O/0517/24

TRADE MARKS ACT 1994

IN THE MATTER OF

INTERNATIONAL TRADE MARK REGISTRATION NO. 1625118

IN THE NAME OF THREAD WALLETS LLC

AND

OPPOSITION UNDER NO. 434175

BY BRIAN BAKER

Background and pleadings

1. International trade mark registration number 1625118 for the words "CARRY ON" ("the contested mark") stands registered in the name of Thread Wallets LLC ("the holder"). The international registration date is 6 April 2021 and the UK was designated on the same date. The contested mark claims a priority date of 11 November 2020 from US trade mark number 90313166 in respect of all classes in its specification, namely:

> Class 3: Lip balm holders, lipstick holders.
>
> Class 5: Hand sanitizer holders.
>
> Class 9: Cases for holding digital devices, namely, cell phone cases, tablet cases, and laptop cases; protective cases for audio equipment, namely, headphone cases, and earbud cases.
>
> Class 14: Watch wrist bands; key chains; lanyards for holding keys.
>
> Class 18: Wallets; cross-body bags, belt bags, fanny packs; lanyards for holding wallets.
>
> Class 25: Clothing, namely, shirts, hats, and belts.

2. The request for protection in the UK is opposed by Brian Baker ("the opponent"), based upon ss. 5(1), 5(2)(a), 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). The earlier registered trade marks relied upon are shown below:

	Trade mark details	**Specification relied upon**
i.	UK3195835 ("UK835") CARRY ON Filing date: 09 November 2016	Class 3: Beauty care products; perfumes, cosmetics, make up; hair care preparations; skin care preparations, sun care preparations; nail care products; nail varnishes and nail polishes; powder compacts; lipsticks; lip gloss; nail varnish remover; cotton wool balls for use in removing and applying cosmetics; make-up pads; make-up powder and

	Date of entry in register: 26 June 2020 Registered in classes 3, 6, 9, 16, 21, 25, 28, 30, 38, 41, 42 and 45.	foundation; facial wipes impregnated with cosmetics; moisturisers; beauty care preparations, body care preparations, essential oils for personal use; soaps; antiperspirants; after shave lotions; eau de cologne; soaps; preparations and products for removing make-up; toiletries; eau de toilette; antiperspirants; deodorants for personal care; hair care preparations; skin care preparations; lotions, creams and conditioners; shampoos; conditioners; beauty masks; cream, masks, oil, powder and scrubs; hand and body lotions; dentifrices; shaving preparations, dyes for hairs; bath preparations, namely, beads, crystals, foam, gels, oil and powder; scented body sprays; after-shave lotions; pre-electric shaving preparations. Class 6: Chains for keys; figurines; key rings. Class 9: Sound, video and data recording and reproducing apparatus; computer software; computer games; video games; CD Rom games; games cartridges for use with electronic games apparatus; sound and video recordings; cinematographic and photographic films; motion picture films; sunglasses; eyewear; instructional and teaching apparatus and instruments; records, discs, tapes, cassettes, cartridges, audio video disks, DVDs; cards and other carriers, all bearing or for use in bearing sound recordings, video recordings, data, images, games, graphics, text, programs or information; pre-recorded DVDs, CDs, video tapes and laser disks featuring images and/or sound; interactive multimedia computer programs and software; interactive audio visual works,

		including those distributed online; software linking digital video and audio media to a global computer information network; memory carriers, interactive compact discs and CD-ROMs; parts and fittings for all the aforesaid goods. Class 25: Clothing; footwear; headgear.
ii.	UK917997624 CARRY ON Filing date: 07 December 2018 Date of entry in register: 10 May 2019 Registered in classes 3, 6, 9, 16, 21, 25, 28, 30, 38, 41, 42 and 45.	Class 3: all goods in class (identical to UK835) Class 6: all goods in class (identical to UK835) Class 9: all goods in class (identical to UK835) Class 25: all goods in class (identical to UK835)
iii.	UK3377800 (“UK800”) CARRY ON Filing date: 22 February 2019 Date of entry in register: 10 May 2019 Registered in classes 3, 32 and 33.	Class 3: Detergents; preparations and substances for laundry use; fabric conditioning preparations; bleaching preparations; cleaning, polishing, scouring and abrasive preparations; preparations for dishwashing purposes; soaps; deodorants for personal use; hand washes; tissues impregnated with preparations and substances for cleaning and polishing; multi-use liquid cleaning preparations; detergents in powder form for domestic use; washing and bleaching preparations and other substances for laundry use.
iv.	UK3408371 CARRY ON	Class 6: all goods in class (identical to UK835)

	Filing date: 20 June 2019 Date of entry in register: 18 October 2019 Registered in classes 6, 9, 16, 21, 25, 28, 30, 38, 41, 42 and 45.	Class 9: all goods in class (identical to UK835) Class 25: all goods in class (identical to UK835)
v.	UK3471679  Filing date: 03 March 2020 Date of entry in register: 10 August 2020 Registered in class 3.	Class 3: all goods in class (identical to UK800)

3. The first four of the above trade marks are relied upon under both s. 5(1) and s. 5(2)(a). The only figurative mark, UK3471679, is relied upon under s. 5(2)(b). The opposition under all of these grounds and based on each of the earlier marks identified above is directed against all of the goods in classes 3, 9, 14, 18 and 25 of the contested mark's specification. The opponent asserts that where the parties' marks and their specified goods are identical, the contested mark should be refused in part under s. 5(1); alternatively, where the marks are identical but the goods only similar, or the marks only similar, he says that there is a likelihood of confusion and that the contested mark should be refused under ss. 5(2)(a) or (b) of the Act.

4. The same five earlier marks and the same lists of goods are relied upon under s. 5(3). The opposition under this ground is directed against all of the goods in the contested mark's specification. The opponent says that each of the marks has a reputation and that the similarity between the marks will cause the average consumer

to believe that they are used by the same or economically connected undertakings. He further asserts that use of the contested mark would give that mark an unfair advantage and that there would be damage to both the reputation and to the distinctive character of the earlier marks. The opponent therefore requests that the application be refused under s. 5(3).

