O/0500/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO UK3803519

BY GRATTAN PUBLIC LIMITED COMPANY

TO REGISTER:

FREESTYLE

AS A TRADE MARK IN CLASSES 18 AND 25

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NO 436671
BY FFI GLOBAL S.R.L

BACKGROUND AND PLEADINGS

1. On 27 June 2022, ("the applicant") Grattan Public Limited Company applied to register the trade mark shown on the cover of this decision ("the applicant's mark") in the UK for the following goods:

> **Class 18:** Bags; handbags; leather bags; belts; travelling bags; wallets; purses; note cases; card cases; brief cases; attaché cases; umbrellas; toiletry bags and cases; cosmetic bags and cases; jewellery bags and cases; leather handbags; leather belts; leather travelling bags; leather wallets; leather purses; leather note cases; leather card cases; leather brief cases; leather attaché cases; leather toiletry bags and cases; leather cosmetic bags and cases; leather jewellery bags and cases; imitation leather handbags; imitation leather belts; imitation leather travelling bags; imitation leather wallets; imitation leather purses; imitation leather note cases; imitation leather card cases; imitation leather brief cases; imitation leather attaché cases; imitation leather toiletry bags and cases; imitation leather cosmetic bags and cases; imitation leather jewellery bags and cases; excluding fishing bags and fishing belts.
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> **Class 25:** Swimwear; nightwear; underwear; lingerie; women's clothing; women's wear; women's footwear; women's headgear; women's swimwear; women's nightwear; women's underwear; men's clothing; men's wear; men's footwear; men's headgear; men's swimwear; men's nightwear; men's underwear; children's clothing; children's wear; children's footwear; children's headgear; children's swimwear; children's nightwear; children's underwear; baby wear; excluding fishing clothing, fishing footwear and fishing headgear.[1]

2. The application was published for opposition purposes on 5 August 2022, and it was opposed by FFI Global S.R.L ("the opponent") on 5 October 2022. The

[1] On 11 July 2024 a Form TM21B was filed which changed the applicant's class 25 goods to as they are now. It was accepted by the registry and a letter notifying the parties was sent on 28 July 2024. The opponent contacted the registry on 12 August 2024 to confirm that the opposition was maintained.

opposition is based on section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opponent relies on the following mark in relation to the ground of opposition:

Free Soul
UK900285023[2]
Filing date 2 July 1996; date of entry in register 14 April 2000

Relying on all of its goods, namely:
("opponent's earlier mark")

Class 25: Clothing, footwear, headgear.

3. Under its 5(2)(b) ground, the opponent claims that due to the similarity between the parties' marks and the identity and/ or similarity of the goods at issue, there exists a likelihood of confusion on the part of the relevant public, which includes the likelihood of association. The opponent's mark is subject to proof of use. The applicant requested that the opponent demonstrate use of its mark.

4. The opponent is represented by Barker Brettell LLP; the applicant is represented by Clarion Solicitors Limited. The opponent filed evidence in chief. The applicant filed a witness statement. The opponent also filed evidence in reply. No hearing was requested. Only the applicant filed submissions in lieu of a hearing. The decision is taken following a careful consideration of all of the papers.

5. 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 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU

[2] On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all rights holders with an existing EUTM. As a result of the opponent having an EUTM being protected as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable trade mark shown here is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law and retains its original filing date.

Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

EVIDENCE

6. As mentioned above, the opponent filed evidence in chief to demonstrate proof of use of its mark. The opponent's evidence in chief came in the form of the witness statement of Ms Deborah Scalcon dated 18 October 2023 and is accompanied by 2 exhibits, DS01 and DS02. Ms Scalcon is the CEO of the opponent. The evidence is of purchase orders and invoices dated 28 February 2020 to 24 June 2022 and of the opponent's website.

7. The applicant filed a witness statement in the name of Mr Lee Weighman who is a Legal Executive at Freemans Grattan Holdings Limited (which Mr Weighman explains is a subsidiary organisation of the applicant). The witness statement provides background information about the applicant's company and addresses the evidence of use provided by the opponent.

8. The opponent also filed evidence in reply. This came in the form of the second witness statement of Ms Deborah Scalcon dated 4 July 2024. The witness statement of Ms Scalcon is accompanied by two exhibits, DS01A and DS02A. The evidence is of marketing booklets and further purchase orders and invoices..

