

O/0582/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3975131

BY RETRAZE CO., LTD.

TO REGISTER:

ReTraze Aqua- It's Dope!

AS A TRADE MARK IN CLASSES 18, 22, 23, 24, 25

AND

IN THE MATTER OF THE OPPOSITION THERETO

UNDER NO. 444863 BY

RDSTR IP 2 AB

BACKGROUND AND PLEADINGS

1. On 3 November 2023, RETRAZE CO., LTD. (“the applicant”) applied to register **ReTraze Aqua- It’s Dope!** as a trade mark in the United Kingdom in respect of goods in Classes 18, 22, 23, 24 and 25. A full list can be found in the table in paragraph 23 of this decision.

2. On 21 December 2023, the application was opposed by RDSTR IP 2 AB (“the opponent”). The opposition was based on sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”) and concerns all the goods in the application. The opponent relies on the following two marks and the goods listed:

UKTM No. 911518313 (“the 313 mark”)

DOPE

Filing date: 25 January 2013

Registration date: 21 June 2013

Class 25

Clothing, footwear, headgear; shirts, hoodies, jersey shirts; vests; sweaters; braces for clothing; collars (clothing); underwear; clothing; sweat absorbent underwear; clothing apparel; outerwear; jackets; (other than for protection against accidents and injuries); headbands (clothing); clothing of imitations of leather; clothing of leather; t-shirts; camisoles; hats; caps; shirts; socks; beach wear; gloves (clothing); gloves (other than for protection against accidents and injuries); sports headgear (other than helmets); pants; jeans; tights; shorts; swimwear; shorts; footwear for use in snowboarding and skiing; sports and leisure shoes and boots.

UKTM No. 3628891 (“the 891 mark”)

DOPE

Filing date: 19 April 2021.

Priority date: 20 November 2020.¹

Registration date: 22 October 2021.

Class 18

Bags; Sports packs; Kit bags; Backpacks; Toiletry bags; Pocket wallets; Key cases; Umbrellas.

3. Both marks qualify as earlier marks under section 6(1) of the Act by virtue of their earlier filing dates. The 891 mark was registered less than five years before the application date of the contested mark and so the opponent is not required to prove that it has used this mark. It may therefore rely on all the goods listed in Class 18. The 313 mark was registered more than five years before the application date and the opponent has stated that it has used the mark for all the goods relied upon.

4. Under section 5(2)(b), the opponent claims that the marks are similar and that the goods covered by the marks are either identical or similar. Consequently, it claims that there exists a likelihood of confusion on the part of the relevant public in the UK.

5. The section 5(3) ground was dropped during the evidence rounds.²

6. The applicant filed a defence and counterstatement denying the claims made and put the opponent to proof of use of the 313 mark.

7. Only the opponent filed evidence. This comes from Elin Glommen, Chief Executive Officer of RDSTR IP 2 AB and Ridestore AB. She has held this position since January 2024. Her witness statement is dated 3 June 2024 and is accompanied by two exhibits. The evidence goes to the use made of the 313 mark. The opponent also filed written submissions with the evidence.

¹ Priority is claimed from EUTM No. 018342165. As this application was pending on IP completion day, the opponent had a period of nine months until 30 September 2021 in which it could file an application for a UK trade mark and retain the EU priority date.

² Written submissions, paragraph 6.

8. Neither side requested a hearing. The opponent filed written submissions in lieu of such on 9 September 2024.

9. In these proceedings, the opponent is represented by Morgan, Lewis & Bockius UK LLP and the applicant is represented by Jinxu Jia.

RELEVANCE OF EU LAW

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

DECISION

Proof of Use

11. 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.

...”

12. As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It is 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.”

13. The relevant date in these proceedings is 3 November 2023 and the five-year period in which use must be shown is 4 November 2018 to 3 November 2023. As the 313 mark is a comparable mark, use must be shown in the EU for the period up to IP completion day (31 December 2020) and the UK thereafter.

14. The case law on genuine use was summarised by Arnold LJ in *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247:

“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 *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 Bundersvereinigung Kamaradschaft ‘Feldmarschall*

Radetsky [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken 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 sub-category 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] and [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].”

