but, where it does not, that level increased to a medium degree.⁴¹

Whether there is a likelihood of confusion

120. While I have found there to be no likelihood of direct confusion, I have found that there exists a likelihood of indirect confusion between the marks at issue for all of those goods that are identical and/or similar.

Conclusion on link

121. While I have found the strength of 1661's mark to be only moderate, I am of the view that a link would still be made. I say this because the marks are sufficiently similar and while not all of the goods are similar, they share a sufficient degree of closeness because they will all be selected by the same section of the relevant public. In my view, when confronted with Mr Saddiq's mark, the average consumer that is aware of 1661's mark will be caused to wonder if it is linked to 1661's mark.

Damage

122. 1661 has pleaded that use of Mr Saddiq's mark would, without due cause, lead to an unfair advantage in favour of Mr Saddiq and cause a detriment to both the reputation of 1661 and to the distinctive character of 1661's mark.

⁴¹ While the finding was made in respect of all goods in 1661's mark's specification, it applies equally to 1661's reputed goods.

Unfair Advantage

123. I bear in mind that unfair advantage has no effect on the consumers of 1661's mark's goods. Instead, the taking of unfair advantage of the distinctive character or reputation of an earlier mark means that consumers are more likely to select the goods of the later mark than they would otherwise have been if they had not been reminded of the earlier mark.

124. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. (as he then was) considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

125. Given that I have found there to be a likelihood of confusion between the marks at issue under the 5(2)(b) ground above, it follows that unfair advantage is automatically made out on the basis that the consumer would erroneously purchase the goods of Mr Saddiq in the mistaken belief that they are the goods of 1661. In such circumstances, it is implicit that there would be an unfair advantage for those goods in the parties' marks that are identical or similar.

126. For the avoidance of doubt, due to the shared section of the relevant public that will select the parties' goods, I consider that the above finding applies to those goods that are dissimilar also. This is because Mr Saddiq, by using the identical element of 'GOAT', would achieve instant familiarity in the eyes of the average consumers, thereby securing a commercial advantage and benefitting from 1661's reputation without paying financial compensation. Such commercial advantage would not exist were it not for the reputation of 1661's mark.

127. As damage is made out on the basis of unfair advantage, I do not consider it necessary to go on to consider 1661's other heads of damage. The 5(3) ground of the present opposition, therefore, succeeds.

Section 5(4)(a)

128. Section 5(4)(a) of the Act reads as follows:

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

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

(aa)

(b)

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

129. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of

application for registration of the trade mark or date of the priority claimed for that application.”

130. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

131. Halsbury’s Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

“Establishing a likelihood of deception generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other indicium which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

- (a) the nature and extent of the reputation relied upon,
- (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

Relevant date

132. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, as the Appointed Person, endorsed the registrar’s assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

“43. In *SWORDERS TMO-212-06* Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’ ”

133. Mr Saddiq’s mark does not have a priority date. Further, there is no evidence of any earlier use of Mr Saddiq’s mark that is capable of being deemed earlier behaviour complained about.⁴² As a result, the relevant date for the present assessment is the filing date of Mr Saddiq’s mark, being 11 April 2022.

Goodwill

134. The first hurdle for 1661 is that it needs to show that, at the relevant date, it had the necessary goodwill in its business and that the sign relied upon was distinctive and/or associated with that goodwill. I note that there is evidence before me from Mr Saddiq regarding a form TM7 filed on 7 September 2021 (in relation to separate proceedings) that claims that it was Goat Fashion Limited and not 1661 that had goodwill in the GOAT mark.⁴³ I note that Mr Hannay raised this point at the hearing and claimed that there is no certainty as to whether 1661 acquired the goodwill of Goat Fashion upon being assigned the mark. On this point, I note that the witness statement of Mr Webman sets out, at paragraph 14, that 1661 acquired all the goodwill attached to the trade marks acquired from Goat Fashion in 2021. While no agreement confirming this has been provided, I see no reason to doubt Mr

⁴² On this point, I note that there is evidence before me of an assignment of Mr Saddiq’s mark by a Swedish designer in 2017 (see APP-02). However, this is not use that is capable of being the behaviour complained about.