DECISION

Proof of Use

9. Section 6A of the Act is as follows:

"(1) This section applies where-

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in sections 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section 'the relevant period' means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if-

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes-

(a) use of a trade mark includes use in a form (the 'variant form') differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

[(5) Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

…"

10. Paragraph 7 of Part 1 Schedule 2A of the Act reads as follows:

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

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

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

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

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

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

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

11. Section 100 of the Act is as follows:

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

12. In *EasyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

"105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 Ansul BV v Ajax Brandbeveiliging BV [2003] ECR I-2439, Case C-259/02 La Mer Technology Inc v Laboratories Goemar SA [2004] ECR I-1159, Case C-416/04 P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs) [2006] ECR I-4237, Case C-442/07 Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'[2008] ECR I9223, Case C-495/07 Silberquelle GmbH v Maselli-Strickmode GmbH [2009] ECR I-2759, Case C-149/11 Leno Merken BV v Hagelkruis Beheer BV [EU:C:2012:816], Case C-609/11 Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG [EU:C:2013:592], Case C-141/13 P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) [EU:C:2014:2089], Case C-689/15 W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 Ferrari SpA v DU [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a subcategory of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: Ansul at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: Ansul at[36]; Sunrider at [70]; Verein at [13]; Centrotherm at [71]; Leno at [29]; Ferrari at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: Ansul at [36]; Sunrider at [70]; Verein at [13]; Silberquelle at [17]; Centrotherm at [71]; Leno at [29]; Gözze at [37], [40]; Ferrari at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: Ansul at [37]. Internal use by the proprietor does not suffice: Ansul at [37]; Verein at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: Silberquelle at [20]-[21]. But use by a non-profit making association can constitute genuine use: Verein at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial raison d'être of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: Ansul at [37]-[38]; Verein at [14]; Silberquelle at [18]; Centrotherm at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: Ansul at [38] and [39]; La Mer at [22]-[23]; Sunrider at [70]-[71], [76]; Centrotherm at [72]-[76]; Reber at [29], [32]-[34]; Leno at [29]-[30], [56]; Ferrari at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no de minimis rule: Ansul at [39]; La Mer at [21], [24] and [25]; Sunrider at [72]; Leno at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: Reber at [32]."

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

14. Given its filing date, the opponent's mark qualifies as an earlier trade mark under section 6 of the Act. The opponent's mark completed its registration process more than five years before the filing date of the application and, therefore, should be subject to proof of use conditions. The conditions of use, therefore, do apply to the earlier mark and, as I have already said, the applicant has put the opponent to proof of use. The relevant period for the purposes of the proof of use assessment is the five-year period ending with the date of application for the contested mark. It is therefore 28 June 2017 to 27 June 2022.

15. I am also guided by *Awareness Limited v Plymouth City Council,* Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

"22. The burden lies on the registered proprietor to prove use. […] However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the

more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public."

16. I also note Mr Alexander Q.C.'s comments in *Guccio Gucci SpA v Gerry Weber International AG*, Case BL O/424/14. He stated:

"The Registrar says that it is important that a party puts its best case up front – with the emphasis both on "best case" (properly backed up with credible exhibits, invoices, advertisements and so on) and "up front" (that is to say in the first round of evidence). Again, he is right. If a party does not do so, it runs a serious risk of having a potentially valuable trade mark right revoked, even where that mark may well have been widely used, simply as a result of a procedural error. […] The rule is not just "use it or lose it" but (the less catchy, if more reliable) "use it – and file the <u>best evidence first time round</u> – or lose it"" [original emphasis]

17. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd,* Case BL 0/404/13*,* Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

"21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence

required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not *'show'* (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use."

The opponent's evidence

18. Ms Scalcon states that the 'Free Soul' brand is an Italian-based clothing manufacturer and designer that was founded in 1994. Ms Scalcon asserts that the opponent used this trade mark in relation to a range of clothing products which are sold in territories around the world, including in the UK.

19. The opponent has provided evidence in respect of invoices and purchase orders, product catalogues and historic website extracts as recorded on the 'wayback machine'. I note the following regarding the evidence:

a) Exhibits DS01 and DS02A pertain to the sale of goods between 28 February 2020 and 24 June 2022. All of the invoices are dated in the relevant period. In some of the purchase orders the opponent's mark appears either after the

vendor as “Vendor: FFI GLOBAL/FREESOUL’ or under the brand of the goods in the purchase orders as “Freesoul”. Whilst I note that there is no reference to the full mark on the invoices there is reference to ‘FRSL’. Given that the opponent’s purchase orders are followed immediately by the opponent’s invoice dates, the items listed in the purchase order match the invoices and the associated value of the goods are also highly similar or identical – I consider that reference to the brand freesoul in the purchase orders indicates sales of goods relating to the brand in the invoices. Below is a table that outlines the goods demonstrated by the purchase order and the correlating invoices:

Purchase order date	**Correlating invoice date**	**Goods**	**Units**	**Customer and location**	**Value in Euros**
28 Feb 2020	9 March 2020	Denim Shirt Shirley	809	TJX Europe Buying Limited. Watford, Hertfordshire.	9592
12 Aug 2020	17 Aug 2020	Quilted shirt man	260	As above	3380
23 Oct 2020	27 Nov 2020	Jogger Woman Pant	505	As above	4545
23 Oct 2020	27 Nov 2020	Jogger Woman Pant	280	As above	2520
16 Sept 2021	24 Sept 2021	Alfa 7 Pocket Slim	530	As above	6360
16 Sept 2021	27 Sept 2021	Alfa 7 Pocket Slim	400	As above	4800
14 July 2021	15 Nov 2021	FRSL 5 Pocket Women Short RFD Man FRSL 5 Pocket Woven Short RFD Man	576	As above	3456

3 Nov 2021	14 Feb 2022	Freesoul Woven Man Slim Jeans	1100	As above	15950
24 June 2022	13 July 2022	Alloa Black P94/P93/ P90/ P96/ P95 Alloa Blue P89/P86/ 88/P74/P90	1061	As above	5474.76
24 June 2022	13 July 2022	Colin Black 1 Colin Black 2	952	As above	6426
15 March 21	19 March 2021	FRSL WMN JKT Teddy Lining	660	As above	7920
20 May 2021	18 June 2021	Boyfriend hoodie woman knitwear	469	As above	4455
3 Nov 2021	14 Feb 2022	Freesoul Women Man Slim Jeans	962	As above	13949
13 May 2022	26 May 2022	Denim Slim Denim Slim Blue Italy Colorno/ Collecchio/ Compian	998	As above	12125.70

b) Exhibit DS02 are extracts of the opponent's website dated during the relevant period. The opponent's mark appears on the website. There are a series of images of models wearing jackets, t-shirts and jeans. Whilst it is unclear whether these items bear the opponent's mark, given that they appear on the opponent's website this indicates that these are goods sold under its mark.

c) Exhibit DS01A- the opponent states that there are marketing booklets which show the range of the goods sold under the mark "FREE SOUL", including footwear, shorts and t-shirts. I note that the bottom, inside and tongue of the shoes and the polo shirts bear the opponent's marks. However, the shorts do not bear the opponent's mark, rather they bear a device mark. Example 1

and 2, is the mark as it appears on t-shirts. The marks on the opponent's shoes appear in different colour variants as those demonstrated below.

(Example 1)

(Example 2)

Form of the mark

20. Before considering whether the opponent has made genuine use of the mark and, if so, for what goods, I shall deal with the question of the form of the mark. The opponent's registration can be seen below. In all instances throughout the evidence where the opponent has used the mark as registered – this is clearly use upon which the opponent can rely:

Free Soul

21. Throughout its evidence, the opponent has used its mark in a number of other ways. These are shown below:

Example 1: FREESOUL

Example 2:

Example 3: 

22. I note that the first example is the opponent's mark as a singular word rather than two separate words. Despite this, I do not consider that this alters the distinctive character of the mark to the point that it would not be considered use of the mark as registered, nor does the fact that it is used in all capitals alter anything as word only marks are not limited by any features such as capitalisation or the typeface which appears on the Register.[3] Example 1 is therefore use upon which the opponent can rely.

23. As per the case of *Colloseum*, use of a mark generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark. As seen above, examples 2 and 3 show use of the mark with the additional device, either with the text within the device or next to the device. I consider that the opponent's mark maintains its role as an independent indication of origin within these examples. Even taking into account the additional device, I do not consider that this would alter the distinctive character of the mark to the point that it would not be considered use of the mark as registered. Examples 2 and 3 are also acceptable variants of the mark, therefore use of these variants is use on which the opponent can rely.

Genuine use of the mark

24. For use to be genuine, it must have been real commercial exploitation of the mark, in the course of trade, sufficient to create or maintain a market for the goods at issue in the relevant territory during the relevant five-year period. In making my assessment, I am required to consider all relevant factors, including:

[3] See the comments of Iain Purvis KC, sitting as the Appointed Person in the following two cases: *Groupement Des Cartes Bancaires v China Construction Bank Corporation,* Case BL O/281/14, paragraph 21; and *HERNO S.p.A. v Miss Sparrow Ltd,* BL O/954/22, paragraph 37.

- the scale and frequency of the use shown;
- the nature of the use shown;
- the goods for which use has been shown;
- the nature of those goods and the market(s) for them; and
- the geographical extent of the use shown.