107. The trade mark proprietor bears the burden of proving genuine use of its trade mark: see section 100 of the 1994 Act and *Ferrari* at [73]-[83]. The General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. Case T-78/19 *Lidl Stiftung & Co KG v European Union Intellectual Property Office* [EU:C:2020:166] at [25]. It has also repeatedly held that the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. *Lidl* at [33]. In *Awareness Ltd v Plymouth City Council* [2013] RPC 24 Daniel Alexander QC sitting as the Appointed Person said:

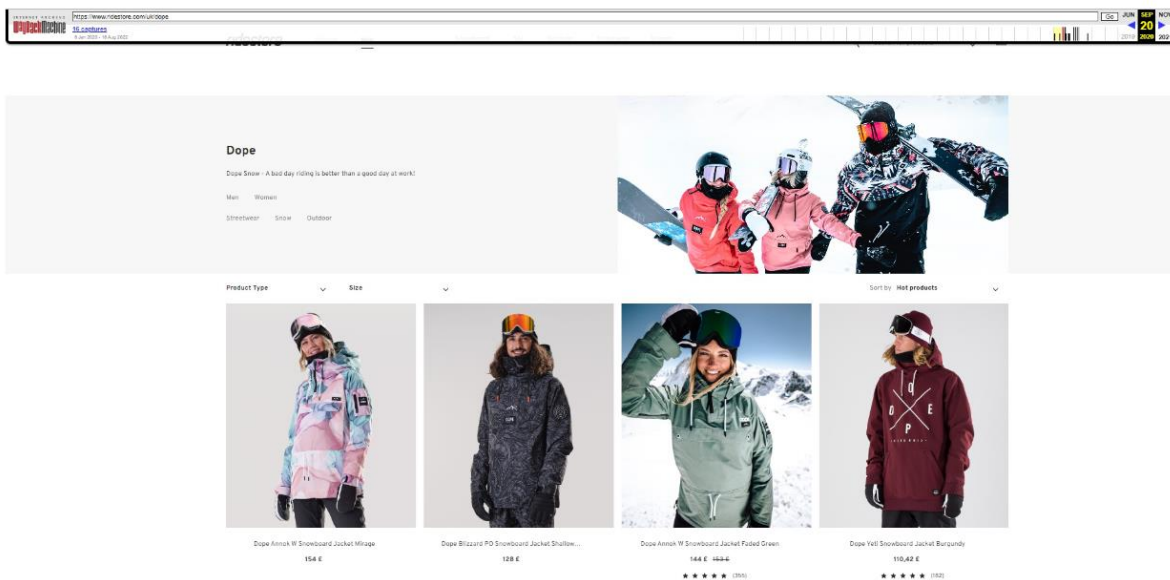
‘19. For the tribunal to determine in relation to what goods or services there has been genuine use of a mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know.
...

22. ... 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 ... 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.”

The evidence

15. Ms Glommen states that the DOPE brand was founded in 2006 and specialises in the sale of snow wear and outerwear for men and women. The goods are sold in the UK on the DOPE website. Exhibit 1 contains a collection of seven screenshots obtained through the Internet Archive Wayback Machine. The earliest is dated 20 September 2020 and is shown below. The latest is dated 11 November 2023, which I note is a few days after the relevant date.



16. The mark can be seen on the screenshots, and they show snow and outdoor jackets and trousers for men and women.

17. Exhibit 2 contains examples of UK media coverage:

a) An article from www.inthesnow.com dated 27 October 2020 entitled “Dope Annok”, which is a review of the Dope Annok jacket. It begins: *“If you’ve been out on the slopes in the last year or two, it’s more than likely you’ve seen the Dope*

Annok, the signature style that's brought this fresh new brand to the forefront of snow sports apparel";

b) An article from www.inthesnow.com dated 14 November 2021 entitled "Dope Blizzard PO W Jacket", which is a review of the Blizzard jacket. The recommended retail price is given in sterling. The article begins as follows:

"The Blizzard jacket is probably a little unlike any other ski jacket you've got your hands on. It has all the right credentials but takes a novel approach to design, which is a real breath of fresh air.

