O/0469/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER 4091284
IN THE NAME OF ABDULWAHED BIN SHABIB DISTRIBUTION
FOR THE TRADE MARK

GymBull

IN CLASS 25

AND

THE OPPOSITION THERETO UNDER NUMBER 452082
BY GYMSHARK LIMITED

Background and pleadings

1. Abdulwahed Bin Shabib Distribution ("the applicant") filed an application for the trade mark shown on the cover page of this decision (number 4091284) on 23 August 2024 ("the relevant date") for goods in class 25:

> *Clothing; coats; dresses; dressing gowns; headbands [clothing]; headscarves; hoods [clothing]; jackets [clothing]; jumper dresses/ pinafore dresses; knitwear [clothing]; leggings; leg warmers; trousers; petticoats; pyjamas; ready-made clothing; ready-made linings [parts of clothing]; scarves; shirts; short-sleeves shirts; stuff jackets [clothing]; suits; sweaters; jumpers; pullovers; tee-shirts; trousers; pants; waistcoats / vests.*

2. Gymshark Limited ("the opponent") opposes the application under sections 5(2)(b), 5(3), 5(4)(a) and 3(6) of the Trade Marks Act 1994 ("the Act"). The opponent relies upon classes 25 and 35 of the following earlier trade mark registration for its section 5(2)(b) and 5(3) grounds:

(i) 3446283 (series of 4 marks)
GYMSHARK
Gymshark
GymShark
gymshark

Filing date: 22 November 2019; priority date 8 November 2019 (Pakistan); registration date: 27 March 2020

3. Under section 5(2)(b), the opponent claims that the parties' goods are identical and highly similar and that the marks are highly similar, leading to a likelihood of confusion.

4. Under section 5(3), the opponent claims a reputation in its series of marks for the goods and services relied upon, and that the parties' marks are highly similar, with the result that the relevant public will believe that the parties' marks are used by the same undertaking or an economically connected undertaking. It claims that there will also

be unfair advantage because the contested mark will ride on the coat-tails of the opponent's reputation, unfairly benefitting from the opponent's marketing and advertising efforts. It also claims that there would be detriment to the distinctive character and repute of the earlier series of marks. As to the former, the opponent claims that consumers would be less able to identify the earlier series of marks as an exclusive indicator of origin. There is no separate explanation for the claim to detriment to repute, which is inadequately pleaded.

5. Under Section 5(4)(a), the opponent claims that it has used four signs corresponding to its series of four marks (as above) throughout the UK since 2012 in relation to *clothing, footwear, headgear; coats; dresses; headbands; headscarves; jackets; knitwear; leggings; leg warmers; trousers; pyjamas; ready-made clothing; ready-made linings [parts of clothing]; scarves; shirts; short-sleeves shirts; sweaters; jumpers; pullovers; tee-shirts; trousers; pants; waistcoats; vests; and retail, online retail, mail order and wholesale services, including temporary and 'pop-up' retail store services in connection with clothing, footwear, headgear, coats, dresses, headbands, headscarves, jackets, knitwear, leggings, leg warmers, trousers, pyjamas, ready-made clothing, ready-made linings [parts of clothing], scarves, shirts, short-sleeves shirts, sweaters, jumpers, pullovers, tee-shirts, trousers, pants, waistcoats, vests.*

6. The opponent claims that its business, distinguished by the four signs, has goodwill and that the use of the application would cause misrepresentation and damage to its goodwill. On this basis, the opponent claims that use of the application is contrary to the law of passing off.

7. The section 3(6) ground is pleaded as follows:

> "28. The Opposed Mark is overall highly similar to the Earlier Marks, for the same reasons outlined at paragraphs 6-9, and/or similar/reminiscent to the well-known RedBull mark seen below, which is construed in a similar way to the Opposed Mark and also features a 'bulls' device (registered in the UK in the name of Red Bull GmbH under, inter alia, Registration No. UK00003476267):

29. The Opponent's online research highlighted a number of other trade mark applications in the UK in the name of the Applicant (with similar applications in other jurisdictions} for marks comprising and/or resembling well-known/reputable marks, including the following notable examples:[1]

UK TM Application Number	Mark	Classes	Examples of the earlier marks imitated
UK00004086885	THE SOUTH FACE	3, 18, 25	THE NORTH FACE

[1] The curved pink background is part of a watermark in the opponent's representative's headed notepaper, used for the statement of grounds, from which I have copied the table to ensure complete reproduction.

			owned by The North Face Apparel Corp.
UK00004086887	ARMANI BROTHERS	3, 18, 25	**ARMANI** owned by GIORGIO ARMANI S.P.A.
UK00004073362	TOMMY	3, 18, 25	**TOMMY** owned by Tommy Hilfiger Licensing B.V.
UK00004062584	Calvin Bags	18	Calvin Klein owned by CALVIN KLEIN TRADEMARK TRUST
UK00004073464	UPPER ARMOUR	18, 25	and **UNDER ARMOUR** owned by UNDER ARMOUR, INC.

30. The Applicant has engaged in a pattern of filing to protect, in the UK as well as in other jurisdictions, trade marks that resemble well-known/reputable marks, without an apparent reason to do so. The Opponent's online investigations (to be substantiated during the evidential rounds) do not suggest any relationship with the third-parties referenced above, or use on the market of any of the marks for which protection is sought.

31. It is therefore clear from the above trade mark filing activity (which includes the filing of the Application) and the resemblance of the Opposed Mark with the Earlier Marks and/or with the well-known brand 'Red Bull', that there is no obvious commercial logic for the Application to have been filed.

32. The Applicant's conduct in its attempt to register marks that are reminiscent or close copies of well-known/reputable marks (such as those shown above by way of example), including the present Application for the Opposed Mark, departs significantly from accepted principles of ethical behaviour or honest commercial and business practices. This is reinforced by the fact that out of the Applicant's pending UK Trade Mark Applications as of 26 February 2025 (of which there are 20 in total), 15 have been opposed. In particular, all of the applications identified in the table above have been opposed by the owners of the corresponding well-known marks they imitate (this information is readily available from the UK IPO website and will be submitted in the appropriate format during the evidential stage of the proceedings).

33. The Applicant's actions with respect to other well-known third-party marks (namely, its filing of multiple marks that imitate various famous/reputable brands including the Opposed Mark) are capable to support a bad faith claim, as confirmed by Mr Geoffrey Hobbs in Paper Stacked Ltd v CK Holdings NV (ALEXANDER Trade Mark) BLO/036/18 at paragraph 19 (emphasis added):

"[…] Since there is no requirement for the objector to be personally aggrieved by the filing of the application in question, it is possible for an objection to be upheld upon the basis of improper behaviour by the applicant towards persons who are not parties to the proceedings provided that their position is established with enough clarity to show that the objection is well-founded."

34. In view of the above, it is the Opponent's submission that there is no commercial logic for the Applicant's filing pattern. It is further submitted that there is no bona fide intention to use the Opposed Mark and/or that the Applicant's conduct in filing the Application in line with the filing pattern identified above falls short of honest standards of accepted commercial behaviour, as will be demonstrated during the course of the proceedings.

35. Further or in the alternative, it is submitted that the purpose of filing the Application (and indeed all applications outlined above) is to intentionally

mislead the public or to create conflict with the earlier rights holders, rendering the Application an instrument of fraud."

8. The applicant filed a defence and counterstatement. Whilst accepting that the parties' class 25 and 35 goods and services are identical or complementary, it denies the grounds of opposition and puts the opponent to proof of reputation and goodwill. The applicant's denial of the section 3(6) ground is as follows:

"28. The Applicant denies the application was filed in bad faith. An allegation of bad faith is a serious allegation which must be distinctly proved. The Opponent has not advanced any explanation on why it considers the application to be in bad faith other than pointing to other applications filed by the Applicant and claiming this to be a sign that the Applicant's behaviour falls short of honest standards of accepted commercial behaviour. This claim is strongly denied by the Applicant.

29. The mere fact that a trade mark bears some similarity to another trade mark is not in itself a marker of bad faith. Indeed, many of the marks listed in paragraph 29 of the Opponent's Statement of Grounds could be construed as parodies. The right to publish parodies is an important aspect of free speech (Human Rights Act s12) and is not sufficient to amount to bad faith. It is not an inherently dishonest business practice to use a sign which brings another trader to the mind of some consumers in an amusing but inoffensive way (*Swatch AG v Apple Inc* [2021] EWHC 719 (Ch)).

30. It is denied that the Applicant's conduct in filing the application was dishonest as the mark applied for is not confusingly similar to the Opponent's earlier mark. Registration of the mark applied for would not in any way block or hinder the Opponent's use of its mark. As advised in paragraph 29 above, many of the marks listed in the Opponent's Statement of Grounds could be construed as parodies. Nonetheless, and irrespective of any co-pending marks that the Applicant has filed, there is nothing intrinsically wrong with the Applicant

filing the current application as it would not be confused with the Opponent's mark. The Applicant has a bone fide intention to use the mark on the goods in question."

9. The opponent is represented by Springbird IP Limited and the applicant by Lincoln IP. Both parties filed evidence. The opponent filed submissions in reply to the applicant's evidence and in lieu of attendance at a hearing, no hearing having been requested by either party. I make this decision after careful consideration of all the papers on file, referring to them as necessary.

Evidence

10. The opponent's evidence comes from Laura Todhunter, a trade mark attorney and the CEO of the opponent's legal representatives.[2] Her evidence chiefly goes to the opponent's reputation and to supporting the section 3(6) claim with information about other trade mark applications and proceedings involving the applicant. The applicant's evidence comes from Gail Nichol, its trade mark attorney, replying to the opponent's evidence.[3] I will begin with setting out what they both state, as far as is relevant to the issues I have to decide.