5. The opponent also claims that the sign "CARRY ON" has been used in the UK since 1958 in respect of "entertainment, TV programmes, films, production of films and TV programmes, distribution of films and TV programmes, marketing of films and TV programmes and licensing". As a result, the opponent says that he owns a protectable goodwill and that use of the contested mark would cause a misrepresentation and damage to the goodwill, resulting in passing off. Consequently, he asks that the application be refused in full under s. 5(4)(a) of the Act.

6. The holder filed a counterstatement denying all of the grounds.

Hearing and representation

7. A hearing was held before me, by videoconference, on 4 October 2023. The opponent was represented by Peter Cornford of Stevens Hewlett & Perkins. The holder chose not to attend. It has been professionally represented in these proceedings by HGF Limited.

Evidence

8. The opponent's evidence consists of two witness statements by Brian Baker, including eighteen exhibits. The second of his statements was filed in reply to the holder's evidence. A good deal of Mr Baker's evidence is concerned with establishing his ownership of the goodwill in the "Carry On" films. I do not understand this to be disputed, so will not mention it further. Mr Baker provides details of the use which has been made of the earlier marks, his plans for merchandise and some evidence going to the issue of similarity between the various goods. Mr Baker has also filed some internet archive evidence showing the holder's website.

9. The holder's evidence consists of a witness statement by Ryan King, who is the chief financial officer for the holder. He gives evidence about the inception of the holder

and says that the holder has been using the "CARRY ON" brand since 2018 with no instances of actual confusion known to it. Mr King does not, however, adduce any documentary evidence of the holder's use of "CARRY ON".

10. Neither witness was cross-examined. I have read all of the evidence and will refer to it as appropriate later in this decision. Both witnesses also gave submissions in their witness statements. I will bear these in mind.

Legislation

11. The provisions of the Act relied upon by the opponent are as follows:

> "**5 Relative grounds for refusal of registration**.
>
> (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.
>
> (2) A trade mark shall not be registered if because—
>
> > (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
> >
> > (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.
>
> (3) A trade mark which—
>
> > (a) 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.

(4) A trademark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented—

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

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.

(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.

[…]

5A Grounds for refusal relating to only some of the goods or services

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."

Relevant date

12. The relevant date for the assessment of the grounds under ss. 5(1), 5(2) and 5(3) is the date of priority of the contested mark, i.e., 11 November 2020. I will return to the matter of the relevant date under s. 5(4)(a) later in this decision.

Proof of use

13. None of the earlier trade marks had been registered for five years at the contested mark's priority date. They are therefore not subject to the provisions at s. 6A of the Act, meaning that all of the goods identified by the opponent may be relied upon for the grounds under ss. 5(1), (2) and (3) without evidence of genuine use.

The ss. 5(1), 5(2)(a) and 5(2)(b) grounds

Approach

14. As is evident from the table of earlier marks at paragraph 2, above, the specification of UK835 covers all of the goods in the specifications of both UK917997624 and UK3408371. As these trade marks are identical and none requires proof of genuine use, neither UK917997624 nor UK3408371 will put the opponent in a better position than UK835. It is also the case that the specification of UK3471679, the only figurative mark among the earlier trade marks, is identical to the specification of UK800. The earlier word mark is not subject to the use provisions and the figurative mark is, by dint of its stylisation, less similar to the contested mark. Any enhanced distinctiveness attributable to the stylisation alone will not increase the likelihood of confusion with the contested mark. Accordingly, if the opposition under UK835 and UK800 fails, it will also fail insofar as it is based upon the remaining earlier marks. It is therefore only necessary to consider the opposition based on UK835 and UK800.

Preliminary issues

15. The holder has made a number of submissions which it is convenient to address at this point. The first is that it says its customer base is "a young adult demographic of people who are active and outgoing and engaged in the alternative sports culture", with its marketing focused on those in the 18-30 age group. It is, however, well

established that when assessing the likelihood of confusion in the context of registering a new trade mark it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered: *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, EU:C:2008:339 at [66]. Consequently, my assessment must take into account only the applied-for mark and its specification and any potential conflict with the earlier trade marks. Any differences between the goods and services provided by the parties, or differences in their trading styles, are irrelevant unless those differences are apparent from the applied-for and registered marks.

16. The holder also seeks to rely on the existence of other marks incorporating the words "CARRY ON" on the UK trade mark register in order to show that such marks can co-exist without a likelihood of confusion. However, in the absence of evidence that such marks are in use this sort of evidence has always been given short shrift. This is because without evidence that the marks are in use on a scale that might have led to confusion, it cannot be shown that the public have become used to distinguishing between them without confusion. There is ample authority to this effect (see, for example, *British Sugar Plc v James Robertson & Sons Ltd ("Treat")* [1996] RPC 281). The mere existence of similar marks on trade mark registers neither increases nor decreases the likelihood of confusion between one such mark and another trade mark in a different ownership. The "state of the register" evidence is therefore of no weight.

Case law

17. Whether there is a likelihood of confusion, relevant for the opposition based upon ss. 5(2)(a) and (b), requires a global assessment. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, EU:C:1997:528, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, EU:C:1998:442, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, EU:C:1999:323, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, EU:C:2000:339, *Matratzen Concord GmbH v OHIM*, Case C-3/03, EU:C:2004:233, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, EU:C:2005:594, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P, EU:C:2007:333, and *Bimbo SA v OHIM*, Case C-591/12P, EU:C:2016:591:

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

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

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

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

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

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

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

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

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

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

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

18. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. This is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Comparison of trade marks

19. The holder denies that the trade marks are identical. It says this because the contested mark appears on the register in the form shown below:

CARRY ON

20. The holder submits that the contested mark is a stylised mark with fluted letters, that this stylisation is different from the earlier marks and that the opposition under s. 5(1) must fail.

21. I reject this submission on three bases. First, this is how the search results for the international registration are displayed on the Word Intellectual Property Organisation ("WIPO") register:

22. As can be seen, the mark is shown in a plain typeface and font and there is no representation in the "image" field. The official request for the extension of protection also indicates that the holder wishes the mark to be considered a mark in standard

characters. For these reasons, I reject the holder's contention that the contested mark is registered in any specific (serif) font. As a plain word mark, it is self-evidently identical to the same earlier plain word mark for the words "CARRY ON".