25. I note that the applicant reiterated that it did not consider the evidence to show use of the mark in relation to the goods relied upon. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.[4] I note that as the opponent's mark is a comparable mark it is possible for the opponent to rely on evidence of use in the EU as set out in Tribunal Practice Notice 2/2020. [5]

26. I note that the opponent has not provided evidence regarding its turnover during the relevant period other than the invoices referenced above, nor did they provide any summary of the invoices. I have calculated that the invoices demonstrate evidence of the sale to a single UK company based in Hertfordshire to the value of €100,953.46 for sales of hoodies, jeans, jackets, shorts, t-shirts and joggers. When cross-referencing the invoices to the opponent's catalogue, some of the goods listed on the invoices appear with the opponent's mark throughout the evidence. Specifically, in my view, this evidence indicates that shorts and t-t-shirts referenced in the invoices are products that bear the opponent's mark. I do not have evidence or submissions from the parties to assist me on the matter of the size of the UK/EU market for the goods concerned, so it is hard to contextualise the figures. However, I do not consider that the figures are overwhelming.

27. Despite this, the case law cited above states that use of a mark need not always be quantitively significant for it to be deemed genuine. The sales are not simply attributable to a one-off sale but, instead, the opponent has demonstrated a consistent and repeated pattern of sales throughout the relevant period. Further, I have

[4] *New York SHK Jeans GmbH & Co KG v OHIM*, T-415/09
[5]https://www.gov.uk/government/publications/tribunal-practice-notice-22020-end-of-transition-period-impact-on-tribunal-proceedings/tribunal-practice-notice-22020-end-of-transition-period-impact-on-tribunal-proceedings accessed 1/2/2022.

considered that the market for the goods across the UK and the EU is likely to be extremely competitive with a vast number of producers competing with one another. Therefore, lower sales do not equate to use that is not genuine. I also bear in mind that sales to a single customer could be attributed to exclusivity of supply contracts whereby the seller agrees to exclusively sell their products to a single retailer in a given territory, therefore the fact that the evidence only supports sales to a single UK customer is not detrimental either.

28. In relation to promotional materials, specifically the catalogues and website extracts, I note that there is no information on the scale of the audience nor the distribution or reach of the promotional material. There is also a lack of figures being provided to demonstrate expenditure on advertising. In addition, I note that the catalogue pages are undated. Further, as mentioned by the applicant, all of the references to the opponent's fall catalogue on the web pages (which are dated in the relevant period) appear to reference a 2014/2015 catalogue, even in 2018 (which is unusual); the 2014/2015 catalogue is not dated during the relevant period but appears to have been accessible during the relevant period.

29. There are some clear deficiencies in the evidence provided by the opponent. There is a lack of evidence in relation to the distribution of marketing and advertising evidence. However, as noted above genuine use requires a global assessment of the evidence as a whole. The sales are not simply attributable to a one-off sale but, instead, the opponent has demonstrated a consistent and repeated pattern of sales to a customer throughout the relevant period. I do note that this is to a single customer. I note that the sales figures of €100,953.46 are far from overwhelming. The evidence supports a finding that the opponent's sales constitute a genuine attempt to create a market for its goods in the UK under its mark. Taking all the above into consideration, I am of the view that the opponent has demonstrated genuine use of its mark during the relevant period in the UK. I will now go on to assess whether the terms used in the opponent's specification are fair in light of what use has been shown.

Fair specification

30. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors*, [2017] EWCA Civ 1834, Kitchin LJ (as he then was) set out the approach to be followed when considering partial revocation of a trade mark. The same approach is relevant when framing a fair specification. He said:

> "244. As I described in Maier v Asos, the approach to be adopted is relatively straightforward (although I readily acknowledge that it may on occasion be difficult to apply) and it is in my view consistent with the earlier decisions of the Court of Appeal to which I referred at paragraph [63]. On reflection, I think it can be expressed more clearly as follows.
>
> 245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.
>
> 246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other categories.
>
> 247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.
>
> 248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark."

31. I note that the opponent's mark is registered for the following goods:

Class 25: *Clothing, footwear, headgear.*

32. I shall begin with *"headgear".* I do not consider that any use has been shown for *"headgear"* in the evidence that has been provided. No mention has been made in the invoices nor is there any evidence in relation to the website extracts.

33. I accept that there is mention on the invoices for goods that fall within the term *"clothing"* in the opponent's evidence, specifically hoodies, jeans, jackets, shorts, t-shirts and joggers. I note that these goods are referenced on the invoices bearing the opponent's marks. However, I have no corroborating evidence to show whether the packaging/ swing tags of the goods listed in the invoices bore the opponent's mark, nor whether the mark was applied to the goods themselves. There is only clear corroborating evidence in relation to shorts and t-shirts.[6]

34. I remind myself that the burden of proof lies on the opponent. Taking all of the above factors into account, I do not consider that the opponent has proved use in relation to all of the goods on which it relies; they have proved use in relation to *"hoodies", "jeans", "jackets", "shorts", "t-shirts"* and *"joggers".* Given that the general term *"clothing"* would include many other goods, such as vests, I do not consider that it would be fair to allow the opponent to rely on the general term purely on the basis of the use shown in the evidence for the goods listed above. Therefore, in my view, a fair specification for the class 25 term *"clothing"* is "hoodies", "jeans", "jackets", "shorts", "t-shirts" and "joggers".