11. Ms Todhunter's witness statement does not provide a narrative about the opponent. Three very brief paragraphs serve simply to adduce three exhibits about the opponent. Exhibit LTT01 comprises 170 pages of extracts from various articles containing information about the opponent's activity. Exhibit LTT02 comprises information about some of the publications in which the articles appear, including the estimated reach. Exhibit LTT03 comprises public extracts from the opponent's accounts at Companies House about the opponent's annual revenue between 2020 and 2024.[4] I have examined all of these exhibits and have extracted what I consider to be pertinent. However, it would have been helpful to have been referred to specifics or, at the least, to have had some explanation of what the opponent wanted me to glean from all of these pages.

[2] Witness statement dated 23 June 2025 and exhibits
[3] Witness statement dated 19 August 2025
[4] Up to 31 July 2024, which is just prior to the relevant date

12. The accounts state that the opponent's principal activity is the sale of fitness and conditioning clothing and associated accessories through e-commerce channels. The 2023 report refers to the successful launch of the opponent's first permanent retail store on Regent Street, and the 2024 report to the opening of its second store in July 2024, in Westfield, Stratford, and to partnerships with Selfridges in its stores on Oxford Street and in the Trafford Centre. UK-specific turnover figures are given for 2021 to 2024: £86.4 million for 2021, £89 million for 2022, £111.7 million for 2023 and £136.4 million in 2024.

13. I note, in particular, the following from the articles:

- the opponent is known for matching leggings, shorts and fitted tops, often modelled on sculpted gym-goers. Its focus is on conditioning and gymwear, with Gen Z making up half of its customer base, with its social media and marketing being "heavily populated with extremely toned, attractive people" (*Vogue Business*, 12 January 2022);

- Womenshealthmag.com reported, on 7 March 2024, that the opponent had launched an 'athleisure' Gymshark range at Selfridges, noting that its leggings were some of the best in the business, its sweatshirts cosy, its products affordable, and that the opponent organises fun community events;

- SGB Media Online reported, on 16 July 2024, that the opponent had opened a second UK store, in Westfield, Stratford City, referring to the opponent as being "ambitious gym-focused activewear retailers." The article refers to the 18,000 square feet Regent Street store having opened in 2022 and to the opening of "permanent spaces in Selfridges in London and Manchester Trafford Centre" earlier in 2024;

- giraffesocialmedia.co.uk reported that the opponent uses influencers to market its goods. The article was published in 2021 and updated in October 2022;

- an article on the BBC's website dated 14 August 2020 is headlined "Gymshark: Ex-pizza delivery boy's sportwear firm worth over £1bn", reporting that a large part of the opponent's success is due to its significant social media following;

- an article on forbes.com, dated 17 August 2020, refers to the opponent's target audience of 18 to 25 year-olds, "whose lives revolve around fitness, fashion and music";

- an article dated 3 June 2024 on internetretailing.net says that the opponent has become "a juggernaut at the activewear end of the sports goods industry". The opponent is described as having "built a powerful brand through social media savvy and influencer marketing that has resonated with a younger, fitness-focused demographic";

- an article dated 10 May 2022, on Global Data, reports that the UK sportwear market was valued at £13.8 billion in 2020. It lists Gymshark as one of 18 leading brands in the UK sportwear market.

14. Ms Todhunter concludes her evidence with two exhibits about bull sharks and sports teams incorporating 'bull' or 'shark'. The first, Exhibit LTT06, comprises an extract from National Geographic which says that bull sharks get their name because of their short, blunt snout and a tendency to head-butt their prey, and an extract from aquariumofpacific.org which says "their common name comes from their short blunt snout which is said to resemble that of a bull". Ms Todhunter states that these characteristics "mirror bulls". Exhibit LTT07 comprises prints from the following websites (undated or post-relevant date): a South African rugby team called Vodacom Bulls; a rugby team called Bradford Bulls; a US basketball team called Bulls; a US baseball team called Chicago Bulls; a South African rugby team called The Sharks; an Australian rules football club called Glasgow Sharks; a Jersey football team called Jersey Bulls; a rugby team called Sale Sharks; an ice hockey team called San Jose Sharks (of unknown location); an Australian basketball team called Sharks (who had a fixture with a team called Bulls, and with other teams named after animals, birds and insects); and a basketball team called Sheffield Sharks.

15. Ms Nichol's evidence is brief and consists of submissions in response to that of Ms Todhunter, without adducing any evidence about the applicant other than assertions about the applicant's rights and intentions, to which I refer later in this decision.

Section 5(2)(b) of the Act

16. Section 5(2)(b) states:

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

17. Section 5A states:

> "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."[5]

18. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pair s Europe Inc & Anor*, [2025] UKSC 25:[6]

[5] This section also applies to the grounds raised under sections 5(3) and 5(4)(a) of the Act.

[6] 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

(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 greater degree of similarity between the marks, and vice versa;

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.

(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; and

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

Comparison of goods and services

19. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*, Case C-39/97 where the CJEU stated at paragraph 23 of its judgment:

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

20. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited ("Treat")* [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

21. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, the General Court ("GC") stated that complementary means:[7]

> "82 … there is a close connection between [the goods], in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking…".[8]

22. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

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

23. The opponent's class 25 specification gives it the best case in terms of the comparison with the applicant's goods, but I will also address certain terms in the opponent's class 35 specification.[9] The parties' class 25 goods for comparison are shown in this table:

[7] Case T-325/06, the General Court.
[8] In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is capable of being the sole basis for the existence of similarity between goods and services.
[9] The full class 35 specification is shown in the annex to this decision.

Earlier mark	Application
Clothing, footwear, headgear; clothing, namely tops and bottoms; sweat absorbent clothing; bodybuilding clothing, fitness clothing, gym clothing, sports clothing; ski wear; surf wear; leisurewear; clothing for gymnastics; dancewear; clothing for running; clothing for tennis; bodybuilding and weightlifting clothing straps, wristbands and wrist straps; sweatbands; headbands; hats, caps, sun visors being head wear; beach hats; bobble hats and beanie hats; swimming caps; T-shirts, long sleeve t-shirts; crop t-shirts; running vests; vests and tank tops; polo shirts; sports shirts; crop tops; bodysuits; hooded jackets; tops, sweaters and jumpers; cardigans; knitwear; gilets; jackets; padded jackets; sports jackets; coats; jumpers; sweatshirts; cycling tops; pullovers; boxing robes; shorts; sweat shorts; gym shorts; running shorts; cycling shorts; boxing shorts; tennis shorts; dresses and skirts; clothing for martial arts; jumpsuits; dungarees; dresses and skirts for tennis; trousers; tracksuits and tracksuit bottoms; jogging bottoms; leggings; cropped leggings; ski pants; yoga pants; yoga shirts; tights; knitted tights; harem pants; underwear; thongs; briefs; boxer shorts; trunks being	*Clothing; coats; dresses; dressing gowns; headbands [clothing]; headscarves; hoods [clothing]; jackets [clothing]; jumper dresses/ pinafore dresses; knitwear [clothing]; leggings; leg warmers; trousers; petticoats; pyjamas; ready-made clothing; ready-made linings [parts of clothing]; scarves; shirts; short-sleeves shirts; stuff jackets [clothing]; suits; sweaters; jumpers; pullovers; tee-shirts; trousers; pants; waistcoats / vests.*

underwear; sports bras; bras; bralettes; socks; trainer socks and ankle socks; dressing gowns and robes; gloves; weightlifting gloves; cycling gloves; base layer clothing; compression wear clothing; swimwear; beachwear; beach cover ups and wraps; sarongs; bikini tops, bikini bottoms, tankinis; swimsuits, swimming trunks; swimming shorts; rash vests, wetsuits; shoes; sports footwear; trainers; beach footwear; boots, sandals, flip flops, sliders; slippers; boxing shoes and boots; track shoes, running shoes and spiked running shoes; cycling shoes; golf shoes; gym shoes; dance shoes and dance slippers; tennis shoes; moisture wicking sports pants, shirts and bras; articles of outer clothing; articles of underclothing; scarves; pyjamas; babies clothing, footwear, headgear; infant clothing, footwear, headgear; baby boots; bibs; romper suits; baby sleepsuits; belts; sports singlets; athletic tights; bandanas; ballet shoes; baselayer tops; cashmere clothing; cargo pants; casualwear; clothing for wear in wrestling games; cover-ups; costumes; ear muffs; suits; eye masks; earbands; fishing clothing, footwear, headgear; functional underwear; golf clothing, headgear, footwear; insoles; jeans; jerseys; jogging suits; jogging	

clothing sets; leg warmers; leather clothing; leotards; light-reflecting coats; maternity clothing; maternity sports clothing; motorcyclists clothing; neckerchiefs; nightwear; one-piece suits; padded clothing for athletic use; playsuits; plimsolls; rainwear; rugby clothing; rugby footwear; football clothing; football footwear; shapewear; sleepwear; sports garments; stretch pants; sweat-absorbent socks, stockings, leggings, underclothing, outerclothing and clothing; tennis wear; thermal clothing, headgear, underwear; waist belts; water resistant clothing; walking shoes; windcheaters; combative sports uniforms; combative sports clothing, footwear and headgear; clothing, footwear and headwear for boxing, cage fighting, kickboxing and muay thai.	

24. Both parties' specifications include *clothing*, making this term identical.

25. The law requires that goods and services be considered identical where one party's description of its goods and services encompasses the specific goods and services covered by the other party's description (and vice versa): *Gérard Meric v OHIM*.[10] On this basis, with the exception of the applicant's *ready-made linings [parts of clothing]*, all the goods in the applicant's specification are identical to the opponent's *clothing*.