23. Secondly, even if the contested mark were protected in the specific typeface and font in which it is displayed on the UK register, the earlier marks are word marks. Notional fair use permits use of the earlier marks in any standard typeface/font. This means that notional fair use would permit use of the earlier marks in the identical form to that of the contested mark shown on the UK register.

24. Thirdly, even if the marks are in different typefaces and fonts as submitted by the holder, in *S.A. Société LTJ Diffusion v Sadas Vertbaudet SA,* Case C-291/00, EU:C:2002:27, the Court of Justice of the European Union ("CJEU") held that:

> "54. […] a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer."

25. In my view, the differences between the standard typefaces in which the marks appear on the register are likely to go unnoticed by the average consumer. The marks are identical.

Comparison of goods

26. The goods to be compared are:

Earlier marks	Contested mark
UK3195835 Class 3: Beauty care products; perfumes, cosmetics, make up; hair care preparations; skin care preparations, sun care preparations; nail care products; nail varnishes and nail polishes; powder compacts; lipsticks; lip gloss; nail varnish	Class 3: Lip balm holders, lipstick holders. Class 9: Cases for holding digital devices, namely, cell phone cases, tablet cases, and laptop cases; protective

remover; cotton wool balls for use in removing and applying cosmetics; make-up pads; make-up powder and foundation; facial wipes impregnated with cosmetics; moisturisers; beauty care preparations, body care preparations, essential oils for personal use; soaps; antiperspirants; after shave lotions; eau de cologne; soaps; preparations and products for removing make-up; toiletries; eau de toilette; antiperspirants; deodorants for personal care; hair care preparations; skin care preparations; lotions, creams and conditioners; shampoos; conditioners; beauty masks; cream, masks, oil, powder and scrubs; hand and body lotions; dentifrices; shaving preparations, dyes for hairs; bath preparations, namely, beads, crystals, foam, gels, oil and powder; scented body sprays; after-shave lotions; pre-electric shaving preparations. Class 6: Chains for keys; figurines; key rings. Class 9: Sound, video and data recording and reproducing apparatus; computer software; computer games; video games; CD Rom games; games cartridges for use with electronic games apparatus; sound and video recordings; cinematographic and photographic films;	cases for audio equipment, namely, headphone cases, and earbud cases. Class 14: Watch wrist bands; key chains; lanyards for holding keys. Class 18: Wallets; cross-body bags, belt bags, fanny packs; lanyards for holding wallets. Class 25: Clothing, namely, shirts, hats, and belts.

motion picture films; sunglasses; eyewear; instructional and teaching apparatus and instruments; records, discs, tapes, cassettes, cartridges, audio video disks, DVDs; cards and other carriers, all bearing or for use in bearing sound recordings, video recordings, data, images, games, graphics, text, programs or information; pre-recorded DVDs, CDs, video tapes and laser disks featuring images and/or sound; interactive multimedia computer programs and software; interactive audio visual works, including those distributed online; software linking digital video and audio media to a global computer information network; memory carriers, interactive compact discs and CD-ROMs; parts and fittings for all the aforesaid goods. Class 25: Clothing; footwear; headgear. <u>UK3377800</u> Class 3: (all goods in class) Detergents; preparations and substances for laundry use; fabric conditioning preparations; bleaching preparations; cleaning, polishing, scouring and abrasive preparations; preparations for dishwashing purposes; soaps; deodorants for personal use; hand washes; tissues impregnated with	

preparations and substances for cleaning and polishing; multi-use liquid cleaning preparations; detergents in powder form for domestic use; washing and bleaching preparations and other substances for laundry use.	

27. The opponent's best case is that based on UK835. That is where I will start.

28. In the judgment of the CJEU in *Canon*, the court stated at paragraph 23 that:

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

29. The factors identified by Jacob J. (as he then was) in *Treat* as relevant for assessing similarity are:

> (a) The respective uses of the respective goods or services;
>
> (b) The respective users of the respective goods or services;
>
> (c) The physical nature of the goods or acts of service;
>
> (d) The respective trade channels through which the goods or services reach the market;
>
> (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
>
> (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance

whether market research companies, who of course act for industry, put the goods or services in the same or different sectors."

30. "Complementary" means that "[…] there is a close connection between [the goods/services], 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": *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)***,** Case T-325/06, EU:T:2008:338.

31. In *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T-133/05, EU:T:2006:247, the General Court ("GC") stated that:

> "29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark."

Class 3

32. The opponent submits that lip balm holders are identical to "beauty care products", contained in UK835's specification, or, in the alternative, complementary to them.[1] In my view, the average consumer would construe "beauty care products" as products themselves intended for beauty care, such as lip balms and lipsticks, but would not consider lip balm holders or lipstick holders to be beauty care products. Their nature, purpose and methods of use differ, one being a preparation for application to the lip, the other the receptacle for the preparation. However, users are the same, the goods are complementary in the sense described in the case law, and they are likely to coincide in both channels of trade and manufacturer. They are similar to a medium degree.

[1] The opponent's submissions on the similarity of goods are at Baker 1, §28.

Class 9

33. The opponent says that the contested goods in class 9 overlap with “sound, video and data recording and reproducing apparatus” in UK835’s specification.

34. It seems to me that “data recording and reproducing apparatus” is a very wide term which would cover computing devices such as smartphones, tablet computers and laptops. These goods have the same users as the contested “cases for holding digital devices, namely, cell phone cases, tablet cases, and laptop cases”, the goods will be sold through the same channels, originate from the same manufacturer and be complementary. They are similar to a medium degree.

35. I agree with the opponent that “sound reproducing apparatus” includes headphones and earbuds. These differ from “protective cases for audio equipment, namely, headphone cases, and earbud cases” in nature, purpose and method of use. I accept, however, that manufacturers of headphones and earbuds will also manufacture cases for these goods, which may be sold as accessories or spare parts. The goods share users and channels of trade and they are complementary. They are similar to a medium degree.

Class 14

36. The opponent’s position is that “watch wrist bands; key chains, lanyards for holding keys” are identical or complementary to “chains for keys” and “key rings” as both parties’ goods are means of wearing keys on the person. He also submits that watch wrist bands are for wear on the person, like clothing, and that “brand ‘cross over’ from clothing into watches is commonplace”.