35. Turning to *"footwear"*, whilst I note that the opponent's catalogue evidence demonstrates trainers bearing the opponent's marks, those catalogues are not dated during the relevant period (they are dated 2014/2015) and there is nothing in the evidence to suggest that the opponent was still selling trainers during the relevant period. For example, none of the invoices provided demonstrate the sale of trainers not any type of footwear for that matter. Therefore, the evidence does not support use

[6] Exhibit DS01A

of the term *"footwear".* Subsequently, I consider that a fair specification of the opponent's goods encompasses *"hoodies", "jeans", "jackets", "shorts", "t-shirts"* and *"joggers".*

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

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

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

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

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

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

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

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

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

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

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

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

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

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

COMPARISON OF THE GOODS

The applicant's goods	The opponent's fair specification
Class 18: Bags; handbags; leather bags; belts; travelling bags; wallets; purses; note cases; card cases; brief cases; attaché cases; umbrellas; toiletry bags and cases; cosmetic bags and cases; jewellery bags and cases; leather handbags; leather belts; leather travelling bags; leather wallets; leather purses; leather note cases; leather card cases; leather brief cases; leather attaché cases; leather toiletry bags and cases; leather cosmetic bags and cases; leather jewellery bags and cases; imitation leather handbags; imitation leather belts; imitation leather travelling bags; imitation leather wallets; imitation leather purses; imitation leather note cases; imitation leather card cases; imitation leather brief cases; imitation leather attaché cases; imitation leather toiletry bags and cases; imitation leather cosmetic bags and cases; imitation leather jewellery bags and cases; excluding fishing bags and fishing belts. **Class 25:** Swimwear; nightwear; underwear; lingerie; women's clothing; women's wear; women's footwear; women's headgear; women's swimwear; women's nightwear; women's underwear; men's clothing; men's wear; men's footwear; men's headgear; men's swimwear; men's nightwear; men's underwear; children's clothing; children's wear; children's footwear; children's	**Class 25:** Hoodies; jeans; jackets; shorts; t-shirts; joggers.

headgear; children's swimwear; children's nightwear; children's underwear; baby wear; excluding fishing clothing, fishing footwear and fishing headgear.[7]	

38. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

39. Guidance on this issue has also come from Jacob J. (as he was then) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

> (a) The respective uses of the respective goods or services;
>
> (b) The respective users of the respective goods or services;
>
> (c) The physical nature of the goods or acts of service;
>
> (d) The respective trade channels through which the goods or services reach the market;

[7] On 11 July 2024 a Form TM21B was filed which changed the applicant's class 25 goods to as they are now. It was accepted by the registry and a letter notifying the parties was sent on 28 July 2024. The opponent contacted the registry on 12 August 2024 to confirm that the opposition was maintained.

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

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

40. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court stated that "complementary" means:

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

41. All of the goods in the applicant's class 18 and 25 terms are accompanied by the limitation *"excluding fishing clothing, fishing footwear and fishing headgear".* I have taken this limitation into account when making comparison between the goods at issue.

Class 25

42. The opponent submitted that its goods, which amounted to clothing, footwear and headgear before my assessment of the proof of use demonstrated by the opponent, were identical to the applicant's class 25 goods. The applicant, on the other hand, denied that the goods are identical or similar to the opponent's specification.

43. I consider that the broad categories *of "women's clothing", "women's wear", "men's clothing", "men's wear", "children's clothing", "children's wear"* and *"baby wear"* in the applicant's specification encompass the terms *"t-shirts"* and *"shorts"* in the opponent's specification. Therefore, I consider the goods to be identical on the principle outlined in *Meric.*

44. Moving on to *"women's footwear", "men's footwear", "children's footwear", "women's headgear", "men's headgear" and "children's headgear"* in the applicant's specification. I consider that consumers purchasing the applicant's goods will expect to find their goods in the same department or shop as the opponent's *"t-shirts"* and *"shorts*". Further, it is common that many manufacturers and designers will design and produce all of the aforementioned items. They are often selected as part of an overall aesthetic and are likely to be considered to be produced by the same undertakings. They are thus, complementary. In addition, although these goods are different in nature, I consider that these goods will share a similar purpose, as they are all used to cover and protect various parts of the human body against the elements. Further, I consider that they share the same channels of trade and are used by the same consumers. I do not consider that the goods are in competition. Therefore, I consider the goods to be similar to a medium degree.