[10] Case T-33/05, GC

Ready-made linings [parts of clothing]

26. Since these goods are defined as parts of clothing rather than items of clothing, it seems to me that they are not encompassed by *clothing* in the opponent's specification and there are no specified items in the opponent's specification which are identical. The opponent's clothing and the applicant's goods will have the same nature, being made of fabric, but the purpose of ready-made linings is as a constituent part of finished goods, rather than a standalone item for wear. It may be the case that ready-made linings are sold as an extra option for consumers; such as, a raincoat with a zip-in fleecy lining, in which case the goods will share trade channels as well as users. They will not be in competition but, in the example of the raincoat, will be complementary. The goods are similar to at least a medium degree.

27. The opponent also has cover in class 35 for *retail, online retail, mail order and wholesale services in connection with […] fabric linings for clothing […]*. I note that the opponent's specification is set out so that the subject goods of the retailing and wholesaling services are approximated to the class in which they fall; e.g. *retail, online retail, mail order and wholesale services in connection with […] fabric linings for clothing […]* forms part of a list of subject goods which belong to class 24. The opponent's services are still similar to the applicant's *ready-made linings [parts of clothing]* in class 25. This is because the class in which the goods have been applied for as a tool to interpret the meaning of the words used to describe them does not apply to descriptions of goods in the specification of a retail services mark in class 35. Accordingly, it is necessary to construe the meanings of the descriptions of goods forming part of the opponent's class 35 specification by reference to their ordinary, natural meaning; i.e. the retailing and wholesaling of fabric linings for clothing does not distinguish between different types of fabric linings for clothing. The applicant's goods are identical to the subject goods of the opponent's services. The goods are indispensable to the retail services relating to them. In addition to the complementary relationship between the goods and the retailing and wholesaling thereof, there is an overlap in the trade channels through which the goods and services reach the average consumer.[11] They are similar to a medium degree.

[11] See *Oakley, Inc v OHIM*, Case T-116/06, GC.

Average consumer and the purchasing process

28. As the caselaw cited above indicates, it is necessary to decide who the average consumer is for the goods and services at issue and how they purchase them. "Average consumer" in the context of trade mark law means the "typical consumer."[12] The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.*, Case C-342/97. In *Lidl Great Britain Limited & anor v Tesco Stores Limited & anor* [2024] EWCA Civ 262, Lord Justice Arnold explained:

> "16. First, the average consumer is both a legal construct and a normative benchmark. They are a legal construct in that consumers who are ill-informed or careless and consumers with specialised knowledge or who are excessively careful are excluded from consideration. They are a normative benchmark in that they provide a standard which enables the courts to strike a balance between the various competing interests involved, including the interests of trade mark owners, their competitors and consumers.
>
> 17. Secondly, the average consumer is neither a single hypothetical person nor some form of mathematical average, nor does assessment from the perspective of the average consumer involve a statistical test. They represent consumers who have a spectrum of attributes such as age, gender, ethnicity and social group.
>
> 18. Thirdly, assessment from the perspective of the average consumer is designed to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling

[12] *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).

courts and tribunals to determine such issues so far as possible without the need for evidence. ....

19. Fourthly, the average consumer's level of attention varies according to the category of goods or services in question.

20. Fifthly, the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind."[13]

29. As the opponent's best case relates to the comparison between the parties' goods, I will confine the analysis to the goods. The average consumer of the goods is a member of the general public, and the trade in relation to ready-made clothing linings. The level of attention paid will vary depending on the type and cost of the goods. However, consumers generally care about their appearance and choose such goods to meet their particular needs, such as protection against rain or cold, and durability. Although the cost of the goods varies greatly, it is not usually an impulse purchase made without paying much attention, which will also be the case for clothing linings. In my view, average consumers of the goods will pay a 'normal' or medium degree of attention during the selection process. The goods are likely to be selected from shelves and displays in stores, from printed catalogues or from websites. Therefore, the selection process is likely to be primarily visual; but sales assistance and word of mouth orders/recommendations may also play a part in the selection process, so the way the marks sound must also be considered.

Comparison of marks

30. *Sabel BV v. Puma AG*, Case C-251/95 explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant

[13] Approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc and anor* [2025] UKSC 25, at paragraph 30.

components. 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."

31. 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.

32. The marks to be compared are:

Opponent's series of marks	**Applicant's mark**
GYMSHARK Gymshark GymShark gymshark	 **GymBull**

33. I will compare the applicant's mark with the third mark in the earlier series of marks, GymShark, which is the closest in the series to the applicant's mark, given the use of a capital letter in (approximately) the middle of the mark. I will refer to this as "the earlier mark".

34. The earlier mark comprises a single word which consists of the joining of Gym and Shark. There are no other elements which contribute to the overall impression, which lies in the word itself. The applicant's mark comprises two elements. The word element comprises a single word which consists of the joining of Gym and Bull. Above that is a device element of a bull, poised for movement. Both elements are large. There is no general rule that a verbal element in a mark comprising verbal and graphic elements should always be dominant, but verbal elements are generally considered to be more distinctive than figurative elements because the average consumer is more likely to identify the mark through word elements.[14] The word element is in bold and is longer (or wider) than the device, drawing the eye towards it. To that extent, GymBull has a slightly more dominant and distinctive weight in the overall impression, but the device also plays a significant role because it is an important visual element of the mark.[15]

35. There is a low degree of visual similarity between the marks. It is low because although both marks share Gym at the beginning of the word elements, the rest of the marks are different to one another, which includes the large bull device.

36. The bull device will not be articulated which makes the marks more similar aurally than visually because the aural comparison is only between GymShark and GymBull: both start with Gym and both are two syllables in length. Given that the second syllables are different but that the first syllables are identical, there is a medium degree of aural similarity.

37. There is a shared concept of Gym. *Collins Online Dictionary* gives the meaning as "a club, building or large room, usually containing special equipment, where people go to for physical exercise and to get fit" and "the activity of doing physical exercises in a gym, especially at school".[16] In each mark, Gym has been joined to the name of an animal. This cannot really be said to form a sensible concept: sharks and bulls do

[14] *C. & J. Clark International Limited v Global Trademark Services Limited*, BL O/992/22, Mr Iain Purvis KC, sitting as the Appointed Person and *Grosvenor Technology Limited v Janus International Group LLC*, BL O/0558/25 Mr Phillip Johnson, sitting as the Appointed Person
[15] See also *PLANETART LLC and anor v PHOTOBOX LIMITED* [2020] EWHC 713 (Ch) at paragraph 21
[16] Accessed on 10 May 2026

not frequent gyms, but to the extent that the nonsensical combination refers to an animal in a gym, there is a small degree of conceptual similarity. The opponent has provided evidence about bull sharks which it states (or submits) share characteristics with bulls. It would be a considerable stretch to find that the average consumer would perceive a shared meaning between GymShark and GymBull on this basis, even if they were appreciative of the characteristics of bull sharks. There are too many steps to make. They would also not see a sharing of concept on the basis that sports teams invariably call themselves after animals including sharks and bulls (some of the evidence is outside of the UK, although there are some UK teams shown, and none of it is dated prior to the relevant date). It follows that the device of a bull does not bring the marks any closer, conceptually. Allowing for the shared concepts of gym and animals, the marks are conceptually similar to a low degree.

Distinctiveness of the earlier mark

38. The assessment as to whether there is a likelihood of confusion includes considering whether the distinctive character of the earlier mark has been enhanced (i.e. more distinctiveness has been acquired) through the use made of it. If a mark has an inherently high, or an enhanced, level of distinctiveness, the likelihood of confusion is increased.[17]

39. I will firstly consider the inherent distinctive character of the earlier mark. It is comprised of the joining of two dictionary words. Dictionary words generally have no more than a medium degree of distinctive character, provided they do not describe or allude to the goods and services covered by the earlier mark or to one of their characteristics. In this case, Gym is descriptive of clothes for wearing in the gym (gym shorts, gym shoes etc). Shark does not allude to or describe the goods or any of their characteristics. However, the mark as a whole is GymShark, the meaning of which I consider above. It creates a nonsensical concept which gives it more than a medium (although not a high) level of inherent distinctive character.

[17] *Sabel BV v Puma AG,* Case C-251/95.

40. Distinctive character is a measure of how strongly an earlier mark identifies the goods or services for which it is registered, determined, according to *Lloyd Schuhfabrik Meyer & Co.*, partly by assessing the proportion of the relevant public which, because of the mark, identifies the goods or services as originating from a particular undertaking. At paragraph 23 of its judgment, the CJEU stated:

> "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)."

41. The opponent's evidence entitles it to claim that the level of distinctive character of its earlier mark has been enhanced through the use made of it. The turnover figures are substantial, running into many millions of pounds. It has a strong print-based media and social media presence, using influencers to attract customers. Its stores in London's Regent Street and its permanent concessions in Selfridges in London and Manchester are in high profile retail locations and premises. It is one of the 18 leading brands in the UK sportwear market (as of 2022). In relation to sportwear and the retail thereof, the opponent's earlier mark has a high level of distinctive character. Its use goes no further than this which means that for all the other goods (and services) the mark has an above medium (but not high) level of distinctive character.

Likelihood of confusion

42. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between goods and services may be offset by

a greater degree of similarity between the trade marks, and vice versa. In this case, the similarity of goods and services ranges from identical to similar to a medium degree.

43. There are two types of confusion, direct and indirect.[18] Direct confusion occurs where marks are mistaken for one another, flowing from the principle 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 which has been retained in the mind. The earlier mark is highly distinctive in relation to sportswear and retail thereof, and inherently distinctive for the other goods and services to an above medium level. There will be a medium level of attention paid to the purchase. The marks are visually and conceptually similar to a low degree and, although aurally similar to a medium degree, the purchase will be primarily visual, so this carries more weight in the global appreciation than the level of aural similarity. The overall impression of the applicant's mark is slightly dominated by GymBull, which contains the only point of similarity with the earlier mark: 'Gym". However, the GymBull element only slightly dominates the application and the bull is a significant part of the mark which has no counterpart in the earlier mark. It is highly unlikely that average consumers will make any sort of connection between bulls and bull sharks sufficient to confuse the parties' marks for each other on the basis of imperfect recollection. Even for identical sportwear, which is the high point of the opponent's case in relation to the earlier mark (the third in the series) because of its high degree of distinctiveness, the differences between the marks will be sufficient to avoid direct confusion.