37. Beginning with “watch wrist bands”, these goods are components of watches which allow a watch to be secured on a person’s wrist. This purpose is different from that of clothing which, although also worn on the person, is intended to cover the body. The nature of the goods is different; any overlap in method of use is confined to the fact that both are worn. I accept that watches and clothing belong to adjacent market sectors and that they may both be sold by, for example, large clothing retailers (the

examples in evidence include NEXT and Marks & Spencer).[2] However, the contested goods are watch parts, not complete watches. These goods generally reach the market through distinct trade channels. Nor are "watch wrist bands" complementary to clothing. Whilst both may be chosen for their aesthetic appeal, watch wrist bands and clothing are not normally selected in order to coordinate with one another. The goods are not competitive and whilst they will be used by the general public, this is a point of intersection at a very high level of generality. These goods are dissimilar. I cannot see any other goods in the opponent's specification which would be closer to "watch wrist bands".

38. Before comparing the contested "key chains" with the earlier mark's specification, it is necessary to consider precisely which goods are protected in class 6 of the earlier mark. The opponent's submission proceeds on the basis that the goods are identical because they are both key chains/key rings. However, the specifications at issue are in different classes. In *Pathway IP Sarl (formerly Regus No. 2 Sarl) v Easygroup Ltd (formerly Easygroup IP Licensing Limited),* [2018] EWHC 3608 (Ch), the late Carr J considered the judgments of the High Court in *Omega 1* [2010] EWHC 1211 (Ch) and *Omega 2* [2012] EWHC 3440 (Ch) and reached the provisional view that it is appropriate to use class number as an aid to interpretation of the specification where the words used in the specification lack clarity and precision. In particular, the judge stated that where "the words chosen may be vague or could refer to goods or services in numerous classes [of the Nice classification system], the class may be used as an aid to interpret what the words mean with the overall objective of legal certainty of the specification of goods and services". One example of goods corresponding to the same description which could appear in multiple classes is, notoriously, valves, which appear in many different classes depending on their function and/or composition (e.g., cardiac valves, radiator valves, valves for musical instruments). By contrast, if "ballet slippers" appeared in class 13 of a specification (the class heading of which is "firearms; ammunition and projectiles; explosives; fireworks"), there would be no uncertainty over the goods which were meant by the term and no doubt that they had simply been misclassified.

[2] BFB16.

39. The class heading for class 6 includes, and included in 2016 when the earlier mark was filed, so far as relevant to this decision, “common metals and their alloys” and “small items of metal hardware”. “Chains of metal” were, and are, proper to class 6, though metal chains may also be classified elsewhere according to their nature and/or use (e.g., chains of precious metal; chains [jewellery] in class 14 and bicycle chains in class 12). I also note that “safety chains of metal” were and are proper to class 6 and that, whilst “key chains” are proper to class 14, the full entry in the 2016 Nice classification alphabetical list for class 14 reads “key chains [trinkets or fobs]”. I further bear in mind that the *Oxford English Dictionary* defines “key chain” as “[a] chain for carrying keys. In later use also: a key ring, *esp.* one with a fob connected to the ring itself by a chain”.[3] I therefore accept that “key chain” may be used synonymously with “key ring” in common parlance. However, as *Pathway* suggests, where there is ambiguity about a term in a specification, the class may be used to assist interpretation. In the present case, it seems to me that the Nice classification deliberately delimits the protection as between goods in classes 6 and 14, meaning that goods in class 14 are key rings with fobs or other decorative attachments, while class 6 would cover chains for keys that are, literally, chains, such as the chains for keys used by prison officers. Protection in class 6 does not, however, extend to “key chains” used in the loose sense of “key rings”.

40. The purpose of “key chains” in both class 6 and class 14 overlaps, since both may be intended to keep several keys together. They have a similar nature, as both will include a ring and possibly a metal chain of varying length. There will be similarity in their method of use and their users. Channels of trade may intersect and the goods are potentially competitive but they are not complementary. They are highly similar overall.

41. The same qualification, i.e., “[trinkets or fobs]” is shown in the alphabetical list for “key rings” in class 14. It therefore seems to me that “key rings” in class 6 means split rings, or similar, of common metal which may used to hold keys together but which do not feature additional decorative elements. The opponent is in no better a position based on “key rings” in class 6.

[3] https://www.oed.com/dictionary/key-chain_n?tab=meaning_and_use#40130865 [accessed 20 May 2024].

42. The contested “lanyards for holding keys” coincide in purpose with “chains for keys” but there are differences in nature and method of use, as lanyards are fabric and worn around the neck, in distinction from chains for keys. Users of the goods may overlap and channels of trade may be shared, though it is likely that lanyards and chains would be in distinct sections of retail or online shops. There is potential for competition but these goods are not complementary. They are similar to a medium degree.

Class 18

43. The opponent says that the contested goods are similar to “chains for keys”, “key rings”, “various items of stationery and bags” and “clothing”. He submits that “Clothing brand manufacturers brand-extend to leather goods, bags and wallets and so the Applicant’s goods are complementary with the Opponent’s clothing”. The opponent’s evidence includes website prints showing goods such as bum bags, wallets, key fobs and cross-body bags for sale (none is dated).[4]

44. The first point to note is that “various items of stationery and bags” are not relied upon so no comparison can be made between these goods.

45. As regards the contested “wallets; cross-body bags, belt bags, fanny packs”, the GC has considered on a number of occasions whether certain goods in class 18 are similar to “clothing”. In *El Corte Inglés SA v OHIM (PiraÑAM)*, Case T-443/05, EU:T:2007:219, the GC considered whether “clothing, footwear, headgear” in class 25 was similar to “Leather and imitations of leather goods not included in other classes”. It held that the competing goods are often made of the same raw material, namely leather or imitation leather and that that fact may be taken into account when assessing the similarity between the goods. However, given the wide variety of goods which can be made of leather or imitation leather, that factor alone was not sufficient to establish that the goods are similar ([42] of the judgment). The GC held that:

> “45. On the other hand, as regards the first group of goods in class 18, namely leather and imitation leather goods not included in other classes such as, for example, handbags, purses or wallets, it should be noted that those goods are

[4] BFB17.

often sold with goods in class 25 at points of sale in both major retail establishments and more specialised shops. That is a factor which must be taken into account in assessing the similarity of those goods".