The Dope Snow lineup of jackets is extensive to say the least. With everything from do-it-all coats to arctic-temperature-proof puffers, from spring-ready softshells to backcountry prepped anoraks, there's really no niche or rider not catered for. So where does the Blizzard fit into things then? Because looking at it, it's a pullover – and Dope has four of them in the line already.";

c) An article from Snowmagazine.com. The exhibit itself does not appear to be dated but Ms Grommen gives the date of 20 December 2021. The title is incomplete: "...d this be the best value ski jacket out there?" and says "*Look no further than Dope Snow*"; and

d) An undated article from www.inthesnow.com entitled "Best women's ski jackets for 2022". Ms Grommen gives a date of 10 October 2022. The text is the same as the start of the article at (b).

18. This concludes the evidence filed by the opponent.

Assessment of genuine use

19. As Mr Alexander noted in the passage from his decision quoted by Arnold LJ above, the courts have not specified particular types of evidence that must be filed in order to prove genuine use. Although Ms Grommen has not provided any sales figures, that is not in itself fatal. That said, the evidence here is scant. The witness statement is barely over three pages and the exhibits amount to 21 pages, including two cover sheets. The high point is the articles from websites, but, even then, there is nothing to

tell me the reach of these sources. I note that the first of these articles suggests that the opponent's jackets have been visible on the ski slopes, but this is a single reference and could be advertising puffery. While such material can contribute to an overall picture of use, there is very little else in this particular instance. The opponent has not told me if its goods have been sold through any other outlets apart from its website. It should have been able to provide sales figures or sample invoices. The onus is on the opponent to show that it has made genuine use of the 313 mark. In my view, it has not done so. Consequently, I find that it may not rely on this mark and so the opposition will continue on the basis of the 891 mark alone.

Section 5(2)(b)

20. Section 5(2) of the Act is as follows:

“A trade mark shall not be registered if because—

...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

21. In considering the opposition, I am guided by the following principles, gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (Case C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (Case C-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their 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 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 the earlier mark to mind, is not sufficient;
- j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; and

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

Comparison of goods

22. It is settled case law that I must make my comparison of the goods on the basis of all relevant factors. These include the nature of the goods, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary: see *Canon*, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296]. As the General Court said in *Boston Scientific Ltd v OHIM*, Case T-325/06, goods and services are complementary when

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

23. The goods to be compared are shown in the table below:

Contested goods	Earlier goods
<p><u>Class 18</u> <i>Leather, unworked or semi-worked; bags; reins for guiding children; umbrellas; walking sticks; clothing for pets; pocket wallets; travelling trunks; slings for carrying infants; bags for sports; rucksacks; travelling bags; hiking bags; Umbrellas; mountaineering sticks; fitted protective covers for luggage.</i></p>	<p><u>Class 18</u> <i>Bags; Sports packs; Kit bags; Toiletry bags; Pocket wallets; Key cases; Umbrellas.</i></p>
<p><u>Class 22</u> <i>Hemp bands; ropes; tarpaulins; commercial fishing nets; nets; mesh</i></p>	

Contested goods	Earlier goods
<p><i>bags for washing laundry; tents; sacks for the transport and storage of materials in bulk; down [feathers]; eiderdown; padding materials, not of rubber, plastics, paper or cardboard; raw silk; raw fibrous textile; hemp fibres; schappe [raw silk waste]; coconut fibre; raffia; carbon fibres for textile use; glass fibres for textile use; sails for ski sailing; hammocks; awnings of textile; canvas for sails; packing [cushioning, stuffing] materials, not of rubber, plastics, paper or cardboard; vitreous silica fibres for textile use; textile fibres; fleece wool; silk flock.</i></p>	
<p><u>Class 23</u> <i>Yarn; cotton thread and yarn; woollen thread and yarn; hemp thread and yarn; coir thread and yarn; silk thread and yarn; spun silk; fibreglass thread for textile use; threads of plastic materials for textile use; sewing thread and yarn; spun cotton; spun wool; rayon thread and yarn; darning thread and yarn; elastic thread and yarn; rubber thread for textile use; chenille yarn.</i></p>	
<p><u>Class 24</u> <i>Upholstery fabrics; fabric; buckram; textile material; fabric for footwear; trellis [cloth]; wall hangings of textile;</i></p>	

