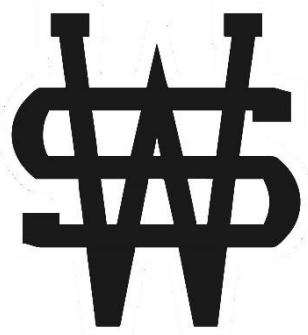
o/0663/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003792033

BY 1 OF 1 WORLD LIMITED

TO REGISTER THE TRADE MARK:



(SERIES OF 2)

IN CLASSES 25, 26, 28, 32 AND 35

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 436170

BY SMITH & WESSON CORP.

BACKGROUND AND PLEADINGS

1. On 25 May 2022, 1 OF 1 WORLD LIMITED ("the applicant") applied to register the series of two trade marks shown on the cover page of this decision in the UK. The application was published for opposition purposes on 10 June 2022. The applicant seeks registration for the following goods and services:

Class 25 Hats; Small hats; Woolly hats; Ski hats; Fashion hats; Sports caps and hats; Clothing; Clothes; Motorcyclists' clothing; Hoods [clothing]; Leisure clothing; Childrens' clothing; Sports clothing; Leather clothing; Gloves [clothing]; Waterproof clothing; Jackets [clothing]; Sports jackets; Sports socks; Sports caps; Sport shirts; Sports jerseys; Sport shoes; Sports bras; Sport coats; Sports over uniforms; Clothes for sport; Clothes for sports; Footwear for sport; Footwear for sports; Clothing for sports; Headwear; Caps [headwear].

Class 26 Hat bands; Hat pins, other than jewellery.

Class 28 Sports balls.

Class 32 Sports drinks.

Class 35 Marketing; Promotional marketing; Event marketing; Marketing campaigns; Direct marketing; Online Marketing; Digital marketing; Marketing services; Internet marketing; Retail services relating to sporting goods.

2. The application was partially opposed by Smith & Wesson Corp. ("the opponent") on 9 September 2022 based upon section 5(2)(b) of the Trade Marks Act 1994 and is directed against the following goods and services:

Class 25 Hats; Small hats; Woolly hats; Ski hats; Fashion hats; Sports caps and hats; Clothing; Clothes; Motorcyclists' clothing; Hoods [clothing]; Leisure clothing; Childrens' clothing; Sports clothing; Leather clothing; Gloves

[clothing]; Waterproof clothing; Jackets [clothing]; Sports jackets; Sports socks; Sports caps; Sport shirts; Sports jerseys; Sport shoes; Sports bras; Sport coats; Sports over uniforms; Clothes for sport; Clothes for sports; Footwear for sport; Footwear for sports; Clothing for sports; Headwear; Caps [headwear].

Class 35 Retail services relating to sporting goods.

3. Under section 5(2)(b), the opponent relies upon the following trade marks:

UK registration no. UK00001523220

Filing date 18 December 1992; Registration date 13 October 1995.

("The First Earlier Mark")

S & W

Comparable UK trade mark (EU) registration no. UK00902731644[1]

Filing date 11 June 2002; Registration date 30 June 2004.

("The Second Earlier Mark")

4. Under section 5(2)(b), the opponent relies upon some of its goods, for which both earlier marks are registered, namely "articles of outer clothing" in class 25, and claims

[1] Following the end of the transition period of the UK's withdrawal from the EU, all EU trade marks ("EUTM") registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (EU)' retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

there is a likelihood of confusion because the goods are identical, and the marks are stylised versions of the letters S and W.