46. The GC said that there was a "slight similarity" between all of the goods in class 25 and the leather and imitation leather goods in class 18 on this basis. It then considered whether the goods are complementary:

> "49. Goods such as shoes, clothing, hats or handbags may, in addition to their basic function, have a common aesthetic function by jointly contributing to the external image ('look') of the consumer concerned.
>
> 50. The perception of the connections between them must therefore be assessed by taking account of any attempt at coordinating presentation of that look, that is to say coordination of its various components at the design stage or when they are purchased. That coordination may exist in particular between clothing, footwear and headgear in class 25 and the various clothing accessories which complement them such as handbags in class 18. Any such coordination depends on the consumer concerned, the type of activity for which that look is put together (work, sport or leisure in particular), or the marketing strategies of the businesses in the sector. Furthermore, the fact that the goods are often sold in the same specialist sales outlets is likely to facilitate the perception by the relevant consumer of the close connections between them and strengthen the perception that the same undertaking is responsible for the production of those goods.
>
> 51. It is clear that some consumers may perceive a close connection between clothing, footwear and headgear in class 25 and certain 'leather and imitations of leather, and goods made of these materials and not included in other classes' in class 18 which are clothing accessories, and that they may therefore be led to believe that the same undertaking is responsible for the production of those goods. Therefore, the goods designated by the mark applied for in class 25 show a degree of similarity with the clothing accessories included in 'leather and imitations of leather, and goods made of these materials and not included in other classes' in class 18 which cannot be classified as slight."

47. In 2013, the GC gave judgment in *Gitana SA v OHIM*, Case T-569/11, EU:T:2013:462, which again held, for very similar reasons, that various items of clothing, footwear and headgear in class 25 were similar to "goods made of leather and imitations of leather and not included in other classes" in class 18.

48. However, in *Asos Plc v OHIM*, Case T-647/11, EU:T:2014:230, the GC upheld a decision by the OHIM (now EUIPO) Fourth Board of Appeal that there was no similarity between, on the one hand, clothing, footwear and headgear and, on the other hand, "bumbags; sports bags; casual bags; briefcases; attaché cases; satchels; beauty cases; credit card cases and holders; wallets; purses". The GC said:

> "45. It is apparent from the case-law that goods such as shoes, clothing, hats or handbags may, in addition to their basic function, have a common aesthetic function by jointly contributing to the external image ('look') of the consumer concerned. The perception of the connections between them must therefore be assessed by taking account of any attempt at coordinating presentation of that look, that is to say, coordination of its various components at the design stage or when they are purchased. That coordination may exist in particular between clothing, footwear and headgear in Class 25 and the various clothing accessories which complement them, such as handbags in Class 18 (*PiraÑAM diseño original Juan Bolaños*, cited in paragraph 15 above, paragraphs 49 and 50).
>
> 46. In the present case, in the contested decision, the Board of Appeal held that the 'bumbags; sports bags; casual bags; briefcases; attaché cases; satchels; beauty cases; credit card cases and holders; wallets; purses' in Class 18 — contrary to the 'clothing, footwear, headgear' in Class 25, which had an aesthetic function — essentially had a practical function, namely that of containing sports equipment, documents, banknotes and coins, are not perceived as part of the external image, have no aesthetic function and are not included in the marketing strategy for fashion accessories. The Board of Appeal consequently held that the abovementioned goods, coming within Class 18, were not complementary to 'clothing, footwear, headgear' in Class 25. It added that it was unlikely that, when buying a briefcase or a wallet, the purchaser

would be asked about the colour of the suits or shoes normally worn or, when buying a sports bag, the colour of his tracksuit.

47. That appraisal by the Board of Appeal must be upheld.

48. Firstly, the ‘bumbags; sports bags; casual bags; briefcases; attaché cases; satchels; beauty cases; credit card cases and holders; wallets; purses’ in Class 18, unlike the ‘clothing, footwear, headgear’ in Class 25, have an essentially utilitarian function and not an essentially aesthetic function. There is therefore no reason for the consumer to coordinate them with the ‘clothing, footwear, headgear’ in Class 25. In contrast to handbags, coming within Class 18, the goods at issue in Class 18 do not contribute to the external image of consumers.

49 Secondly, the purchase of the goods at issue in Class 18 is viewed independently from the purchase of ‘clothing, footwear, headgear’ in Class 25. The average consumer will purchase ‘bumbags; sports bags; casual bags; briefcases; attaché cases; satchels; beauty cases; credit card cases and holders; wallets; purses’ without worrying about the concomitant possession or purchase of ‘clothing, footwear, headgear’ in Class 25. Conversely, for the average consumer, the decision to buy ‘clothing, footwear, headgear’ in Class 25 is generally not influenced by, or subject to, the purchase or possession of the goods at issue in Class 18.

50. It follows that the ‘bumbags; sports bags; casual bags; briefcases; attaché cases; satchels; beauty cases; credit card cases and holders; wallets; purses’ in Class 18 cannot be considered to be clothing accessories.

51. In addition, even if the goods at issue in Class 18 were to share with the goods at issue in Class 25 the same distribution channels and have the same end users, that would not suffice for the conclusion that there is a similarity between those goods. Lastly, the intervener’s argument that those goods in Class 18 and the ‘clothing, footwear, headgear’ in Class 25 are generally produced by the same manufacturer has not been substantiated.”

49. Despite the different conclusions, both decisions agree that complementarity regarding these goods concerns the coordination of different elements of an outfit to achieve an overall "look", resulting in the clothing and accessories being considered the responsibility of the same undertaking. Whatever the position may have been in the EU in 2014, my view is that in the UK by November 2020 the average consumer would not simply have chosen bags such as bum bags and cross-body bags for functionality but would consider the aesthetic features of these accessories as an important part and an enhancement of their overall "look", in this instance being casual- or leisurewear. The relationship is close enough to give rise to a complementary relationship. These goods have shared distribution channels and a common manufacturer. "Cross-body bags, belt bags, fanny packs" are similar to clothing to a medium degree.