44. I note here that the opponent's submissions in lieu of a hearing refer to Exhibit LTW01 showing the earlier mark alongside logo elements depicting "strong, muscly sharks" which, the opponent submits, will make it more likely that consumers will be confused (because bulls are also strong and muscly). I can only consider the earlier mark as it appears on the register, so this submission is not accepted.[19]

[18] *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207
[19] *J.W.Spear & Sons Ltd and Others v Zynga Inc.* [2015] FSR 19 at [46] to [47]

45. Nor will the marks be indirectly confused. This type of confusion was explained by Mr Iain Purvis QC, sitting as the Appointed Person, in *Back Beat Inc v L.A. Sugar (UK) Limited*, BL O/375/10:

> "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)."

46. That the three categories in that case are non-exhaustive was confirmed by the Court of Appeal in *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others*.[20]

47. I cannot conclude that the presence of the name of two different animals which the average consumer is unlikely to associate with each other will lead average consumers to believe that the later mark is a brand variation or extension of the earlier mark (or vice versa) or that the goods/services have been in some way endorsed or licensed by the opponent, or that the parties are collaborating. The nature of the differences between the marks do not lend themselves to such a conclusion. In *Dirtybird Restaurants Ltd v. Salima Vellani*, BL O/413/18, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, said:

"18. There is no rule or presumption to the effect that the concurrent use of a trade mark and one of its components for identical or similar goods or services will always or necessarily give rise to the perception that the goods or services concerned come from the same or economically linked undertakings. That might or might not be the case. In order to determine whether it is, the decision taker must give as much or as little significance to the visual, aural and conceptual differences and similarities between the marks in issue as the relevant average consumer would have attached to them at the relevant point in time (which in this case was July/August 2015). It is axiomatic that the relevant average consumer is to be regarded as reasonably well-informed and reasonably observant and circumspect. However, (s)he is not to be regarded as a person who normally engages in extended thought processes for the purpose of pairing and matching trade marks or actively considering how they might be developed or appropriated for use as siblings of other marks. Indirect confusion of the kind described by Mr Iain Purvis QC in paras. [16] and [17] of

[20] *Ibid*.

his decision in L.A. Sugar is a matter of instinctive reaction to precipitating factors rather than the result of detailed analysis, as emphasised by Mr James Mellor QC sitting as the Appointed Person in Duebros Ltd v Heirler Cenovis GmbH (BL O/547/17; 27 October 2017) at para. 81."

48. Although I find that there will not be a belief that there is an economic connection; a belief which must be "something more than mere idle wondering or speculation that there might be a connection"[21], the huge reputation and distinctiveness of the earlier mark is likely to cause a significant proportion of average consumers to bring the earlier mark to mind in relation to sportswear. However, this is not enough for confusion; i.e. a belief in an economic connection. Even if the earlier mark is brought to mind in relation to sportswear, a finding of indirect confusion should not be made merely because one mark calls to mind the other.[22] Indirect confusion is not a consolation prize for an opponent which has not succeeded in a finding of direct confusion. Differences between marks which are the reason why there is no likelihood of direct confusion might also be the reason why there is no indirect confusion. That is the case here.[23]

49. The section 5(2)(b) ground fails.

Section 3(6)

50. Section 3(6) of the Act states:

> "A trade mark shall not be registered if or to the extent that the application is made in bad faith."

51. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin summarised the general principles applicable to bad faith at [240], as follows:

[21] *Vault IP Limited v Mark Kingsley-Williams*, Mr Iain Purvis KC, sitting as the Appointed Person, BL O/0353/24, at paragraph 15
[22] James Mellor QC (as he then was), sitting as the Appointed Person, in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17
[23] See the comments of Mr James Mellor QC, sitting as the Appointed Person, in *Cheeky Italian Limited v Ashish Sutaria*, BL O/219/16

"(i) […]

(ii) The date for assessing whether an application to register [a] trade mark was made in bad faith is the date the application for registration was made (*Lindt*, para 35).

(iii) Bad faith in this context is an autonomous concept of EU law which must be given a uniform interpretation […], and must be interpreted in the context of Directive 89/104 in the same manner as in the context of Regulation 40/94 ([*Malaysia Dairy Industries Pte Ltd v Ankenaevnet for Patenter og Varemaerker* (C-320/12) EU:C:2013:435 ("*Malaysia Dairy*")], para 29; [*Sky plc v SkyKick UK Ltd* (C-371/18) EU:C:2020:45 ("*Sky CJEU*")], para 73).

(iv) While, in accordance with its usual meaning in everyday language, the concept of bad faith presupposes the presence of a dishonest state of mind or intention, the concept must also be understood in the context of trade mark law, which involves the use of marks in the course of trade. Further, it must have regard to the objectives of the […] law of trade marks, namely the establishment and functioning of […] a system of undistorted competition in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable consumers, without any possibility of confusion, to distinguish those goods or services from those which have a different origin (*Lindt*, para 45; [*Koton Mağazacilik Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 ("*Koton*")], para 45).

(v) Consequently, the objection will be made out where the proprietor made the application for registration, not with the aim of engaging fairly in competition but either (a) with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties; or (b) with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, and in particular the essential function of indicating origin (*Koton*, para 46; *Sky CJEU*, para 75).

(vi) The intention of the applicant is a subjective matter, but it must be capable of being established objectively by the competent administrative or judicial authorities having regard to the objective circumstances of the case (*[Hasbro Inc* v *EUIPO, Kreativni Dogaaji d.o.o. (intervening)* (Case T-663/19) EU:T:2021:211 ("*Hasbro*")], paras 39 and 40; *Koton*, para 47).

(vii) The burden of proving that an application for a registered mark was made in bad faith lies on the party making the allegation. But where the circumstances of the case may lead to a rebuttal of the presumption of good faith, it is for the proprietor of the mark to explain and provide a plausible explanation of the objectives and commercial logic pursued by the application for registration (*Hasbro*, paras 42 and 43).

(viii) Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all of the factors relevant to the particular case (*Lindt*, para 37).

(ix) The applicant for a trade mark is not required to indicate or to know precisely when the application is filed or examined, the use that will be made of it (*Sky CJEU*, para 76; [*AS v Deutsches Patent-und Markenamt* (C-541/18) EU:C:2019:725], para 22).

(x) Nevertheless, the registration by an applicant of a mark without any intention to use it in relation to the goods and services covered by the registration may constitute bad faith where there is no rationale for the application in the light of the aims referred to in Regulation 40/94 and Directive 89/104 (*Sky CJEU*, para 77).

(xi) Such bad faith may, however, be established only where there are objective, relevant and consistent indicia tending to show that, when the application was filed, the applicant for registration had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark (*Sky CJEU*, para 77).

(xii) It follows that the bad faith of the applicant cannot be presumed on the basis of a mere finding that, at the time of filing the application, the applicant had no economic activity corresponding to the goods and services referred to in the application (*Sky CJEU*, para 78).

(xiii) When the absence of an intention to use the mark in accordance with the essential functions of a trade mark concerns only certain goods or services referred to in the application for registration, that constitutes making the application in bad faith only in so far as it relates to those goods or services (*Sky CJEU*, para 81).

(xiv) If, at the end of the day, the court concludes that, despite formal observance of the relevant rules and conditions for obtaining registration, the purpose of the rules has not been achieved, and that there was an intention to take advantage of the rules by creating artificially the conditions laid down for obtaining the registration, this may amount to an abuse sufficient to find that the application was made in bad faith (see, for example, *Hasbro*, para 72).

(xv) Directive 89/104 does not preclude a provision of national law under which an applicant for registration must state that the mark is being used in relation to the goods or services in relation to which it is sought to register the mark, or that the applicant has a *bona fide* intention that it should be used, provided that infringement of such an obligation cannot constitute a ground for invalidity. It may, however, constitute evidence for the purposes of establishing possible bad faith on the part of the applicant when the application was filed (*Sky CJEU*, paras 86 and 87)."

52. An allegation of bad faith is a serious one which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies (i.e. balance of probability). This means that it is not enough to establish facts which are as consistent with good faith as bad faith: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch).

53. I have set out at the beginning of this decision the opponent's table of marks, from its statement of grounds, belonging to third parties next to marks owned by the

applicant which the opponent claims show a pattern of filing trade mark applications in bad faith. The opponent expands upon this in Ms Todhunter's evidence, providing a longer table showing the applicant's opposed or withdrawn applications alongside the earlier rights relied upon in the oppositions against the applicant's opposed or withdrawn applications. Exhibit LLT05 shows that the applications invariably include classes 18 and 25. I have reproduced the table in full here:

Mark the subject of the Withdrawn Application / Opposed Application	Earlier right(s) relied on in the opposition filed against the Withdrawn Application / Opposed Application
	THE NORTH FACE And  And 
	ARMANI
	TOMMY And TOMMY.COM And TOMMY HILFIGER
Calvin Bags	Calvin Klein Calvin Klein CALVIN KLEIN Calvin Klein And Calvin Klein

UPPER ARMOUR	UA And UNDER ARMOUR And  And 
Clark & Mark	Clarks And  And CLARKS And ClarksStores And Clarks And CLARKS
EMIRATES PERFUME	EMIRATES And 
	EMIRATES And

	Emirates And Emirates Holidays And Fresh
	AMERICAN TOURISTER
fogx	ogx And ogx And OGX
TOM CRUISER	TUMI And TUMI And TUMI And TUMI
SWISS TOURISTER	AMERICAN TOURISTER And TOURISTER
	CAPRICE And

	CAPRICE 
	AMERICAN TOURISTER And TOURISTER

54. The applicant claims that the applicant has no bona fide intention to use the application and that the purpose of filing the application is to intentionally mislead the public or to create conflict with the earlier rights holders. If proven, these are objectives for which the application could not properly be filed.[24]

55. For convenience, I will repeat here what the applicant says in response to the section 3(6) claim:

> "28. The Applicant denies the application was filed in bad faith. An allegation of bad faith is a serious allegation which must be distinctly proved. The Opponent has not advanced any explanation on why it considers the application to be in bad faith other than pointing to other applications filed by the Applicant and claiming this to be a sign that the Applicant's behaviour falls short of honest standards of accepted commercial behaviour. This claim is strongly denied by the Applicant.
>
> 29. The mere fact that a trade mark bears some similarity to another trade mark is not in itself a marker of bad faith. Indeed, many of the marks listed in paragraph 29 of the Opponent's Statement of Grounds could be construed as parodies. The right to publish parodies is an important aspect of free speech (Human Rights Act s12) and is not sufficient to amount to bad faith. It is not an inherently dishonest business practice to use a sign which brings another trader to the mind of some consumers in an amusing but inoffensive way (*Swatch AG v Apple Inc* [2021] EWHC 719 (Ch)).