5. The application was also fully opposed under section 5(3) of the Act with the opponent relying upon its Second Earlier Mark and the following mark:

UK registration no. UK0000477487
Filing date 4 February 1927; Registration date 4 February 1927.
("The Third Earlier Mark")

6. Under section 5(3), the opponent claims to enjoy a significant reputation in the UK by virtue of its extensive use in relation to its Second and Third Earlier Mark's class 13 goods. The opponent claims that use of the applicant's mark will "ride on the coattails of the senior mark and will benefit from the power of attraction, reputation and prestige vested therein". The opponent also claims that "detriment to the repute of the earlier registration will occur because use of the mark in suit is likely to devalue the image", and the reputation of the opponent's mark may be tainted "when it is reproduced in a degrading or inappropriate context" and the "likelihood of such detriment may arise in particular from the fact that the goods offered by the third party possess a characteristic or a quality which [is] liable to have a negative impact on the image of the registration". Lastly, the opponent states that the "senior marks ability to identify the goods/services for which it is registered will be weakened as a result of the use of the later mark given the reputation inherent to the earlier mark".

7. The applicant filed a counterstatement denying the claims made.

8. The opponent is represented by Abion UK Limited and the applicant is unrepresented. Neither party requested a hearing, however, the opponent filed

evidence in chief and submissions in lieu of a hearing. I make this decision having taken full account of all the papers.

RELEVANCE OF EU LAW

9. 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.

EVIDENCE

10. The opponent's evidence consists of the witness statement of Vincent Perreault dated 13 July 2023. Mr Perreault is the Director of Brand and Marketing for the opponent, a position he has held for over 5 years. Mr Perreault's statement is accompanied by 4 annexes.

11. Whilst I do not propose to summarise it here, I have taken all of the evidence and the parties' submissions into consideration in reaching my decision and will refer to them where necessary below.

DECISION

Section 5(2)(b)

12. Section 5(2)(b) reads as follows:

> "5(2) A trade mark shall not be registered if because –
>
> (a)…

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

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

13. The opponent's First and Second Earlier Marks had completed their registration process more than five years before the relevant date (the filing date of the applicant's mark). Accordingly, the use provisions at section 6A of the Act do apply. However, as the applicant did not request that the opponent prove use of its marks, it is entitled to rely upon all of its goods without demonstrating that it has used its marks.

Section 5(2)(b) case law

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

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods and services

15. Before I proceed with the comparison of the goods and services, I note that in the opponent's submissions in lieu they state the following:

> *"Noting that the opponent's earlier registrations 1523220 and 902731644 cover "articles of clothing" and "clothing" respectively without limitation, there is direct convergence of goods as against the mark applied for."*

16. Under question 1 of its Form TM7 for both the First and Second Earlier Marks, it lists the goods relied upon as "articles of outer clothing". The opponent does not list "clothing" as indicated by the opponent's submissions in lieu. On this basis, the parties competing goods and services are as follows:

Opponent's goods	**Applicant's goods and services**
Class 25 Articles of outer clothing.	Class 25 Hats; Small hats; Woolly hats; Ski hats; Fashion hats; Sports caps and hats; Clothing; Clothes; Motorcyclists' clothing; Hoods [clothing]; Leisure clothing; Childrens' clothing; Sports clothing; Leather clothing; Gloves [clothing]; Waterproof clothing; Jackets [clothing]; Sports jackets; Sports socks; Sports caps; Sport shirts; Sports jerseys; Sport shoes; Sports bras; Sport coats; Sports over uniforms; Clothes for sport; Clothes for sports; Footwear for sport; Footwear for sports; Clothing for sports; Headwear; Caps [headwear]. Class 35

	Retail services relating to sporting goods.

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

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

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(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

19. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, 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 for Lernsysterne 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."

20. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that "complementary" means:

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

21. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted, as the Appointed Person, *in Sandra Amalia Mary Elliot v LRC Holdings Limited*, BL-0-255-13:

> "It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes."

Whilst on the other hand:

> "… it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together."

Class 25

Clothing; Clothes; Motorcyclists' clothing; Leisure clothing; Childrens' clothing; Sports clothing; Leather clothing; Waterproof clothing; Clothes for sport; Clothes for sports; Clothing for sports.

22. The opponent's "articles of outer clothing" fall within the applicant's above broader categories. The goods are identical on the principle outlined in *Meric.*

Jackets [clothing]; Sports jackets; Sport coats; Sports over uniforms.