Contested goods	Earlier goods
<p><i>felt; towels of textile; household linen; quilts of textile; bed linen; table runners, not of paper; banners of textile or plastic; shrouds; marabouts [cloth]; cotton fabrics; hemp cloth; fabrics for textile use; knitted fabric; non-woven textile fabrics; bed covers; bedsheets; mosquito nets; bed blankets; bivouac sacks being covers for sleeping bags; travelling rugs [lap robes]; lingerie fabric.</i></p>	
<p><u>Class 25</u> <i>Clothing; ready-made clothing; trousers; coats; knitwear [clothing]; sweaters; shirts; underwear; layettes [clothing]; bathing caps; bathing suits; bathing trunks; waterproof clothing; masquerade costumes; footwear; half-boots; caps being headwear; hosiery; gloves [clothing]; boas [necklets]; girdles; sleep masks; waistcoats; skirts; tights; camisoles.</i></p>	

24. The opponent submits that the goods in Class 18 of the contested specification are identical or similar to the earlier Class 18 goods. It also submitted that the applicant's Class 25 goods were identical or similar to the earlier Class 25 goods, but the opponent may not rely on that mark. With regards to the contested goods in Classes 22, 23 and 24, the opponent submits that the goods are identical or similar to the earlier goods for the following reasons:

“18. ... These goods might be purchased/offered at the same sales outlets and are aimed at the same relevant public. Due to this close complementary relationship, it is likely that a significant part of the relevant public may

believe that the goods and services covered by the Applicant are produced/provided by the same undertaking. Accordingly, for these reasons, these contested goods are similar.”³

25. It will be seen that the pleadings and the submissions remain at a fairly general level. In *SmartX Trade Mark*, BL O/0911/24, Mr Iain Purvis KC, sitting as the Appointed Person, said:

“28. ... it is for the Opponent to put forward the combination of goods on which it relies for similarity (or identity). If it fails to identify a particular combination, it cannot expect the Hearing officer to do the job for it. The approach ... would place an intolerable burden on Hearing Officers in cases of this nature in which there will be thousands of potential combinations of goods which could be relied on, and for each combination a slightly different argument for similarity could be made. Furthermore, such an approach would be unfair on the Applicant for the mark, since they will have had no opportunity to address points on similarity taken by the Hearing Officer if those points are not first raised by the Opponent.”

26. Later in the same decision, he said:

“31(v). In fact (as I have pointed out) the Hearing Officer went beyond the written submissions in making findings of similarity in respect of a number of groups of goods on the basis of arguments which had not been raised by the Opponent. If the Applicant had complained about this by way of an Appeal, there would probably have been a good argument that he had been the victim of procedural unfairness. ...”

27. I agree with the opponent that some of the goods in Class 18 of the earlier specification are identical to some of the earlier goods. These include *Bags; Pocket wallets; Umbrellas*. In order to guard against the danger of procedural unfairness, I shall not undertake a full comparison of the goods at present. The examination of the opposition will proceed on the basis that the contested goods are identical to those covered by the earlier trade mark. If the opposition fails, even where the goods are

³ Written submissions in lieu of a hearing.

identical, it follows that it will also fail where the goods are only similar. I shall return and carry out a full comparison should that prove necessary.

Average consumer and the purchasing process

28. The average consumer is deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), paragraph 60. 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 and services in question: see *Lloyd Schuhfabrik*, paragraph 26.

29. The opponent submits that the goods at issue are aimed at average consumers. If, by this, it means members of the general public, then in the case of the Class 18 goods, I agree. These are ordinary consumer goods. They vary in price, but on the whole I consider that they are not particularly costly items. In my view, they would be purchased on a fairly frequent basis. The average consumer would buy them from a retail outlet or online. In each of these scenarios, they would see the mark in use, as they would pick the physical goods from shelves or racks. The purchasing process would be primarily visual, although the average consumer may also seek the assistance of sales staff or order goods over the telephone. Therefore, I shall not neglect the aural comparison of the marks. I consider that the level of attention paid would be medium.