⁴³ See paragraph 9 of the witness statement of Mr Hannay dated 13 January 2023 and APP-08.

Webman on this point as his statement is accompanied by a signed statement of truth. As such, I am of the view that if I find any goodwill to have vested in Goat Fashion in 2021 (and that said sign relied upon is associated with/distinctive of that goodwill), I am satisfied that it was assigned accordingly to 1661 in 2021.

135. Goodwill was described in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), in the following terms:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

136. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not

occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

137. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

138. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation.”

139. Under the present ground, I remind myself that 1661 relies on the unregistered sign of 'GOAT' which it claims to have used in the UK since at least 2004. The goods and services relied upon under the present ground are as follows:

“Clothing and knitwear; fashion clothing; ladies’ clothing, coats, frocks, skirts, dresses, jackets, jerseys, sweaters, trousers, tops, evening wear, headgear, footwear, retail services and online retail services in connection with the retail of clothing, footwear, headgear and bags.”

140. I have summarised the relevant evidence insofar as it relates to class 25 goods at paragraphs 95 to 100 above. I do not intend to repeat this summary here but following the same reasons when discussing the issue as to reputation at paragraphs 111 and 112 above, I am of the view that there existed a protectable level of goodwill in 1661’s business as at the relevant date and that 'GOAT' is associated with and/or distinctive of that goodwill. Based on the summaries of the evidence already provided above, I am satisfied that this goodwill relates to 1661’s business of “women’s and girl’s clothing”. That being said, my summaries of the evidence related to clothing goods and not the retail of the same, being a service relied upon in the present ground. As a result, I am required to consider the evidence further. I do not consider that this issue necessarily furthers 1661’s case so will deal with it briefly here.

141. As discussed in my evidential summary above, 1661 has provided printouts that show products for sale on the website 'goatfashion.com'. While a '.com' website, it makes several references to the UK by way of reference to a flagship store in London and information regarding orders placed before 12:30pm in the UK will be delivered the next working day. Further, the order confirmation evidence that I have discussed briefly above is, in my view, confirmation that sales took place via the GOAT website. I say this because the confirmation emails provided make reference to 'goatfashion.com' and information as to the customer care email address being @goatfashion.com. In my view, it is reasonable to infer that the sales associated with these confirmations were provided by 1661’s online retail service. While these confirmations are not provided in large volumes, I consider it

reasonable to infer that the actual retail sales provided would have been at a reasonable level, particularly given that the online store is only one of two methods for purchasing 'GOAT' clothing shown before me in evidence.

142. I appreciate that 1661 operates a physical retail store but I do not see any evidence as to the level of sales associated with this store. While I was willing to make an inference in respect of online retail services, I am not willing to do so in respect of physical retail due to the limited nature of such evidence. As such, I am only willing to accept that there exists a level of protectable goodwill in its online retail services only. As above, the term for which goodwill is claimed is "retail services and online retail services in connection with the retail of clothing, footwear, headgear and bags". Given what I have said throughout this decision, I consider it reasonable to limit this to "online retail services in connection with the retail of women's and girl's clothing."

Misrepresentation

143. In considering the issue of misrepresentation, I acknowledge that the outcome for this assessment often follows the outcome of 5(2)(b) grounds, if pleaded.⁴⁴ I appreciate that, in the present case, I have found there to exist a likelihood of confusion under 1661's 5(2)(b) ground. That being said, the goods upon which this outcome of confusion was based are broader than those in respect of which I have found that 1661 has a protectable goodwill. Therefore, it does not automatically follow that just because there was confusion above that there must be a misrepresentation here. Having said that, however, I do not consider that this issue has much of an impact. I say this because 1661's goodwill is associated with "women's and girl's clothing" and "online retail services in connection with the retail of women's and girl's clothing". These goods and services are, for the most part, still similar to a degree with Mr Saddiq's goods. Even where they are not, they still concern the same or associated fields of activity, i.e. clothing. As such, I consider that when confronted with Mr Saddiq's mark, being one that is similar to the sign

⁴⁴ See the comments of Lewinson L.J in the case of *Marks and Spencer PLC v Interflora* [2012] EWCA (Civ) 1501

'GOAT', a substantial number of members of the public will be deceived into believing that it is in some way associated with 1661's business.