23. The applicant's above goods fall within the broader category of "articles of outer clothing" in the opponent's specification. The goods are identical on the principle outlined in *Meric.*

Sport shirts; Sports jerseys.

24. The applicant's above goods are similar to the opponent's "articles of outer clothing" which would encompass sporting articles of outer clothing. All the goods are types of clothing, worn on the upper half of the body. They will also be worn for sporting or fashionable purposes. Therefore, I consider that they overlap in nature, method of use, purpose and users. However, I appreciate that the opponent's goods are to be worn over, and layered with, the applicant's goods. There will also be an overlap in trade channels as clothing undertakings and retail stores would sell all the goods,

which would be located in close proximity. Consequently, I consider that the goods are similar to a medium degree.

Sports socks; Sports bras; Gloves [clothing].

25. The applicant's above goods are similar to the opponent's "articles of outer clothing". All of the goods are types of clothing, which are to be worn on the body of the user, albeit different parts. Therefore, the goods to some extent, overlap in method of use, purpose and users. However, I appreciate that the goods will be made from different materials and therefore do not overlap in nature. I consider that there would be an overlap in trade channels as clothing undertakings and retail stores would sell all of the goods, and in close proximity, but they are neither in competition nor complementary. I consider that the goods are similar to between a low and medium degree.

Footwear for sport; Footwear for sports; Sport shoes.

26. The applicant's above goods are similar to the opponent's "articles of outer clothing", which would encompass sporting articles of outer clothing. Whilst the goods are all worn when performing sporting activities, they are also are worn on the user's body to provide protection, and thus overlap to some extent in purpose. However I appreciate that the goods are worn on different parts, with the applicant's goods protecting the user's feet and the opponent's goods protecting the user's body. The goods will also overlap in user and trade channels, as the same sports clothing undertakings and clothing retail stores will sell the goods, and in close proximity. Consequently, the goods are similar to between a low and medium degree.

Hats; Small hats; Woolly hats; Ski hats; Fashion hats; Sports caps and hats; Sports caps; Headwear; Caps [headwear].

27. The applicant's above goods are similar to the opponent's "articles of outer clothing". This is on the basis that the goods are all to be worn and protect the body of the user from elements such as the sun and rain. However, they will be worn on different parts of the body. The goods can also be worn for fashionable purposes and

therefore overlap in purpose and user. Furthermore, the goods would be sold by the same clothing undertakings and in the same clothing retail stores, located in close proximity. I therefore consider that the goods are similar to between a low and medium degree.

Hoods [clothing].

28. As set out in *Les Éditions Albert René v OHIM*,[2] it is clear that just because a particular good is used as a part, element or component of another, it should not result in a finding of identity/similarity between those goods. However, it does not mean that there can never be similarity between such goods where there is overlap in the factors identified in *Treat*.

29. In this instance, I consider that the applicant's hoods, which are parts of clothing, do not overlap with all of the opponent's "articles of outer clothing". Albeit the opponent's goods, which encompass jackets and coats, will most likely have hoods, I do not find that the use, user or nature of the goods overlap. I also consider that there would not be an overlap in trade channels as the applicant's hoods would be purchased wholesale to be used in the production of the finished article, which would then be on sale to the general public. Moreover, I do not have any evidence before me to show that it is typical within the trade for "hoods" to be sold singularly. I also do not consider that the goods are in competition nor complementary. Therefore, taking the above into account, I consider that the applicant's hoods and the opponent's clothing goods are dissimilar.

Class 35

30. *In Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

[2] Case T-336/03

31. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He stated (at paragraph 9 of his judgment):

> "9. The position with regard to the question of conflict between use of BOO! for handbags in Class 18 and shoes for women in Class 25 and use of MissBoo for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are 'similar' to goods are not clear cut.

32. However, on the basis of the European courts' judgments in *Sanco SA v OHIM*[3], and *Assembled Investments (Proprietary) Ltd v. OHIM* Case T-105/05[4], upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd,* Case C-398/07P, Mr Hobbs concluded:

> (i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;
>
> ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and

[3] Case C-411/13P
[4] paragraphs [30] to [35] of the judgment

then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in Oakley did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

Retail services relating to sporting goods.