45. The remaining goods in the application are either general items of clothing such as *"women's nightwear", "men's nightwear", "children's nightwear" , "nightwear" "women's underwear", "men's underwear", "children's underwear", "underwear"* and *"lingerie"* or more specific items of clothing such as *"women's swimwear", "men's swimwear", "children's swimwear"* and *"swimwear".* These goods in the application are not identical to the opponent's goods in class 25. However, when one considers the likely overlap in: the users of the competing goods, the nature of the competing goods, their intended purposes, the manner in which they will be used and, their respective trade channels, the competing goods are, in my view, to be regarded as being similar to a medium degree.

Class 18

Bags; handbags; leather bags; leather handbags; imitation leather handbags;

46. The broad terms *"bags"* and *"leather bags"* in the applicant's specification includes handbags. Fashion accessories such as handbags have consistently been found to be similar to clothing based on the fact that they share a common aesthetic

function since these goods jointly contribute to the 'look' of the consumers.[8] It is, in fact, common customer behaviour to aesthetically combine those goods when purchasing them and their aesthetic coordination may also be considered at the design stage. Moreover, these goods usually coincide in their producers and are commonly found in the same retail outlets. Consequently, whilst the nature, purpose and method of use of the goods is different, they target the same users, share trade channels and are complementary. Overall, they are similar to a low degree.

Belts; leather belts; imitation leather belts;

47. Similarly to the comparison made above in relation to handbags, I consider that belts are a fashion accessory that have consistently been found similar to items of clothing based on the fact that they share a common aesthetic function since these goods jointly contribute to the 'look' of the consumers; in addition belts are intended to hold clothing in place around the wearer's waist and are also functional and used in conjunction with clothing – for example, many garments, especially trousers, are manufactured with belt loops. I consider that the comparison that I have made above in relation to the handbags will apply here. Subsequently, I consider the goods to be similar to a low degree.

Travelling bags; brief cases; attaché cases; toiletry bags and cases; cosmetic bags and cases; jewellery bags and cases; leather travelling bags; leather brief cases; leather attaché cases; leather toiletry bags and cases; leather cosmetic bags and cases; leather jewellery bags and cases; imitation leather travelling bags; imitation leather brief cases; imitation leather attaché cases; imitation leather toiletry bags and cases; imitation leather cosmetic bags and cases; imitation leather jewellery bags and cases; Wallets; purses; note cases; card cases; leather wallets; leather purses; leather note cases; leather card cases; imitation leather wallets; imitation leather purses; imitation leather note cases; imitation leather card cases;

48. These goods are dissimilar to the opponent's goods. The nature and the main purpose of these goods are different. The main function of clothing is to dress the

[8] See for example the GC's decision T 39/10, Pucci, at § 76-77

human body whilst the main purpose of: luggage (i.e. 'travelling bags') and toiletry bags is to carry things when travelling or for an overnight trip or stay; and the purpose of purses and wallets is to carry money, payment cards etc. These goods therefore have different uses and methods of use to the opponent's goods. In my view, the goods will target the same consumers. The goods may be found next to each other in the store as part of a cohesive collection and I consider that there may be a degree of complementarity between the goods. Therefore, I find them to be similar to a low degree.

Umbrellas

49. I do not consider that the goods overlap in nature, use or purpose with the opponent's "t-shirts" and "shorts". In my view, there is no overlap in user or trade channels, other than the fact that the goods may be sold within a reasonable proximity of clothing items in departments stores or other retail premises. It is not my view that there will be any complementarity or competition between the goods. Therefore, I find these goods to be dissimilar.

50. As some degree of similarity between the goods is necessary to engage the test for likelihood of confusion,[9] the opposition must fail in respect of the following goods in the applicant's specification that I have found to be dissimilar to the opponent's goods:

Class 18: *Umbrellas.*

THE AVERAGE CONSUMER AND THE PURCHASING PROCESS

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

[9] eSure Insurance v Direct Line Insurance [2008] ETMR 77 CA

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

52. The applicant submits that the average consumer will take a higher degree of care when choosing these types of products. This is on the basis that consumers nowadays, rather than in the past, have a greater interest in the source of their clothing for ethical, environmental and sustainability reasons. The applicant goes on to submit that the average consumer therefore takes a greater interest in these types of products when purchasing them.

53. In my view, the average consumer of the goods at issue will be members of the general public. The goods at issue will be available via various retailers. Regardless of the retailer, the goods at issue will be displayed on shelves or racks and self-selected by the consumer. In addition, the goods at issue will also be available via these retailers' online equivalents where they will be displayed on webpages and will be selected by the consumer after having viewed an image of the products. In my view, the visual aspect will dominate the selection process, however, I do not discount the aural component playing a role by way of word of mouth recommendations or after discussions with sales assistants. It is my understanding that the goods at issue will range both in price and in the frequency of the purchase, for example, handbags are likely to be purchased less frequently than clothing.