144. Given that I have found that there is a misrepresentation, I consider that damage through diversion of sales is easily foreseeable or, alternatively, use of Mr Saddiq's mark may result in 1661 losing control over its own reputation.⁴⁵ The opposition based upon section 5(4)(a), therefore, succeeds in full.

Final remarks in respect of 1661's opposition

145. Given the level of success in respect of 1661's mark, I do not consider it necessary to return to consider the remaining marks relied upon. To do so would not further 1661's case and neither would it affect the outcome of the opposition to the benefit of Mr Saddiq.

146. One point that does warrant further comment at this stage, however, is the fact that the conclusions under the sections 5(2)(b) and 5(3) grounds of the opposition are based upon a mark that is yet to complete its registration process. As per section 6(2) of the Act (reproduced above), an earlier mark may include one for which registration has been sought but not yet achieved. Reliance upon such a mark is *subject to its being so registered*. Given that 1661's mark is yet to achieve registration, any decision reliant upon it is provisional pending its registration. Technically, this remains the case regardless of the fact that the ongoing opposition against that mark is not aimed at the goods that were relevant in my decision. As a result, my findings under the section 5(2)(b) and 5(3) grounds are provisional and can only be confirmed upon the registration of 1661's mark. In such circumstances, I am required to issue a supplementary decision confirming the outcome of my decision upon the registration of the earlier mark.⁴⁶

147. All of the above being said, my findings under the section 5(4)(a) ground are not reliant upon the pending mark. Given that this ground succeeded in full, my

⁴⁵ See *Harrods Limited V Harrodian School Limited* [1996] RPC 697

⁴⁶ Ordinarily, this would be upon the registration of the mark or successful opposition of the same. However, in the present case, the successful opposition of 1661's mark would still result in registration of the mark as the opposition is only partial and not aimed against the class 25 goods at issue here.

decision is capable of being considered final. While that may be the case, I do consider it appropriate to issue a supplementary decision confirming the outcome of the section 5(2)(b) and 5(3) grounds of my decision at the appropriate time. However, this is merely a formality as the degree of success of 1661's opposition will remain unchanged.

148. In respect of costs, I am of the view that regardless of the fact that the outcome of my decision will not change, it is still technically provisional until my supplementary decision is issued. As a result, I consider it appropriate to deal with costs at that time.

CONCLUSION

149. Subject to any successful appeal, Mr Saddiq's invalidation application has failed in its entirety meaning that 1661's first mark may remain protected for all goods for which it is registered.

150. 1661's opposition succeeds in full meaning that, subject to any successful appeal, Mr Saddiq's mark is refused registration for all of the goods that he sought to register.

151. For the avoidance of doubt, the above outcomes (insofar as they rely on 1661's third mark) are technically provisional due to the pending opposition against 1661's third mark. When the outcome of those proceedings are decided, I will issue a supplementary decision which will formally bring these proceedings to a close and, as above, will include a decision on costs. The appeal period for these proceedings will not begin until the issuance of that decision.

Dated this 19th day of April 2024

A COOPER
For the Registrar

ANNEX

Class 9

Software; e-commerce software; computer software in the field of e-commerce; mobile application software in the field of e-commerce; downloadable and non-downloadable software in the field of e-commerce; computer and mobile application software to allow users to perform electronic business transactions; e-commerce software allowing users to find, research, analyze, compare, sell, and purchase goods and services; computer and mobile application software to allow users to perform electronic business transactions via the Internet, global computer communication networks, and wireless telecommunications networks; computer and mobile application software to allow users to find, research, analyze, compare, sell, and purchase goods and services; computer and mobile application software for advertising, buying and selling new and used clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; computer and mobile application software for buyers and sellers to transact over consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; computer and mobile application software for use in operating an online marketplace for buyers and sellers to transact over consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; computer and mobile application software for use in the online retail sale for others of consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; computer and mobile application software in the field of analyzing consumer and marketplace trends; computer and mobile application software for verifying the authenticity of consumer products; computer and mobile application software for verifying the authenticity of clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; computer and mobile application software for categorizing and indexing products; computer and mobile application software for analyzing and displaying sales trends, customer demands and buying patterns;