Comparison of marks

30. It is clear from the judgment of the CJEU in *SABEL* that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details: see, in particular, paragraph 23. In the same case, the court explained that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. Artificial dissection of the marks would therefore be wrong, although it is necessary for me to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impression created by the marks: see *Bimbo*, paragraph 34.

31. The respective marks are shown below:

Contested mark	Earlier mark
ReTraze Aqua- It's Dope!	DOPE

32. The earlier mark consists of a single word "DOPE". There is no other element that can contribute to the overall impression of this mark.

33. The contested mark comprises four words, separated into two parts by a dash. The applicant submits that this dash is in fact a minus sign, but I do not consider that this would be apparent to the average consumer. Instead, I think they would see it as a dash. The opponent submits that "Dope" is the dominant element of this mark. I disagree. I consider that the average consumer would perceive "ReTraze Aqua" as the more dominant and distinctive element of the mark, with both words contributing roughly equally. The words "It's Dope!" are likely to be seen as a comment on the brand, particularly as one of the meanings of the word "Dope" is as a slang term of approval. There is likely to be a group of consumers who are aware of this usage and for them the words "It's Dope!" will play a lesser role in the overall impression of the mark given its laudatory meaning. In my view, though, a significant group of consumers would not be aware of this meaning. They would understand that the word can also refer to illegal drugs, the process of administering such a drug, a stupid person, or an informal way of referring to news or information. The applicant also submits that it might refer to a dyeing process ("Dope-Dye"), which is used in the textile industry. I think it unlikely that the average consumer would be aware of this latter usage. For this group, "It's Dope!" would have some distinctive character and make a contribution to the overall impression of the mark, but it will be a smaller contribution than that made by the first two words.

Visual comparison

34. The entirety of the earlier mark can be seen at the end of the contested mark. However, I am mindful that I must bear in mind that the average consumer will not artificially dissect the marks and will consider them as wholes. The average consumer tends to pay more attention to the beginning of marks and words: see *El Corte Inglés*

SA v OHIM, Joined cases T-183/02 and T-184/02, paragraphs 81 and 82. I find that the marks are visually similar to a low degree.

Aural comparison

35. The contested mark consists of six syllables, the final one of which is identical to the opponent's mark. That word "DOPE" would be pronounced in the usual way. The first group of consumers, who see "It's Dope" as laudatory, may not pronounce it, but I have no reason to suppose that the other group would ignore it. I find that the marks are aurally similar to a low degree.

Conceptual comparison

36. The word "ReTraze" in the contested mark is likely to be seen as an invented word, or as a misspelling of "retrace". This is followed by "Aqua", which I consider would prompt the average consumer to think of water. I have already set out some of the possible meanings that the word in the earlier mark ("DOPE") would bring to mind. There will be some average consumers who see a low degree of conceptual similarity with the contested mark, given the presence of the same word "DOPE". There will be others for whom "It's Dope!" gives that word a meaning it doesn't possess on its own. For them, the marks will be conceptually dissimilar.

Distinctive character of the earlier mark

37. Distinctive character is a measure of how strongly a mark distinguishes the goods or services of one undertaking from those of others. The factors that I must take into account in assessing the level of distinctive character were set out by the CJEU in *Lloyd Schuhfabrik Meyer*.

"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).”

38. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of the mark can be enhanced by the use that has been made of it.

39. While the opponent has filed evidence, this does not show any use in relation to goods in Class 18. Consequently, I have only the inherent position to consider. The opponent submits that “DOPE” has no meaning in relation to the goods for which it is registered. I have already discussed how some consumers would understand it as a laudatory term, but, in my view, there will be a significant group of consumers who do not see it that way. I shall focus on this group. The word is in common English usage and so it has a medium degree of inherent distinctive character.