54. Turning to the level of attention paid, I note that whilst the goods will range in price from relatively low (perhaps where they are made of inexpensive materials) or relatively high (for example where expensive materials are used in their production). I am of the view that the consumer will pay a medium degree of attention when selecting the goods this is because the factors considered in the selection process are not particularly complex, these factors include style, fit, materials used etc. and are the same regardless of the price of goods. For the avoidance of doubt, whilst I appreciate

the applicant's submissions that consumers are paying a greater interest in the source of their clothing for ethical reasons, I consider that this applies to some consumers, not all. Even taking this into account, I am of the view that the degree of attention paid in relation to the goods at hand will remain at a medium degree of attention.

COMPARISON OF THE MARKS

The applicant's mark	**The opponent's mark**
FREESTYLE	Free Soul

55. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural, and conceptual similarities of trade marks must be assessed by reference to all the overall impressions created by the trade marks, bearing in mind their distinctive and dominant 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."

56. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

57. The opponent submits that the word element 'FREE' plays a dominant and distinctive role in the respective marks, such that any differences between the marks are likely to go unnoticed by consumers and would be insufficient to outweigh the

similarities present. On the other hand, the applicant denies that the shared element 'FREE' is the dominant element.

Overall impression

58. I agree with the applicant that the shared element of 'FREE' is not the dominant element of either mark. The applicant's mark consists of the conjoined words 'FREE' and 'STYLE'. Neither word is dominant, rather, the overall impression lies in the mark as a whole and together the words form a unit. The words hang together and have a meaning. This is a plain word mark, so it is protected in whichever form, colour and typeface it is used in.[10]

59. In relation to the opponent's mark, it consists of the words 'FREE SOUL'. Neither word is dominant, rather, the overall impression lies in the mark as a whole, and together the words form a unit. The words hang together and have a meaning. As it is a plain word mark it is also protected in whichever form, colour and typeface that it is used in.

60. Visually, I note that the opponent submits that the marks are highly similar; the applicant denies this. The marks are nine and eight letters respectively. I recognise that the marks share the first five letters F-R-E-E-S. They differ in the remainder of their letters which are T-Y-L-E and O-U-L respectively. I consider that the marks are visually similar to a medium degree.

61. Aurally, the applicant denies that the marks are similar whereas the opponent argues that the marks are similar to a high degree. I consider that the words making up both parties' marks will be given their ordinary dictionary pronunciation. The marks will share the pronunciation of 'FREE'. Whilst 'STYLE' and 'SOUL' both begin with the letter 'S', these words are pronounced differently to each other overall. Taking all of this into account, I consider that the marks will be aurally similar to a medium degree.

62. Conceptually, the applicant submits that the marks will be different. The applicant submits that the applicant's mark will convey the concept of *"to dance,*

[10] *La Superquimica v EUIPO,* Case T-24/17, paragraph 39.

perform or compete in an improvised and unrestricted fashion" and the opponent's mark will convey the concept of "*someone who is happy and free anytime, anywhere, with anyone and under any circumstance".* Bearing in mind my assessment of the overall impression of the earlier marks i.e. that the words forming part of the marks form part of a unit (having a different meaning to the meaning of the separate words words) I agree with the applicant in relation to the concepts that it states the parties' marks evoke. Therefore, I consider the marks to be conceptually dissimilar.

DISTINCTIVE CHARACTER OF THE OPPONENT'S MARK

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

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

64. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it. The opponent has not claimed that its mark has acquired an enhanced degree of distinctiveness. However, this need not be pleaded to be found. I will assess enhanced distinctiveness but shall address the inherent distinctive character first.

65. The earlier mark consists of the words 'Free Soul', therefore, the inherent distinctive character rests solely in the words themselves. The opponent's mark consists of two readily understood dictionary words that combine to create a readily understood phrase meaning "*someone who is happy and free anytime, anywhere, with anyone and under any circumstance".* The phrase is not descriptive or allusive of the goods at issue nor would it be considered by the average consumer to be related to the goods at issue. As a result, I find that the opponent's mark enjoys a medium degree of distinctive character.

66. I will now consider the evidence filed in relation to enhanced distinctive character. Enhanced distinctiveness must be established in relation to the UK market because the test for confusion will be in reference to the average consumer who is a member of the UK consumers. I note that there are no figures to demonstrate expenditure on advertising and marketing. Further, I note that I do not have evidence or submissions from the parties to assist me on the matter of the size of the UK market for the goods concerned, to identify the market share held by the mark. Sales figures have been demonstrated on invoices to a customer in the UK. I consider that that sales figures of €100,953.46 are far from overwhelming but demonstrate sales between 2020 to 2022. Taking all of the above in account, I do not consider that the evidence is sufficient to demonstrate enhanced distinctive character in relation to the earlier mark.