computer and mobile application software for test fitting consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets using augmented reality; computer and mobile application software featuring augmented reality; computer and mobile application software for managing user accounts; computer and mobile application software for managing the listing of goods and services available for sale and purchase; electronic publications, articles, magazines, newsletters, catalogues and blogs; Computer application software allowing users to find, research, analyze, compare, sell, and purchase goods and services via the Internet, global computer communication networks, and wireless telecommunications networks.

Class 18

Bags; duffle bags; back packs; wallets; purses.

Class 25

Clothing; footwear; headwear; apparel; shoes; athletic footwear; athletic shoes; basketball shoes; casual footwear; casual shoes; hiking shoes; jogging shoes; leisure shoes; running shoes; sports footwear; sports shoes; track shoes; training shoes; sneakers; sandals; flip flops; boots; track suits; athletic apparel; athletic clothing; casual clothing; casual wear; sports clothing; sports wear; shorts; athletic shorts; running shorts; pants; casual pants; jogging pants; track pants; jeans; trousers; casual shirts; short sleeve shirts; long sleeve shirts; sweatshirts; sweaters; hoodies; jerseys; formal wear; dresses; gowns; skirts; jackets; coats; suits; vests; women's wear; men's wear; children's wear; babies' wear; men's clothing; women's clothing; children's clothing; baby clothing; socks; intimate wear; underwear; boxers; briefs; bras; panties; lingerie; swimwear; bathing suit; swimming trunks; belts; ties; pyjamas; lounge wear; scarves; gloves; mittens; face masks; face shields; headbands; ear muffs; hats; helmets; sports caps; baseball caps; clothing accessories; accessories.

Class 35

Online retail services; e-commerce services; wholesale services; providing business and commercial information; consignment sale services; online consignment store services; retailing of consumer products; online retail services for consumer products;

online retail sale of consumer products; online wholesale services of consumer products; providing an online marketplace for buying and selling new and used goods; providing an online marketplace for connecting potential buyers with potential sellers; providing an online marketplace for buyers and sellers to transact over consumer products; promoting the goods and services of others via a website and mobile application; advertising the goods and services of others; dissemination of advertisements; online advertising on a computer network; sales promotion for others; providing consumer product information via a website and mobile application; wholesale and retail services featuring clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; distribution services, namely, distribution of clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; catalogue ordering services featuring clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; operation of an online retail site and mobile application for advertising, buying and selling new and used clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; operation of an online retail site and mobile application for buyers and sellers to transact over consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; operation of an online marketplace for buyers and sellers to transact over consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; online retail sale for others of consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; operation of a website and provision of a mobile application that allow customers to view and purchase goods and services of others; operation of a website and provision of a mobile application that allow customers to post, advertise for, sell and purchase the goods and services they want; operation of a website and provision of a mobile application that allow third parties to list and offer for sale goods and services; operation of a website and provision of a mobile

application for displaying sales trends, customer demands and buying patterns; operation of a sales platform for online users to shop for consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; providing computerized online ordering services; providing business and commercial information, namely, evaluative feedback in the form of ratings, reviews, recommendations and other consumer information regarding the value and prices of sellers' goods, buyers' and sellers' performance, delivery, and transaction experience via a website and mobile application; the bringing together, for the benefit of others, of a variety of consumer products, namely clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets, to enable sellers to sell and purchasers to purchase those products by electronic means; presentation of goods on communication media for the retailing of consumer products; consultancy, information and advisory services in the field of consumer products; consulting, information and advisory services in the field of consumer and brand protection; rental of advertising space; import and export agency services; operation of a website and provision of a mobile application featuring digital content, namely, publications, articles, magazines, newsletters, catalogues and blogs; Providing an online marketplace for buyers and sellers of collectible consumer goods namely, athletic and sporting footwear; database management services; providing a website featuring evaluative feedback in the form of ratings, reviews, recommendations and other consumer information regarding the value and prices of sellers' goods, buyers' and sellers' performance, delivery, and transaction experience for commercial purposes; providing a searchable advertising guide featuring the goods and services of sellers; advertising and advertising services.