50. I am doubtful that "wallets" are complementary to clothing. There is no evidence on the point. It seems to me that wallets are not typically chosen to enhance the aesthetic effect of a particular outfit, since they are generally carried in pockets and not visible to either the user or others. The respective goods will share users, manufacturer and distribution channels. "Wallets" have a low degree of similarity to clothing.

51. There is no obvious point of similarity between the contested "lanyards for holding wallets" and clothing. I do not accept the opponent's submission that the mere fact that lanyards are "small items for wear about the person or for carrying items by the person" would make these goods similar to clothing. The goods differ in nature, purpose and method of use. There is no reason to believe that these goods are typically either sold through the same outlets or that they have a common manufacturer. Lanyards are largely functional items which will be chosen on that basis. I do not consider that these goods are complementary: it would, in my view, be stretching the concept too far, absent clear evidence to the contrary, to suppose that consumers would choose a lanyard for their wallet based on its ability to set off their outfit as a whole. These goods are not similar.

52. As regards "lanyards for wallets" against the earlier mark's "chains for keys" in class 6, the goods differ in nature, as one is metal and the other is not. They are intended for holding different items, although they coincide in purpose to the extent

that both are for attaching small items to the user. Lanyards are typically worn around the neck, whilst chains for keys are attached to a belt or belt loop. There may be overlap in trade channels. Given the different nature of the raw materials, it is unlikely that the same manufacturers would produce these goods. They are not complementary. As their intended uses differ they are not in direct competition, though a lanyard intended for a wallet could easily be used for keys so substitution is possible. The opponent has referred to the goods at issue in class 18 being similar to the earlier mark's goods because they may be "small gifting accessories". I am not persuaded that this is a relevant point of similarity since whether something is given as a gift is highly subjective and not a clearly identifiable characteristic of the goods themselves. These goods are similar to a low degree.

Class 25

53. The contested "clothing, namely, shirts, hats, and belts" are encompassed by the earlier mark's "clothing; headgear". These goods are identical on the basis outlined in *Meric*.

Final remarks on similarity

54. I cannot see any basis upon which any of the goods in UK800 would be similar to any of the contested goods. None has been proffered. The only possible point of similarity is that the users are the general public which is, on its own, insufficient. None of the goods under UK800 is similar to the contested mark's goods and the opposition under ss. 5(1) and 5(2)(a) is dismissed insofar as it is based upon this mark. For completeness, the opposition under s. 5(2)(b) based on UK3471679 would fail for the same reason.[5]

Average consumer and the nature of the purchasing act

55. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect: *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox*

[5] Some similarity between the goods/services is required for an opposition based upon ss. 5(2)(a)/(b) to succeed: *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU).

Limited, [2014] EWHC 439 (Ch). For the purposes 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*.

56. Mr Cornford submitted that the average consumer of the goods at issue is a non-specialist purchaser and a member of the general public at large. He submitted that the goods will be self-selected from high street shops or online and that the consumer will pay a medium degree of attention. I accept that submission. Although some of the goods will be of low value (e.g., lanyards), even these are not the most casual of purchases. Some attention will be paid to, for example, style, design and/or fit. The purchasing process is likely to be predominantly visual, though I do not discount that there may be an oral element, for example through requests to sales assistants.

Distinctive character of the earlier trade mark

57. 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 *WindsurfingChiemsee 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)."

58. The words "CARRY ON" form an ordinary English phrase. They are inherently distinctive to no more than an average (medium) degree. Although Mr Baker says that merchandise has been produced, there is no evidence at all of sales or advertising in relation to the goods at issue. The evidence is wholly inadequate to establish enhanced distinctiveness.

Conclusions on ss. 5(1) and 5(2)(a)

59. The marks are identical. The goods in class 25 of the respective marks are also identical. The opposition succeeds under s. 5(1) in relation to class 25.

60. Turning to s. 5(2)(a), whether there is a likelihood of confusion is a global assessment, which must take into account all of the relevant factors. I remind myself that the likelihood of confusion must be determined from the perspective of the average consumer, who will rely on their imperfect recollection of the trade marks. The factors considered above are interdependent and, for example, a greater degree of similarity between the trade marks may be offset by less similarity between the goods.

61. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'".

62. If there is no similarity between the goods, there can be no likelihood of confusion under s. 5(2)(a). The opposition fails in relation to "watch wrist bands" in class 14.

63. The remaining goods have degrees of similarity ranging from low to high. The earlier mark is averagely distinctive and the average consumer will pay a medium degree of attention to what is primarily a visual purchase. In my view, there is a likelihood of direct confusion for all of the similar goods. The identity between the marks means that the average consumer has no means of distinguishing between the marks, despite their medium level of attention. Even where the goods are only similar to a low degree, they are not so low in similarity that the consumer would conclude that the undertakings using the identical marks are different. The opposition under s. 5(2)(a) succeeds for all of the similar goods.

64. In summary, the opposition under ss. 5(1) and 5(2)(a) is successful in relation to the following goods:

Class 3: Lip balm holders, lipstick holders.

Class 9: Cases for holding digital devices, namely, cell phone cases, tablet cases, and laptop cases; protective cases for audio equipment, namely, headphone cases, and earbud cases.

Class 14: Key chains; lanyards for holding keys.

Class 18: Wallets; cross-body bags, belt bags, fanny packs; lanyards for holding wallets.

Class 25: Clothing, namely, shirts, hats, and belts.

The s. 5(3) grounds

65. As the opposition under ss. 5(1) and 5(2)(a) has succeeded against all of the goods apart from "watch wrist bands", it is only necessary to consider these goods, along

with “hand sanitizer holders” which were not opposed under ss. 5(1) or 5(2). The provisions of s. 5(3) are set out at paragraph 11, above.

66. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, EU:C:1999:408, *General Motors* [1999] ETMR 950; Case 252/07, EU:C:2008:655 *Intel,* [2009] ETMR 13; Case C-408/01, EU:C:2003:582, *Adidas-Salomon,* [2004] ETMR 10; and C-487/07, EU:C:2009:378, *L'Oréal v Bellure* [2009] ETMR 55; Case C-323/09, EU:C:2011:604, *Marks and Spencer v Interflora*; and Case C-383/12P, EU:C:2013:741*, 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'Oréal 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'Oréal 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'Oréal 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'Oréal v Bellure).*

Reputation

67. In *General Motors,* the CJEU gave the following guidance for the assessment of a trade mark's reputation:

> "25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.
>
> 26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.
>
> 27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.
>
> 28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

68. The opponent asserts a reputation in classes 3, 6, 9 and 25 across all of its marks. In its counterstatement, the holder says that "[the] Opponent, by its own admission, states that the name CARRY ON is well known in relation to a franchise of British comedy films. It is denied that any alleged reputation extends beyond those series of films, and certainly does not extend to any of the goods covered by the [holder's] mark". This appears to be an admission that the earlier marks have a reputation for "motion picture films", where they are registered for these goods, but not otherwise. I proceed on that footing.

69. There is no evidence of a single sale of any of the remaining goods relied upon. Nor is there any evidence of marketing or promotion of any kind. The evidence signally fails to establish a reputation in respect of any of these goods.

70. In view of my findings on reputation, and for the reasons explained at paragraph 14, above, it is only necessary to consider the remainder of s. 5(3) objection based on UK835.

Link

71. Whether the relevant public will make the required mental 'link' between the marks must take account of all relevant factors. The factors are identified in *Intel* (see paragraph 66(d), above). I have considered most of these points already and adopt my earlier findings. For convenience, I will set them out as appropriate below.

The degree of similarity between the conflicting marks

72. The marks are identical.

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

73. Other than an overlap in users, the goods differ in every material respect. They are dissimilar. Nevertheless, there are degrees of dissimilarity. For example, t-shirts may belong to a different market sector from films but due to their commonly being sold as film merchandise, they are not totally unrelated. This is not the case for watch wrist bands and hand sanitiser holders, which are in completely distinct market sectors from films.

74. The average consumer of the goods is a member of the general public who will pay a medium degree of attention. This is because the goods are general consumer goods, which are likely to be fairly inexpensive and/or frequent purchases but consideration will be given to aesthetic appeal, function (capacity to fit a watch face), genre and/or age suitability. The selection of the contested goods will be from the shelves of retail premises or their online equivalents. Films on physical media such as DVDs will be selected in the same way. All of the goods are liable to be advertised in print (e.g., newspapers and magazines) and potentially on advertising hoardings. These factors result in the selection being predominantly visual, though there may be an aural aspect to the purchase.

The strength of the earlier mark's reputation

75. Whilst the holder accepts that the earlier mark has a reputation for films, it has not made any comments about the strength of the earlier mark's reputation, which I must assess. The evidence is that the "CARRY ON" franchise was a series of 31 low budget British comedy pictures created in the period from 1958 to 1992.[6] There were four Christmas specials between 1969 and 1973, a thirteen-episode television series in 1975 and "various West End stage shows which later toured the regions".[7] This is supported by posters advertising the films from the period.[8] In 2002, attempts began to produce another "CARRY ON" film ("Carry On London"), which failed some time after 2008, though it appears that there have been some continuing discussions about the franchise's revival.[9] Mr Baker asserts, without evidence, that "there has long been an enormous appetite amongst the public that the franchise should continue". His evidence is that ITV "continues to broadcast the films on a weekly basis and has done so over the past two decades".[10] In evidence are twenty-two articles which are about or reference "CARRY ON" films.[11] They are dated between 2003 and 2006. Most are from national publications and appear to have been prompted by news of the mooted "Carry On London" film. The franchise is occasionally referred to as an "institution" and one article from *OK* magazine dated 2003 says that the "CARRY ON" films are "one of cinema's most successful and fondly regarded film series". Another article, also from 2003, says that thirteen of the films will be released on DVD, "bringing the films to a younger audience" and refers to the films' "Sixties heyday"; yet another says that "this film will certainly please the faithful fans but also appeal to a young new audience unfamiliar with the legacy of Carry On". The most recent evidence of promotion is dated 3 July 2019 and comprises an article and cartoon concerning the new film, plus a comments page which includes some references to the film, all from the *Daily Star*.[12] The article describes "CARRY ON" films as a "legendary comedy franchise". Narrative

[6] Baker 1, §4.
[7] Baker 1, §5.
[8] BFB1, Baker 1, §6.
[9] Baker 1, §§6, 15-17, 19-24.
[10] Baker 1, §20.
[11] BFB9.
[12] BFB10

evidence refers to a *Today* radio piece in September 2019 and an interview by Mr Baker to GWR FM (a West Country radio station) but nothing further is provided.[13]

76. The evidence is not compelling. It may be that ITV continues to broadcast "CARRY ON" films regularly but there is no information about income generated by this, which ITV channel broadcasts the films, what time of day they are broadcast or viewing figures. There is no evidence of any revenue at all from the sale of the films. The articles from 2003 to 2006 do suggest that the "CARRY ON" films were very popular in their time and continued to have a level of recognition in 2006. However, they also appear to recognise that there is a younger part of the public which is not familiar with the franchise. The evidence of more recent promotion is very limited but it does refer to "CARRY ON" films as "legendary", without explaining to readers what the films are. Despite the weak evidence, it appears that the CARRY ON films enjoyed a high degree of reputation in the past and that even though the absence of use in recent decades is likely to have diminished that reputation, particularly for younger generations, a certain surviving reputation existed at the relevant date among a significant part of the public. I find, not without reservations, that at the relevant date the mark "CARRY ON" had a reasonable reputation among a significant part of the relevant public for motion picture films.

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

77. The earlier mark is inherently distinctive to a medium degree. For essentially the same reasons as above, the fame of the original films which were released over a long period and whose notoriety appears to endure is likely to mean that, for a significant part of the public, the mark has an above average level of distinctive character for motion picture films.

Whether there is a likelihood of confusion

78. Although the earlier mark has a reasonable surviving reputation and an above average level of distinctive character for films, that is largely based on a reputation garnered many years ago. I do not think that the average consumer would believe that

[13] Baker 1, §22.

the dissimilar goods at issue are the products of the same or economically connected undertakings. The reputation is not strong enough to convey that message across the divide between wholly different areas of business.