[24] *Paper Stacked Limited v CKL Holdings* NV, BL O/036/18, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, at paragraph 8.

> 30. It is denied that the Applicant's conduct in filing the application was dishonest as the mark applied for is not confusingly similar to the Opponent's earlier mark. Registration of the mark applied for would not in any way block or hinder the Opponent's use of its mark. As advised in paragraph 29 above, many of the marks listed in the Opponent's Statement of Grounds could be construed as parodies. Nonetheless, and irrespective of any co-pending marks that the Applicant has filed, there is nothing intrinsically wrong with the Applicant filing the current application as it would not be confused with the Opponent's mark. The Applicant has a bone fide intention to use the mark on the goods in question."

56. The applicant says little more than this in its evidence, which comes from its trade mark attorney, not from the applicant itself. In her witness statement, Ms Nicol states:

> "3. […] The Applicant has every right to file trade mark applications as they see fit and in line with their commercial interests and whether or not any of these may have been opposed by third parties has absolutely no bearing on the matter at hand. No evidence has been submitted by the Opponent which indicates that the Applicant has acted in any way in bad faith in filing this specific application, number UK00004091284. Regardless of the fact that the Applicant's mark and the Opponent's earlier marks are inherently dissimilar and would not be confused, the Applicant has a bona fide intention to use the mark in relation to the goods for which protection is sought."

57. The opponent, in its submissions in reply, disputes that Ms Nicol is in a position to make such statements or assertions about the applicant's intentions, calling it hearsay evidence. I agree that it is hearsay. It is second-hand evidence about the applicant's intention without any corroborative evidence and has little weight, if any.

58. The applicant is correct in submitting that the fact that a trade mark bears some similarity to another trade mark is not, per se, a marker of bad faith. However, the opponent's statement of grounds and evidence about the applicant's other applications shows that the contested mark is not the first or only of the applicant's marks to bear (to varying degrees) resemblance to third parties' trade marks. It is a

notorious fact that at least some of the marks highlighted by the opponent have a reputation in the UK, such as Calvin Klein, Armani, The North Face and Under Armour for clothing; and, in the case of Under Armour, specifically for fitness clothing. The Calvin Bags mark has the same font as Calvin Klein, as does the 'Clark' element of the applicant's Clark & Mark application compared to the well-known mark Clarks, for shoes. Such evidence can show a pattern of behaviour which may lead to a conclusion that a mark has been applied for in bad faith. The applicant's claim in its statement of grounds that 15 of 20 applications have been opposed is, in this context, not irrelevant (contrary to Ms Nicol's statement).

59. Similar fact evidence was considered in *Trump International Ltd v DTTM Operations LLC* [2019] EWHC 769 (Ch). The controlling mind behind the applicant in that case was shown to have a history of applying for trade marks without any intention to use them, including famous third-party marks, and of being involved in numerous trade mark proceedings in the UK and elsewhere. The application for the trade mark TRUMP TV was found to have been made in bad faith. Carr J said, at [42]:

> "In relation to allegations of copyright infringement, it is necessary to decide, as a matter of fact, whether copying has occurred. As with claims of bad faith, direct evidence of copying is rarely available. In this context, it is well established that similar fact evidence may be admissible." The case law is considered in *Copinger and Skone James on Copyright*, Vol 1, 17th Edition at [21-393]:
>
> > "…where the issue in a copyright case is whether the similarity between the claimant's work and the defendant's work is due to copying or is a coincidence, it is relevant to know that the defendant has produced works which bear a close resemblance to works other than the work in question which are the subject of copyright. Whereas similarity between two works might be mere coincidence in one case, it is unlikely that there could be coincidental similarity in, say, four cases. The probative force of several resemblances together is much better than one alone."
>
> This reasoning may well apply, depending on the facts, to an allegation that a third-party trade mark has been applied for in bad faith. The probative force of

several instances of such applications, by the same or a connected party who has applied to register a third-party trade mark, is obvious. Such instances, if based on solid grounds, are likely to require evidence from the applicant to refute the inference of bad faith that may otherwise be drawn from them."

60. The applicant states in its defence that many of the marks listed in the opponent's table "could be construed as parodies". It relies upon *Swatch AG v Apple Inc* [2021] EWHC 719 (Ch) for its proposition that it is not bad faith to apply for parodies as trade marks. In that case, Apple had objected to Swatch's application for ONE MORE THING, which was a phrase associated with Apple's CEOs when making announcements at industry events, to the point that compilations of ONE MORE THING moments had been made by Apple 'fans' on YouTube. Parody was one of the legs to Apple's bad faith ground. The present case can be distinguished from the *Swatch AG v Apple Inc* case. Two of the considerations by Mr Iain Purvis QC, sitting as a Deputy judge of the High Court, were that there was "no evidence that Swatch had made a practice of parodic advertising in the past, against any party, let alone Apple" and that it was "not clear how the suggested parodic use of the mark would be effective when, on the Hearing Officer's findings, it was only associated with Apple by only a small number of people."[25] In the present case, there is a pattern of previous filings of marks which are similar to those of third parties, and those third-party marks have a reputation amongst the general public in the UK.

61. The applicant characterises parodical marks as signs which bring another trader to the mind of some consumers in an amusing and inoffensive way, which is taken from *Swatch AG v Apple Inc*:

> "52. 'Poking fun' and 'parody' cover a multitude of possibilities from gentle and affectionate teasing to full-frontal attacks. I do not consider that it is an inherently dishonest business practice to use a sign which brings another trader to the mind of some consumers in an amusing but inoffensive way. Such an activity would not necessarily undermine the interests of the third party in any material way. The point at which parodic or humorous activity of that kind would

[25] Paragraph 44, points (iii) and (iv).

transgress the boundaries of honest business practices must depend on the nature of the humour, the intensity of its use and its consequent impact on the business interests of the recipient.

[…]

54. (i) […]

(ii) He [the Hearing Officer] then makes the point that using a mark as part of a parody of another trader is difficult to reconcile with the use of the marks in accordance with their essential function, of indicating the commercial source of the goods. But, again, this must depend on the actual use in question. Using a phrase in a humorous parodic skit may well not be trade mark use. However, I do not see why a mark may not have parodic character whilst at the same time being perfectly capable of functioning as a trade mark. For example DUNK DIFFERENT could be a perfectly good trade mark for biscuits, whilst no doubt conjuring up for some people a wry or even amusing allusion to Apple's famous slogan."

62. The opponent includes a reference in its statement of grounds to the RedBull trade mark, which I take on judicial notice is famous in the UK in relation to energy drinks:

63. Of course, the opponent is entitled to bring the claim in relation to the RedBull mark, even though it does not own it because, as stated by Mr Geoffrey Hobbs QC, sitting as the Appointed Person in *Fine Gael v Patrick Melly*:[26]

[26] BL O/043/08

> "49. […] Bad faith is an absolute, hence free-standing, ground for refusal of registration. It can be raised in relation to matters arising between applicants and third parties as well as between applicants and the Registrar."

64. Additionally, Mr Hobbs, again sitting as the Appointed Person, said the following in *Paper Stacked Ltd v CK Holdings NV*:[27]

> "19. […] The objection is absolute in the sense that it is intended to prevent abusive use of the system for acquiring title to a trade mark by registration. Any natural or legal person with the capacity to sue and be sued may pursue an objection on this ground: see the judgment of the CJEU in Case C-408/08P *Lancôme parfums et beautè & Cie SNC v OHIM*, EU:C:2010:92 at paragraph [39] and the Opinion of Advocate General Ruiz-Jarabo Colomer in that case EU:C:2009:634 at paragraphs [63] and [64]. Since there is no requirement for the objector to be personally aggrieved by the filing of the application in question, it is possible for an objection to be upheld upon the basis of improper behaviour by the applicant towards persons who are not parties to the proceedings provided that their position is established with enough clarity to show that the objection is well-founded."

65. The opponent is, therefore, entitled to rely upon the fact of the RedBull mark's alleged resemblance to the applicant's mark. I said earlier that the fame of the opponent's mark would cause it to be brought to mind by the use of the applicant's mark, even though the marks would not be confused. The use of a bull in fighting mode, although not the same bull, and a word which ends in Bull (including the capital letter in the middle of the word), preceded by a conjoined word, is also likely to bring to mind the famous RedBull mark, even for different goods. This fits the pattern of the other marks identified by the opponent.

66. The applicant's reliance on parody, which the applicant itself says is use of a sign in an amusing and inoffensive way, is flawed. There is nothing about its application which strikes me as being amusing, as in Mr Purvis' DUNKING DIFFERENT example.