Conclusions on likelihood of confusion

40. Making an assessment of the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer of the goods at issue and determining whether they are likely to be confused. When doing this, I am required to bear in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely on the imperfect picture of them that they have in their mind. This means that the global assessment emulates what happens in the mind of the average consumer on encountering the later mark with an imperfect recollection of the earlier mark. The courts have not said what weight should be attached to each of the factors or provided a formula that can be applied to any set of circumstances. However, I am required to take account of the interdependency principle, i.e. that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or vice versa.

41. Earlier in my decision, I found that:

- a) Some of the contested Class 18 goods are identical to some of the earlier Class 18 goods;
- b) The average consumer is a member of the general public, paying a medium level of attention in a primarily visual purchasing process;
- c) “ReTraze Aqua” is the more dominant and distinctive element of the contested mark;
- d) The marks are visually and aurally similar to a low degree and conceptually similar to at best a low degree; and
- e) The earlier mark has a medium degree of distinctive character.

42. There are two types of confusion: direct and indirect. In *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, Mr Iain Purvis QC, sitting 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 recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

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

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume

that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI', etc.).

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

43. In *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ commented that:

"12. This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition.

13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/291/16) at [16] 'a finding of likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

44. The opponent has referred me to two earlier decisions of this tribunal that it submits present a similar set of circumstances to the instant case and in which the hearing officer found a likelihood of confusion. The first of these is *Alibaba Group Holding Limited v Play'N Go Marks Ltd*, BL O/423/21. The marks in question were ALIBABA (earlier mark) and FORTUNES OF ALI BABA (contested mark). In this decision, the

hearing officer found that “FORTUNES OF” qualified “ALI BABA”, which was the dominant element of the contested mark. For this reason, this case is not on all fours with the instant case, as I have found that the more dominant and distinctive element of the contested mark is “ReTraze Aqua”, rather than “Dope”.

45. The second decision was given in *Dosenbach-Ochsner AG Schuhe und Sport v Kelly Slater Wave Company LLC*, BL O/298/20. The contested mark was THE SCIENCE OF STOKE, while the earlier mark was the figurative mark shown below:

STOKE 

The hearing officer found that the word “STOKE” made the greatest contribution to the overall impression of both those marks. Again, this case is not on all fours with the instant case. I shall say no more about these two decisions.

46. I am mindful that the average consumer is prone to imperfect recollection and is unlikely to see the trade marks side-by-side. Even so, and despite the identity between the goods, I consider that the differences between the marks are too great for them to be mistaken for each other. I find there is no likelihood of direct confusion.

47. Given my finding that the more dominant element of the contested mark is “ReTraze Aqua”, I have considerable difficulty in concluding that there would be a likelihood of indirect confusion. The opponent has not explained in any detail how this might occur. The earlier mark has a medium level of distinctive character. It is not so highly distinctive that the average consumer would believe that the marks belong to the same or economically-connected undertakings. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor QC (as he then was), sitting as the Appointed Person, stressed that indirect confusion should not be found just because the marks share a common element: see paragraph 81.4. I find that there is no likelihood of indirect confusion.

48. The opposition has failed where the goods are identical, and so it would also fail where the goods are merely similar. I shall therefore not return to the comparison of goods.

FINAL REMARKS

49. For the sake of completeness, and in the event of an appeal, I note that I would have found no likelihood of confusion even if I had found that the opponent had shown genuine use of the 313 mark. The evidence would not have been sufficient to show that the distinctive character of that mark had been enhanced through use, given the absence of sales figures and the small amount of media coverage over a period of around two years. In addition, the more dominant and distinctive element of the later mark is quite different from the 313 mark.

OUTCOME

50. The opposition has failed and, subject to a successful appeal, Application No. 3975131 may proceed to registration.

COSTS

51. The applicant has been successful and is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice No. 1/2023. The applicant has taken no part in these proceedings beyond filing its notice of defence and counterstatement and so I award £300 as a contribution to its costs.

52. I therefore order RDSTR IP 2 AB to pay RETRAZE CO., LTD the sum of £300. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an unsuccessful appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 27th day of June 2025

Clare Boucher
For the Registrar,
The Comptroller-General