Conclusion on link

79. Taking all of the above into account, I find that the relevant public would not have made the link between the respective marks at the relevant date. Although the marks are identical and the earlier mark had a reasonable reputation and some enhanced distinctiveness for a part of the public, the goods are in different sectors entirely. I do not consider that the residual reputation of the mark “CARRY ON” for films would be sufficient to bridge the gap between the dissimilar goods.

80. Absent the requisite link, the opposition based upon s. 5(3) fails.

Unfair advantage/detriment to reputation or distinctive character

81. I would add that, even had I found that a section of the public would make a link, I would have rejected the opposition under s. 5(3) because:

(a) any link would have been weak;

(b) the use of the identical mark “CARRY ON” in relation to the goods at issue would be seen by the public as a mere coincidence;

(c) there does not appear to be anything about the image associated with the earlier mark for motion picture films which would readily transfer to the goods at issue;

(d) In the light of (a) to (c) it is unlikely that there would be any economic consequences, either increasing sales under the contested mark, or reducing sales under the earlier mark, if a section of the public were to make a mental link between the marks.

The s. 5(4)(a) grounds

82. I will again focus on the goods for which the opposition has so far failed, namely "hand sanitizer holders" and "watch wrist bands".

83. In *Reckitt & Colman Products Limited v Borden Inc. & Ors* [1990] RPC 341 HL, Lord Oliver of Aylmerton described at [406] the 'classical trinity' that must be proved in order to reach a finding of passing off:

> "First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of the plaintiff. Thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff."

84. The holder says that it has been using its "CARRY ON" brand since 2018. Concurrent user was not part of the pleaded case but the holder has, in any event, filed no evidence of use. Mr Baker filed prints from the Wayback Machine internet archive of the website www.threadwallets.com which are dated between December 2019 and August 2020. Although these show some use of "CARRY ON", there is nothing to indicate that this is use in the UK; on the contrary, where prices are shown, they are in dollars, which points to the website being directed at consumers elsewhere in the world. The relevant date is, therefore, the priority date, i.e., 11 November 2020.[14]

[14] See *Advanced Perimeter Systems Limited v Multisys Computers Limited,* BL O/410/11 at [43].

Goodwill

85. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HL), the House of Lords defined goodwill as follows:

> "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."

86. The holder has accepted that the opponent has a reputation in relation to comedy films but has denied that it has goodwill in any of the goods relied upon, which include films. Those two positions appear to me to be inconsistent. A reputation requires more extensive knowledge of a trade mark on the part of the average consumer than is required for goodwill: it is well established that the law of passing off will protect a small goodwill, provided that the goodwill is not so small it is trivial.[15] It is also possible for a sign to enjoy "residual" goodwill. In *Ad Lib Club Limited v Granville* [1971] FSR 1 (HC), Vice Chancellor Pennycuick stated that:

> "It seems to me clear on principle and on authority that where a trader ceases to carry on his business he may nonetheless retain for at any rate some period of time the goodwill attached to that business. Indeed it is obvious. He may wish to reopen the business or he may wish to sell it. It further seems to me clear in principle and on authority that so long as he does retain the goodwill in connection with his business he must also be able to enforce his rights in respect of any name which is attached to that goodwill. It must be a question of fact and degree at what point in time a trader who has either temporarily or permanently closed down his business should be treated as no longer having any goodwill in that business or in any name attached to it which he is entitled to have protected by law."

[15] *Hart v Relentless Records* [2002] EWHC 1984 (Ch). Two examples of cases where a small goodwill was protectable are *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590 and *Stannard v Reay* [1967] FSR 140 (HC).

87. I am therefore doubtful that, having accepted a reputation for films, it is open to the holder to deny goodwill for the same sign for the same goods at the same date. Regardless of this, and notwithstanding my criticisms of the evidence, above, references in the newspaper articles in evidence to “CARRY ON” films as a British “institution” and “legendary” suggest that they were very famous in the past. One of these articles is dated July 2019. This suggests a continuing reputation which, having been built through the release of films over thirty-four years and kept alive, if more fragile, for another twenty-seven years, is unlikely to have dissipated completely by the relevant date some sixteen months later. Taking the admission of a reputation and the above evidence into account, I find that there was a subsisting residual goodwill in relation to films at the relevant date, of which the sign “CARRY ON” was distinctive. The evidence is inadequate to establish goodwill in respect of any other goods or services.

Misrepresentation

88. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

> “There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341 at page 407* the question on the issue of deception or confusion is
>
> > “is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product].”

89. The opponent’s claim of passing off fails here. The goodwill subsisting in the sign for films is not extensive enough to bridge the gap between the goods, which are in entirely separate fields of activity. I find that it is unlikely that consumers of the opponent’s films would be misled by the use of “CARRY ON” as a trade mark in relation to “watch wrist bands” and “hand sanitizer holders”. The opposition under s. 5(4)(a) against these goods fails.

Overall conclusion

90. The opposition has succeeded in part and the request for protection will be refused save in relation to the following goods:

Class 5: Hand sanitizer holders.

Class 14: Watch wrist bands.

Costs

91. The opponent has been more successful than the holder and is entitled to an award of costs on the standard scale (Tribunal Practice Notice 2/2016 refers) to reflect the partial success. I bear in mind that the evidence was light and the holder's evidence in particular very thin. I also bear in mind that the opponent relied on several trade marks but that there was substantial duplication. This was exacerbated by the opponent's decision to list in the statement of case all of the goods relied upon for each mark and under each ground, rather than simply indicating that he relied upon all goods in classes 3, 6, 9 and 25. It will have taken the holder time, as it took me time, to cross-check the specifications relied upon between the marks and the grounds. I award the opponent £1,800 as a contribution towards the cost of the proceedings, calculated as follows:

Filing and considering the pleadings:	£200
Filing and considering evidence:	£700
Preparation for and attendance at hearing:	£700
Official fees:	£200
Total:	**£1,800**

92. I order Thread Wallets LLC to pay Brian Baker the sum of £1,800. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 5th day of June 2024

Heather Harrison

For the Registrar