[27] Supra

As an isolated instance, there may be no bad faith. However, there is a pattern of behaviour, as in the TRUMP TV case, and I consider that the wording of the counterstatement implicitly acknowledges that there has been a pattern of behaviour of applying for marks similar to those of third parties:

> "Many of the marks listed in paragraph 29 of the Opponent's Statement of Grounds could be construed as parodies."

67. That is to say, if they were not similar to the marks of third parties, the applicant's other applications could not be parodies. There must be similarities for the parody to work. So, this must be an acceptance by the applicant that it has made several applications for marks which are similar to those of third parties (whether or not they actually are parodies).

68. *Paper Stacked Ltd v CK Holdings NV* was a case involving the same controlling mind as in the Trump TV case. Mr Geoffrey Hobbs QC upheld the Hearing Officer's finding of bad faith. At paragraph 35 of his decision (quoted at paragraph 25 of Mr Hobbs' decision), the Hearing Officer said:

> "Taken together with the opponent's evidence that (1) none of the marks applied for in the UK (or US) appear to have been used, (2) the absence of any apparent commercial logic for the filing pattern of the applicant and/or Mr Gleissner's other companies, and (3) the evidence that companies controlled by Mr Gleissner have been found to have abused legal systems, I find that opponent has also made out a prima facie case that, at the time of filing the application, the applicant had no intention of using the mark in accordance with its essential function. That is to say using the mark to distinguish the goods/services of the applicant from those of other traders."

69. In the present case, the applicant has implicitly admitted that it has applied for several trade marks which are similar to those of third parties. It has given no indication that any of them have been used and Ms Nicol's evidence is wholly insufficient to prove intention to use. It is the nature of those applications which is key: they mimic the marks of third parties. The applicant's defence of parody also falls

down because there is nothing funny or mickey-taking about the contested application. It is not mere coincidence that the mark mirrors the word structure of RedBull, and includes a bull device, when viewed alongside its other applications which all ape the trade marks of third parties. In the *Paper Stacked Ltd v CK Holdings NV* case, Mr Hobbs said this:

> "7. CKL's [the applicant's] case as presented in these submissions was that the evidence tendered by the opponent established no basis sufficient in point of fact or in point of law to justify rejection of the contested application for registration on the ground of bad faith. Having chosen to file no evidence directed to the specifics of the facts and matters relied on by the opponent, CKL was, in essence, asking the Registrar to say that it had no case to answer."

70. The applicant in the present case has chosen the same course of action. In *Accessible Labs Ltd v Rui Qu (Shanghai) Enterprise Management Consulting Company Limited*, Mr Daniel Alexander KC, sitting as the Appointed Person, said:[28]

> "43. Third, *SkyKick* notes that the application of the law presents evidential difficulties. It is rare that an opponent to a trade mark application mark will have direct evidence that the applicant intended to do so for reasons which do not accord with the proper objects of securing trade mark registration. Lord Kitchin said in *SkyKick* at [154]:
>
> > "It may be very difficult for a claimant seeking a declaration of invalidity of a registered trade mark to prove the subjective intention or motive of the applicant in filing the application to register that mark in respect of particular goods and services. Accordingly, from the earliest consideration of this issue by the CJEU, it has been recognised that this subjective aspect of the objection will generally have to be established by reference to what have been described as relevant, consistent and objective criteria.""

71. In *Skykick*, the Supreme Court stated at paragraph 240 that:

[28] Case BL O/0534/25.

> "(vii) The burden of proving that an application for a registered mark was made in bad faith lies on the party making the allegation. But where the circumstances of the case may lead to a rebuttal of the presumption of good faith, it is for the proprietor of the mark to explain and provide a plausible explanation of the objectives and commercial logic pursued by the application for registration (*Hasbro*, paras 42 and 43)."

72. I consider that there is a prima facie case to answer, particularly given the applicant's own raising of its own pattern of trade mark filings being potentially parodical, without explaining how the contested mark could be said to be a parody. The opponent has pointed out the applicant's pattern of filing marks which ape those of third parties and, in the light of that pattern, the similarity to the famous RedBull mark is not a coincidence. It is also not a coincidence that the first word of the mark is Gym, matching the first word of the earlier mark, which I have found would be brought to mind by a proportion of average consumers on seeing the applicant's mark. There is nothing amusing about this conjunction, or mash-up. This combination of factors is sufficient to raise a prima facie case. In *Maya Appliances Pvt. Ltd v Prapaharan Sivaratnam*, Mr Iain Purvis KC, sitting as the Appointed Person, said:[29]

> "27. It is obviously wrong to expect a party to Cancellation proceedings to be able to give direct evidence of the motivation of someone who has adopted their mark. All they can reasonably be expected to do in the vast majority of cases is to make inferences from the objective facts and invite the other party to respond to this. If they establish a prima facie case consistent with bad faith, then in the absence of a response from the other party the Cancellation should succeed.

73. In the present case, the opponent has done all that it was able to do, in the circumstances of the case. As the opponent has met the burden of raising a prima facie case, it has rebutted the presumption of good faith. It is incumbent on the applicant to explain and provide a plausible explanation for the contested application.

[29] Case BL O/0052/25: the decision concerned cancellation proceedings, but the law is no different in relation to an opposition under section 3(6).

It has made no real attempt to do so in evidence. In *Accessible Labs Ltd*, Mr Alexander said:

> "45. … as Lord Kitchin said in *SkyKick* at [235] and [252]:
>
> > "235. I recognise that an inference that an application to register a trade mark was made in bad faith may be displaced by an explanation of an appropriate commercial rationale for making it. In my opinion, however, a failure to provide any satisfactory explanation may reinforce the inference and provide further support for a finding of bad faith.
> >
> > …
> >
> > 252. I recognise that such an applicant, when given an appropriate opportunity, may provide a reasonable explanation and justification for its actions and in that way answer and dispel any inference that it made the application in bad faith. If, however, it fails to do so, it is in my view open to the tribunal to find that the application was indeed made in bad faith in respect of those goods and services."

46. *SkyKick* therefore reinforced the importance of a satisfactory explanation for making a UK trade mark application in circumstances where an inference that the mark was applied for in bad faith appeared justified, prima facie. Key questions are therefore (a) whether an explanation was provided at all and (b) whether the hearing officer had sufficient basis to find that the explanation provided was unconvincing with respect to motivation in applying for the mark and in particular intention to use it in the UK, taking the evidential picture as a whole.

47. As to that, the case law from the Court of Appeal prior to *SkyKick* suggests that where, in principle, evidence from those with knowledge of intention is available, it is reasonable to expect it to be adduced to rebut a prima facie case of bad faith. That proposition is supported by *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where Arnold LJ said at [180] of one of the grounds of appeal (namely that it was not realistic for the judge to expect that either witness testimony or documentary evidence would be available to explain Lidl's intentions) that despite the passage of time, the

applicants for registration were best placed to explain their intentions. The court expected a proper explanation.

48. In the light of these authorities, where there is evidence from which it is proper to infer that an application for registration has been made in bad faith (on the basis that it was not applied for to protect one or more of the legitimate functions of a trade mark) an applicant can reasonably be expected to provide a sufficiently coherent explanation for the application specifically in the UK including as to its scope. An applicant may be able to justify the application (including its scope) on the basis of credible evidence as to its purposes in making it, for example by reference to the width of the underlying business, actual or reasonably contemplated, which the trade mark is intended to protect. If no adequate or sufficiently credible explanation is provided or one which justifies the UK application, there may be a proper basis for a finding of bad faith in whole or in part."

74. The objective, relevant and consistent indicia point towards a conclusion that the application was made in bad faith, and the applicant has not rebutted that conclusion. There is no evidence from the applicant as to how it arrived at a mark which brings to mind at least the RedBull mark (with a fierce bull device), and likely not only that mark but also the earlier mark, and there is no evidence of its commercial plans for the mark in the face of the prima facie case brought by the opponent. In paragraph 240 of its *Skykick* judgment, the Supreme Court said:

"(xiv) If, at the end of the day, the court concludes that, despite formal observance of the relevant rules and conditions for obtaining registration, the purpose of the rules has not been achieved, and that there was an intention to take advantage of the rules by creating artificially the conditions laid down for obtaining the registration, this may amount to an abuse sufficient to find that the application was made in bad faith (see, for example, *Hasbro*, para 72)."

75. The applicant has failed to rebut the prima facie case. The application was filed with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties (the opponent and others) by causing conflict with them, as shown by the number of marks which have caused oppositions without countering that

conclusion with evidence of a bona fide intention to use the mark. This behaviour is an abuse of the trade mark system. It is contrary to the objective of a trade mark registration, as set out in *Skykick* at paragraph 240 (iv):

> "… the establishment and functioning of […] a system of undistorted competition in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable consumers, without any possibility of confusion, to distinguish those goods or services from those which have a different origin ...".

76. As I have decided that the contested mark is not a parody, I do not need to consider the applicant's reference to freedom of speech, in its counterstatement. The section 3(6) ground succeeds in full.

77. The section 3(6) ground succeeds.

Section 5(3)

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

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

79. Section 5A states:

"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."

80. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors,* Case C-252/07, *Intel,* Case C-408/01, *Adidas-Salomon,* Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C-383/12 P, *Environmental Manufacturing LLP v OHIM.* The law appears to be as follows.

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

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

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, 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) the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oreal v Bellure NV*, paragraph 44.

(g) 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.

(h) 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.

(i) 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. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it; *L'Oreal v Bellure NV*, paragraph 44.

(j) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics

which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure).*

81. It follows from my earlier findings that the earlier mark (i.e. the third mark in the series) satisfies the requirement of a reputation, per *General Motors*, in relation to sportwear and the retail thereof. The applicant's evidence shows that its mark has a significant presence in the UK sportwear market which is supported by its social media publicity and press coverage.