Class 38

Telecommunication services; data communication services by electronic means; telecommunication services, namely transmission of images, videos, audio recordings, electronic messages, text messages, e-mail notification and push-notification alerts via the Internet, global computer communications networks, and wireless; telecommunication services, namely communications between buyers and sellers by electronic means via the Internet, global computer communications networks, and wireless telecommunications networks; providing access to a website

and mobile application to facilitate e-commerce transactions; providing access to an online marketplace via a website and mobile application; providing access to a website and mobile application to connect buyers and sellers of consumer products; providing access to a website and mobile application for advertising, buying and selling new and used consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; providing access to an online retail site and mobile application for buyers and sellers to transact over consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; providing access to an online marketplace for buyers and sellers to transact over consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; providing access to an online retailer for others to advertise, sell and purchase consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; providing access to computer database containing business and commercial information; providing access to computer database featuring reviews of consumer products and sellers; providing access to online publications, articles, magazines, newsletters, catalogues and blogs; Telecommunication services, namely transmission of electronic messages, text messages, and push-notification alerts between consumer product buyers and sellers on the Internet, global computer communications networks, and wireless telecommunications networks.

Class 42

Application service provider (ASP) services; software as a service (SaaS) provider; application service provider (ASP) services in the field of e-commerce; software as a service (SaaS) provider in the field of e-commerce; application service provider (ASP) services in the field of facilitating electronic business transactions via the Internet, global computer communication networks, and wireless telecommunications networks; software as a service (SaaS) provider in the field of facilitating electronic business transactions via the Internet, global computer communication networks, and wireless telecommunications networks; application service provider (ASP) services in

the field of facilitating the online purchase and sale of consumer goods via the Internet, global computer communication networks, and wireless telecommunications networks; software as a service (SaaS) provider in the field of facilitating the online purchase and sale of consumer goods via the Internet, global computer communication networks, and wireless telecommunications networks; application service provider (ASP) services for advertising, buying and selling new and used consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; software as a service (SaaS) provider for advertising, buying and selling new and used consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; application service provider (ASP) services for buyers and sellers to transact over consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; software as a service (SaaS) provider for buyers and sellers to transact over consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; application service provider (ASP) services in the field of an online marketplace for buyers and sellers to transact over consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; software as a service (SaaS) provider in the field of an online marketplace for buyers and sellers to transact over consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; application service provider (ASP) services in the field of online retail sale for others of consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; software as a service (SaaS) provider in the field of online retail sale for others of consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories; application service provider (ASP) services in the field of analyzing consumer and marketplace trends; software as a service (SaaS) provider in

the field of analyzing consumer and marketplace trends; application service provider (ASP) services in the field of augmented reality; software as a service (SaaS) provider in the field of augmented reality; application service provider (ASP) services featuring software for virtual test fitting of clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; software as a service (SaaS) provider featuring software for virtual test fitting of clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; providing use of software for electronic business transactions in online marketplaces via the Internet, global computer communication networks, and wireless telecommunications networks; hosting an e-commerce website on the internet; hosting an e-commerce website on the internet featuring consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; hosting an application for mobile phones and tablet computers in the field of e-commerce; hosting an application for mobile phones and tablet computers featuring consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; hosting an application for mobile phones and tablet computers for the retail sale of consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; hosting of digital content, namely, publications, articles, magazines, newsletters, catalogues and blogs; creating and maintaining blogs for others; validating the authenticity of consumer products; authentication of consumer products; authentication of origin of clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; Providing temporary use of online non-downloadable software for electronic business transactions in online marketplaces utilizing the Internet, global computer communication networks, and wireless telecommunications networks; authentication services in the field of collectible consumer goods, namely, the inspection and verification of authenticity of athletic and sporting footwear, apparel, and works of art; Providing use of online non-downloadable software.