LIKELIHOOD OF CONFUSION

67. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer of the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

68. I have found the marks to be visually and aurally similar to a medium degree. I have found the marks to be conceptually different. I have found the opponent's mark to have a medium degree of inherent distinctive character. I have found the average consumer to be the general public. I have found the goods are likely to be selected visually, although, I do not discount an aural component. I have concluded that the degree of attention paid during the purchasing process for the goods will be medium. I have found the goods to vary in similarity from those that are identical to those that are similar to a low degree.

69. Taking all of the factors into account and even considering the principle of imperfect recollection, I do not consider that the average consumer will mistake one mark for the other. Whilst I acknowledge that the marks share the same common element, being 'FREE' and the subsequent letter 'S', and that in general terms consumers are believed to place more emphasis on the initial elements of a mark,[11] this belief is just a rule of thumb and each case must be assessed on its own facts. Despite the shared element 'FREE', I consider that the words 'SOUL' and 'STYLE' will be sufficient to enable the average consumer to differentiate between the respective

[11] El Corte Ingles v OHIM (Municor) (n114), [83]

marks; these respective words have different meanings and when combined with the word 'FREE' create different concepts that the average consumer will distinguish between and will prevent the marks from being mistakenly recalled or misremembered as each other. This is further supported by the visual and aural differences between the marks. Consequently, I do not consider there to be a likelihood of direct confusion between the marks.

70. I will now consider whether there is a likelihood of indirect confusion. Indirect confusion involves recognition by the average consumer of the difference between the marks whilst also recognising that they share a common element. Mr Purvis QC in the *L.A Sugar Limited* case sets out that there are three main categories of indirect confusion and that indirect confusion 'tends' to fall in one of them.[12] The three categories are as follows:

> "(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.). BL O/375/10 Page 15 of 16
>
> (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)."[13]

71. Whilst I note that the examples set out by Mr Purvis are not exhaustive, I note the case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors,*[14] wherein Arnold LJ referred to the comments of James Mellor QC sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he stated that a finding of a

[12] Paragraphs 16 & 17 of *L.A Sugar Limited v By Black Beat Inc*, Case BL-O/375/10
[13] Ibid, Paragraph 17
[14] [2021] EWCA Civ 1207

likelihood of indirect confusion is not a consolidation prize and that there needs to be a reasonably special set of circumstances in order to get indirect confusion where there is no likelihood of direct confusion. Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

72. In the present case, I am of the view that when confronted with the parties' marks, consumers would identify them as originating from different and economically unconnected undertakings. I say this because the application will convey the concept "to dance, perform or compete in an improvised and unrestricted fashion" and the opponent's mark will convey the concept of "someone who is happy and free anytime, anywhere, with anyone and under any circumstance". In light of this, I see no reason why a consumer would believe that the differences between them are logical indicators of a sub-brand or brand extensions of one another and to do so would mean that I would need to find that the word 'FREE' has an independent distinctive character within the respective marks and I have already found that it does not. I do not consider that a consumer would consider it logical for an undertaking that refers to dancing, performing or competing in an improvised fashion would alter its brand to the point that the reference is to a free liberal and content individual, or vice versa. I appreciate that when the consumer views the applicant's mark, the shared use of 'FREE' and the shared use of the letter 'S' may call to mind the opponent's mark, however, this is mere association, not indirect confusion. [15] In addition, I do not consider that the shared element (the word 'FREE') is so strikingly distinctive that it would be seen as something that only one undertaking would use. I consider that the consumer would believe that its shared use would be coincidental, even when considering the fact that the marks would in some instances be used for goods that are identical. Taking all of this into account, together with the comments of Arnold LJ and Mr Mellor Q.C. in the preceding paragraph, I find that there exists no likelihood of indirect confusion between the marks at issue.

CONCLUSION

[15] See *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17

73. For the reasons indicated above, the opposition based on section 5(2)(b) fails and is dismissed accordingly.

COSTS

74. The applicant has been successful and is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of £600 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Preparing a notice of defence and counterstatement and considering the notice of opposition	£200
Preparing evidence and considering the opponent's evidence[16]	£400
Total	**£600**

75. I therefore order FFI Global S.R.L to pay Grattan Public Limited Company the sum of £600. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 4th day of 2025

A KLASS

For the Registrar

[16] Whilst the applicant filed a witness statement, it had no exhibits attached and was merely making legal arguments, I therefore consider this to represent submissions as opposed to the provision of anything that is evidentiary in nature and make the costs award accordingly.