82. Despite my finding under section 3(6), it is not open to me to find under section 5(3) that the applicant had an intention to exploit unfairly the reputation and image of the earlier mark. This is because the way in which the opponent has pleaded its case under section 5(3) of the Act does not include a claim that the applicant had such an intention. Such an allegation must be clearly pleaded. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch), Arnold J (as he then was) held that it was not open for the claimant to advance a case based on subjective intention under the EU Directive equivalent to section 5(3) when it had failed to plead such in the beginning and had been refused permission to amend its pleadings.[30] Like the present case, the pleadings in *Jack Wills* were made in general terms and the claimant did not particularise the claim of unfair advantage. Although I have found that the application is part of a pattern of imitating other marks, the applicant has not admitted that this particular application is an imitation and, thereby admitted its intention was to mimic the earlier mark. That said, *Jack Wills* is authority for the proposition that it is also unnecessary to show that the applicant intends to cause confusion or to take unfair advantage: such a finding can be made on the basis of the objective effect of use of the later mark.

83. I need firstly to decide whether the relevant public would make a link between the earlier mark, GymShark, and the applicant's mark. The factors identified in *Intel* are:

[30] Article 5(2), European Parliament and Council Directive 2008/95/EC of 22 October 2008

The degree of similarity between the conflicting marks

84. I have found that there is a low degree of visual similarity and a medium degree of aural similarity between the marks. The marks are conceptually similar to a low degree.

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

85. The respective goods and services are identical or similar to a medium degree.

The strength of the earlier mark's reputation

86. The earlier mark has a very significant reputation for sportwear and retail thereof.

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

87. GymShark is distinctive to a high degree.

Whether there is a likelihood of confusion

88. For the reasons already given, there is no likelihood of confusion.

89. I find that the differences between the marks are such that a significant proportion of the relevant public would still not make a link between the marks, even if the applicant's mark was used in relation to sportswear. However, I find that the reputation and distinctiveness of GymShark for sportswear and retail thereof is such that another (also) significant proportion of the relevant public would call GymShark to mind on seeing (or hearing) the applicant's mark used in relation to sportswear. This is because the mere sight or sound of a mark beginning with Gym- would be enough to trigger a mental association with GymShark in the thought process of this group of

average consumers.[31] There is no single meaning rule.[32] It follows that where average consumers would react differently to the contested mark it is necessary to consider the reaction of both categories of average consumer. This group of consumers will make a link between the marks because they will call the earlier mark to mind, even though they are not confused. However, I consider there is a limit to the link and that it will only operate in relation to sportswear. The reputation of the earlier mark is very firmly planted in that sector of the clothing market.

90. Unfair advantage can be taken of an earlier mark where there is no likelihood of confusion between it and the later mark. The unfair advantage is usually the result of the transfer of the image of the earlier mark, or of the characteristics it projects, to the goods/services identified by the later mark. Unfair advantage has no effect on the consumers of the earlier mark's goods/services. Instead, the taking of unfair advantage of the distinctive character or reputation of an earlier mark means that consumers are more likely to buy the goods/services of the later mark than they otherwise would have been if they had not been reminded of the earlier mark. The later mark will get a marketing or commercial 'leg-up' because the link with the earlier, reputed mark means that the owner of the later mark does not have to put as much effort into making the later mark known because it already feels familiar or sends a message to consumers as to what they can expect.

91. The image of the earlier mark which comes through from the opponent's evidence is of a dynamic, gym-focussed brand, with a large cohort of young ('Gen Z') followers and influencers, the latter who act as trend-setters, modelling the goods on toned and muscular bodies (see, for example, the *Vogue Business* article). This is a modern, attractive and potentially lucrative image from which the applicant's mark will benefit in relation to sportswear. The relevant public will be more likely to buy the applicant's sportwear because there will be instant familiarity with the fame and image of the earlier mark. This means that the applicant's mark will benefit from the marketing efforts and expenditure of the opponent without having to invest at all, or as much, in

[31] The degree of similarity required to create a link between the marks may be less than that required to create a likelihood of confusion: *Intra-Presse SAS v OHIM*, CJEU, Joined Cases C-581/13P & C 582/13P

[32] See *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch)

order to achieve the level of sales it will gain because of the link. The change in consumer behaviour will produce an objectively unfair result by giving the applicant an advantage in relation to sportswear because it has piggy-backed on the efforts of the opponent.

92. This means that the section 5(3) ground succeeds in relation to sportwear and any goods or terms in the specification which cover such goods. The ground succeeds in respect of:

> *Clothing; headbands [clothing]; jackets [clothing]; knitwear [clothing]; leggings; leg warmers; trousers; ready-made clothing; shirts; short-sleeves shirts; stuff jackets [clothing]; sweaters; jumpers; pullovers; tee-shirts; trousers; pants; vests*.

93. The ground fails in respect of:

> *Coats; dresses; dressing gowns; headscarves; hoods [clothing]; jumper dresses/ pinafore dresses; petticoats; pyjamas; ready-made linings [parts of clothing]; scarves; suits; waistcoats*.

94. As I have found that there will be unfair advantage in relation to the goods for which there will be a link, I do not need to look at whether there will also be detriment to repute or distinctive character.[33]

Section 5(4)(a)

95. Section 5(4)(a) states:

> "(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-

[33] As set out at the start of this decision, detriment to repute has been inadequately pleaded.

(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."

96. 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."

97. The three elements which the opponent must show are well known. 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)."

98. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217, at 223:

> "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."

99. The prima facie relevant date is the date the application was filed, there being no evidence that it has been used. The evidence shows that the opponent, at the relevant date, had a very substantial level of goodwill in its business associated with its signs (equivalent to its earlier series of marks) in relation to sportwear and retail thereof. The signs were highly distinctive of this goodwill at the relevant date.

100. I do not think that this ground puts the opponent in a better position than its section 5(2)(b) ground. In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewison L.J. had previously cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that "a substantial number" of the relevant public are deceived, which might not mean that the average consumer is confused. However, in the light of the Court of Appeal's later judgment in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

101. The factors at play in this ground are equal to those in the section 5(2)(b) ground. For the same reasons as there would be no likelihood of confusion, a substantial number of the opponent's customers would not be deceived. Being reminded of the earlier mark is insufficient without deception taking place. In *Phones 4u Ltd v Phone4u.co.uk. Internet Ltd* [2007] RPC 5, Jacob LJ said:

> “16 The next point of passing off law to consider is misrepresentation. Sometimes a distinction is drawn between "mere confusion" which is not enough, and "deception," which is. I described the difference as "elusive" in *Reed Executive Plc v Reed Business Information Ltd* [2004] R.P.C. 40. I said this, [111]:
>
> > “Once the position strays into misleading a substantial number of people (going from 'I wonder if there is a connection' to 'I assume there is a connection') there will be passing off, whether the use is as a business name or a trade mark on goods.””

102. I remain of the view that the opponent’s customers (or potential customers) will not engage in an analysis which brings them to a conclusion that the swapping out of Shark for Bull, and the addition of the bull device, signifies the opponent’s goods or services, or that of a business connected with the opponent. The section 5(4)(a) ground fails.

Overall outcome

103. The opposition succeeds in full under section 3(6) and partially under section 5(3). The application is refused.

Costs

104. The opponent has been successful and is entitled to an award of costs, based on the scale published in Tribunal Practice Notice 1/2023. I award costs in favour of the opponent as follows:

Fee for Form TM7	£200
Preparing the notice of opposition and considering the counterstatement	£400

Preparing evidence, submissions and considering the applicant's evidence	£1000
Written submissions in lieu of a hearing	£450
Total	£2050

105. I order Abdulwahed Bin Shabib Distribution to pay to Gymshark Limited the sum of £2050. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 2nd day of June 2026

Judi Pike
For the Registrar

Annex

The opponent's Class 35 specification

Advertising, particularly services for the promotion of goods; loyalty, incentive and bonus program services; merchandising; product demonstrations and product display services; production of video recordings for marketing purposes; providing consumer product advice; promotion of goods and services through sponsorship; promotion of goods and services through sponsorship of sports, business and charitable events; promotional management for sports personalities and sports people; promotion of sports competitions and events; organisation of exhibitions and events for commercial or advertising purposes; organisation of exhibitions and events in the field of sports; import and export services; advertising services; organisation of trade fairs; retail, online retail, mail order and wholesale services, including temporary and 'pop-up' retail store services in connection with dietary and nutritional supplements and dietetic preparations, vitamin supplements, food supplements for sportsmen, sportswomen and athletes, food supplements in liquid form, protein supplements, protein supplement shakes, mineral nutritional supplements, nutritional supplement energy bars, fitness and endurance supplements, protein powder dietary supplements, nutritional supplement meal replacement bars for boosting energy, powdered nutritional supplement drink mix, nutritional drinks and drink mixes for use as a meal replacement, protein supplement drinks and powders, antioxidants, dietary supplement drinks, herbal supplements, meal replacement powders, mineral supplements, nutraceutical preparations for humans, first-aid kits, scientific, surveying, photographic, cinematographic, weighing, measuring, signalling, checking supervision, monitoring and teaching apparatus and instruments, sensors and detectors, apparatus for recording, transmission or reproduction of sound or images, recording discs, compact discs, DVDs and other digital recording media, calculating machines, data processing equipment, computer software, computer software applications, downloadable mobile applications, health monitoring software, downloadable videos, video recordings, downloadable video files, media content, downloadable videos and media in the field of sports, fitness, nutrition and health, pre-recorded videos, pre-recorded fitness DVDs, electrical and electronic apparatus and instruments for recording and measuring health and fitness parameters, computer software for providing information relating to fitness, calorie counting and step counting, multifunctional electronic devices to view, measure and

upload to the internet information, including time, date, body and heart rate values, global positioning, direction, distance, altitude, cadence, speed, calories burned and steps taken, pedometers, calorie counting apparatus, heart-rate and fitness monitoring apparatus, mouth guards being gum shields, headphones, earphones, sunglasses and spectacles, frames and cases for sunglasses and spectacles, eyeshades, swimming goggles and swimming masks, straps, cases, covers and waterproof cases for mobile phones, tablet computers, computers, electronic devices and portable media players, protective and safety equipment, wearable activity trackers, skin moisture analyzers, not for medical purposes, testing devices, audio-visual teaching apparatus, electronic sports training simulators, massage apparatus, physiotherapy and rehabilitation equipment, foam massage rollers, compression bandages, compression garments, compression stockings, orthopaedic compression supports, limb compression instruments, body limb compression sleeves, compression socks for medical or therapeutic use, apparatus for electrical muscle stimulation, apparatus for the therapeutic toning of the body and muscles, therapeutic body toner apparatus, computer controlled exercise and training apparatus for therapeutic use, deep heat massage apparatus, electro-stimulation apparatus for use in therapeutic treatment, exercise apparatus for medical rehabilitative purposes, exercise machines for therapeutic purposes, hot therapy apparatus, nerve muscle stimulators, parallel bars for medical and therapeutic use, physical exercise apparatus for therapeutic use, step-up machines for use in physiotherapy, weight training apparatus adapted for medical use, supportive bandages, arch supports for flat feet, body limb compression sleeves for athletic use, elastic bandages, inserts and insoles for footwear for orthopaedic use, lumbar belts, tubular elastic bandages, jewellery, key rings, key chains, key chain charms, key fobs, leather and imitations of leather, luggage, trunks and travelling bags, suitcases, athletic bags, umbrellas and parasols, bags, bags for sport, gymnasium bags, mini-bags, tote bags, duffel bags, backpacks, bags for clothes, drawstring bags, holdalls, wash bags, beach bags, boot bags, cloth bags, cosmetic bags, toiletry bags, canvas bags, bum bags, beauty cases, belt bags and hip bags, purses and wallets, fitted protective covers for luggage, handbags, leather bags, luggage labels, luggage straps, luggage tags, shoe bags, shopping bags, animal apparel, animal leads, animal harnesses and collars, combs and sponges, brushes, except paintbrushes, unworked or semi-worked glass, except building glass, glassware, porcelain and

earthenware, glasses, drinking vessels, bottles, drinks bottles, shaker bottles, running bottles, reusable plastic water bottles, sports bottles sold empty, reusable stainless-steel water bottles, cups, cup lids, fruit infuser bottles, flasks, bottle coolers, tableware, mugs, tumblers, bottles and tableware, bowls, plates, dishes, cool boxes, cool bags, ceramics for household purposes, crockery, chopping boards for kitchen use, cloths for eye-glasses, hairbrushes, golf brushes, bakeware, cookware, beverage coolers, biodegradable bowls, cups, plates, coasters, not of paper or textile, non-electric food and beverage coolers, insulated containers for food, empty spray bottles, jugs, laundry baskets, litter bins, lunchboxes, mixing bowls, mixing spoons, portable coolers, vacuum bottles, flasks and jars, cases adapted for cosmetic utensils, nail brushes, boot brushes, boot stretchers, clothes brushes, shoe horns, textile goods, textiles for making into articles of clothing, household linen, towels, gym towels, beach towels, hammam towels, apparel fabrics, coated fabrics, elastic fabrics for clothing, elastic woven materials, fabric linings for clothing, fabric for footwear, fabric and materials for use in the manufacture of clothing, bags, headgear and footwear, fabrics being textile piece goods for use in manufacture, synthetic fibre fabrics, textile fabrics for use in the manufacture of sportswear, vapour permeable fabrics, waterproof fabrics, labels of textile, textile handkerchiefs, throws, washcloths, exercise towels, bedding, bed and table covers, bath linen (except clothing), bedspreads, blankets, cushion covers, curtain holders of textile materials, curtains, banners, flags, textile place mats, napkins of textile materials, pillowcases, sheets, clothing, footwear, headgear, clothing, namely tops and bottoms, sweat absorbent clothing, bodybuilding clothing, fitness clothing, gym clothing, sports clothing, ski wear, surf wear, leisurewear, clothing for gymnastics, dancewear, clothing for running, clothing for tennis, bodybuilding and weightlifting clothing straps, wristbands and wrist straps, sweatbands, headbands, hats, caps, sun visors [head wear], beach hats, bobble hats and beanie hats, swimming caps, T-shirts, long sleeve t-shirts, crop t-shirts, running vests, vests and tank tops, polo shirts, sports shirts, crop tops, bodysuits, hooded jackets, tops, sweaters and jumpers, cardigans, knitwear, gilets, jackets, padded jackets, sports jackets, coats, jumpers, sweatshirts, cycling tops, pullovers, boxing robes, shorts, sweat shorts, gym shorts, running shorts, cycling shorts, boxing shorts, tennis shorts, dresses and skirts, clothing for martial arts, jumpsuits, dungarees, dresses and skirts for tennis, trousers, tracksuits and tracksuit bottoms, jogging bottoms, leggings, cropped leggings, ski pants, yoga

pants, yoga shirts, tights, knitted tights, harem pants, underwear, thongs, briefs, boxer shorts, trunks [underwear], sports bras, bras, bralettes, socks, trainer socks and ankle socks, dressing gowns and robes, gloves, weightlifting gloves, cycling gloves, base layer clothing, compression wear clothing, swimwear, beachwear, beach cover ups and wraps, sarongs, bikini tops, bikini bottoms, tankinis, swimsuits, swimming trunks, swimming shorts, rash vests, wetsuits, shoes, sports footwear, trainers, beach footwear, boots, sandals, flip flops, sliders, slippers, boxing shoes and boots, track shoes, running shoes and spiked running shoes, cycling shoes, golf shoes, gym shoes, dance shoes and dance slippers, tennis shoes, moisture wicking sports pants, shirts and bras, articles of outer clothing, articles of underclothing, scarves, pyjamas, babies clothing, footwear, headgear, infant clothing, footwear, headgear, baby boots, bibs, romper suits, baby sleepsuits, belts, sports singlets, athletic tights, bandanas, ballet shoes, baselayer tops, cashmere clothing, cargo pants, casualwear, clothing for wear in wrestling games, cover-ups, costumes, ear muffs, suits, eye masks, earbands, fishing clothing, footwear, headgear, functional underwear, golf clothing, headgear, footwear, insoles, jeans, jerseys, jogging suits, jogging clothing sets, leg warmers, leather clothing, leotards, light-reflecting coats, maternity clothing, maternity sports clothing, motorcyclists clothing, neckerchiefs, nightwear, one-piece suits, padded clothing for athletic use, playsuits, plimsolls, rainwear, rugby clothing, rugby footwear, football clothing, football footwear, shapewear, sleepwear, sports garments, stretch pants, sweat-absorbent socks, stockings, leggings, underclothing, outerclothing and clothing, tennis wear, thermal clothing, headgear, underwear, waist belts, water resistant clothing, walking shoes, windcheaters, accessories for apparel, sewing articles and decorative textile articles, embroidery, ribbons and braid, buttons, hooks and eyes, pins and needles, hair decorations, hair fastening articles, hairbands, headbands, hair clips, scrunchies, armbands for holding sleeves, badges for wear, not of precious metal, belt buckles, belt clasps, boot laces, buckles for clothing, cords for clothing, fasteners for clothing, shoe laces, shoe ornaments of plastic, zips, zipper pulls, mats and matting, exercise mats, yoga mats, gymnasium mats, games, toys and playthings, video game apparatus, gymnastic and sporting articles, sporting equipment, gymnasium, sport and training equipment, balls, sport and game balls, Pilates toning balls, athletic exercise cones, sporting protective items being protective padding for wear during sport, athletic protective sportswear, weight lifting belts, athletic knee and wrist

supports, boxing gloves, weight lifting gloves, barbell pads, padded lifting straps, punchbags and balls, lifting weights, exercise weights, leg, ankle and wrist weights, elbow guards, knee guards, shin pads, face masks for sports, benches for sporting use, grips for sporting articles, fist protectors, pads for use in sports, chest protectors for sports use, body protectors for sports use, face guards for sports use, shoulder pads for sports use, hand wraps for sports use, hand pads for use in sports, harnesses for use in sports, cases and bags adapted for sporting articles, leg guards adapted for playing sport, exercise balls, treadmills, exercise machines, cardio-vascular exercise machines, exercise bicycles, cross-trainer exercise machines, stepping exercise machines, exercise benches, exercise pulleys, exercise, yoga and Pilates blocks and straps, yoga swings, skipping ropes, exercise resistance straps and bands, swimming floats and rings, beach balls and inflatable beach balls, gym chalk for improving hand grip in sports activities, indoor fitness apparatus, apparatus for achieving physical fitness, shock absorption pads for protection against injury [sporting articles], dumb-bells and bar-bells for weight lifting, back supports for weightlifters, machines incorporating weights for use in physical exercise, aerobic steps, abdomen protectors for athletic use, body-building apparatus, body training apparatus, body toner apparatus, head covers and gloves for use in sports, hoops for exercise, kettlebells, kick pads for martial arts, nets for sports, portable home gymnastic apparatus, body rehabilitation apparatus, relay batons, lanyards for wear, knee and elbow bandages, elasticated supports for the knees and elbows, micro fibre towels, pads for barbells, running belt bags, surfboards and body boards, squat racks, stomach exercisers, stress relief balls, swimming equipment, mouth guards for boxing, boxing helmets, protective clothing, footwear and headgear, protective clothing, footwear and headgear for use in sports and combative sports, combative sports uniforms, combative sports clothing, footwear and headgear, clothing, footwear and headwear for boxing, cage fighting, kickboxing and muay thai, punching bags for boxing and parts, fittings and accessories for all the aforesaid goods; information, advisory and consultancy services in relation to the foregoing.