33. As highlighted in *Oakley* above, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

34. In this case, the applicant's sporting goods retail services relate to the sale of the opponent's "articles of outer clothing" which would encompass sporting articles of outer clothing. They, therefore, overlap in trade channels and user and are complementary. Applying the guidance from *Oakley,* I find that the goods and services are similar to a medium degree.

35. It is a prerequisite of section 5(2)(b) that the parties' goods and services be identical or at least similar.[5] The opposition will, therefore, fail in respect of the goods that I have found to be dissimilar.

36. The opposition under section 5(2)(b) fails for the following goods:

Class 25 Hoods [clothing].

[5] *eSure Insurance v Direct Line Insurance, [2008]* ETMR 77 CA

The average consumer and the nature of the purchasing act

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

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

38. The average consumer for the goods and services will be members of the general public and businesses. The cost of purchase is likely to vary, and the goods and services will be purchased relatively frequently. However, various factors are still likely to be taken into consideration during the purchasing process for the goods, such as materials used, cut, aesthetic appearance and durability. For the services, the average consumer is likely to take into consideration the location, ease of access and availability/the range of products on offer. Consequently, I consider that a medium degree of attention will be paid when selecting the goods and services.

39. The goods are likely to be obtained by self-selection from the shelves of a clothing retail outlet, online or catalogue equivalent. This means that visual considerations will be the most significant.[6] The services are most likely to be selected from websites and following sight of signs on a physical outlet. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there will also be an aural component to the purchase of the goods and services, as advice may be

[6] *New Look Limited v OHIM*, Joined cases T-117/03 to T-119/03 and T-171/03, paragraph 50

sought from a sales assistant or representative and word-of-mouth recommendations may play a part.

Comparison of the trade marks

40. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated, at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

> "… it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

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

42. The respective trade marks are shown below:

Opponent's marks	Applicant's trade marks
	

(The First Earlier Mark) S & W **(The Second Earlier Mark)**	 **(SERIES OF 2)**

Overall Impression

43. The opponent states that its First Earlier Mark consists of the letters S and W, which are superimposed over one another. I consider that a small (but not significant) proportion of average consumers may notice these letters, whether it be SW or WS. However, I also consider that a significant proportion of average consumers will not notice, nor decipher these letters, due to their highly stylised typeface and interlocking presentation. I also remind myself that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.[7] For that significant proportion of average consumers, they will just see it overall as a decorative device, with two star elements on either side, encompassed by a circular outline. I consider that the overall impression lies in the combination of these elements.

44. The Second Earlier Mark consists of the letters S and W, with an ampersand between them. I consider that the overall impression lies in the combination of these elements.

45. The applicant's series of two marks consists of the letters S and W, or W and S, overlapping each other. I note that as the letters are less stylised than in the First Earlier Mark, either presented in a capitalised white typeface with a black outline, or in a thick black capitalised typeface, a significant proportion of average consumers will see these letters within the mark. I consider that the overall impression lies in the combination of the letters, their stylisation and overlapping presentation.

[7] *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.*V. Case C-342/97

Visual Comparison

First Earlier Mark and the applicant's marks

46. The opponent states that "both marks consist of similar stylised versions of the letters SW superimposed or merged into each other". However, as noted above, I do not consider that the average consumer would decipher these letters from the First Earlier Mark, as they would have to engage in a highly imaginative cognitive process in order to do so. Therefore, taking paragraphs 43 and 45 into account, I consider that the parties' marks are visually dissimilar. I also bear in mind that in *Errea Sport S.P.A. v The Royal Academy of Arts*, BL O/010/16, Mr Iain Purvis Q.C., sitting as the Appointed Person, considered an appeal concerning the following two trade marks:

Earlier mark	Later mark
	

47. In that case, the Hearing Officer decided that there was no visual similarity between the marks. On appeal, the opponent contended that the earlier mark would be understood as consisting of the letters RA and that, therefore, the marks should have been found to be visually similar to at least a low degree. Mr Purvis Q.C. stated:

> *"11. I do not accept this. First of all, it seems to me to be a matter of semantics rather than substance. There is no doubt that the Hearing Officer was proceeding on the basis that the average consumer would understand the letters RA to be conveyed by the earlier mark. Indeed she makes the point herself on more than one occasion. When she states that there is no visual similarity between the marks, she cannot therefore be taken to have forgotten this point. Similarly, she cannot be taken to have forgotten it when considering*

the overall 'global' question of whether the average consumer is likely to be confused.

12. Secondly, the difference between 'no visual similarity' and 'a low degree of visual similarity' is not only impossible to define but quite subjective. It is hard to imagine a case in which the spread of reasonable opinions about visual similarity could not cover both of these characterisations. This is not, therefore, fertile ground upon which to base an alleged error of principle.

13. Thirdly, I do not have any difficulty with the notion (which Mr Stobbs appeared to be contending was illogical) that two representations of the same thing may have no visual similarity. In the world of art, the visual representation of a horse in Picasso's Guernica has little or nothing in common with the visual representation of a horse in one of George Stubbs' portraits. I do not think it unreasonable to say that they have no visual similarity, whilst having some limited conceptual similarity (they are both paintings of horses).

14. I therefore do not consider that the Hearing Officer's Decision is undermined by the alleged error of principle identified in the Grounds of Appeal."

48. Therefore, even if the average consumer perceives the First Earlier Mark as comprising or containing the letters S and W (which I have concluded a significant proportion would not), it is not at all visually similar to the applicant's marks. This is analogous to the Picasso and George Stubbs horses. If both marks are perceived as the letters S and W, that may be a point of conceptual similarity (but see below). However, the mere fact that both parties' marks contain the letters S and W, does not, of itself, make them visually similar. The letters are clearly presented in significantly different stylised typefaces, and whilst they are either interlocking or overlapping each other, the placements of them do differ (with the letter S bigger in size and the smaller letter W weaved into it in the First Earlier Mark, and the letters SW/WS being of the same size and placed on top of one another in the applicant's). I also bear in mind that the First Earlier Mark has the addition of the star devices and the circle encasing the letters. On this basis, at best, the marks are only visually similar to a very low degree.

Second Earlier Mark and the applicant's marks

49. Visually, both marks consist of the letters S and W. However, unlike the First Earlier Mark, the letters S and W are less stylised, and are therefore readily identifiable in the Second Earlier Mark. This, therefore, acts more as a visual point of similarity. However, I recognise that the letters S and W are still stylised within the Second Earlier Mark which creates a visual point of difference. Moreover, the opponent's mark also contains the ampersand between these letters, which are presented side by side, whereas the letters S and W are presented overlapping one another in the applicant's marks. These, therefore, act as visual points of difference. Taking the above into account, I consider that the marks are visually similar, but to only between a low and medium degree.

Aural Comparison

First Earlier Mark and the applicant's marks

50. As the letters S and W can be made out within the applicant's marks, and because consumers will naturally look for pronounceable elements within the mark, these letters will be pronounced in either order (SW or WS). As noted above, a significant proportion of average consumers will see the First Earlier Mark as a decorative device and I note that in *Dosenbach-Ochsner AG Schuhe und Sport v OHIM*, T- 424/10, the GC stated:

> "46. A figurative mark without word elements cannot, by definition, be pronounced. At the very most, its visual or conceptual content can be described orally. Such a description, however, necessarily coincides with either the visual perception or the conceptual perception of the mark in question. Consequently, it is not necessary to examine separately the phonetic perception of a figurative mark lacking word elements and to compare it with the phonetic perception of other marks."

51. Therefore, as the First Earlier mark cannot be articulated; the parties' marks are aurally dissimilar. However, for some consumers (and not a significant proportion) who

see the First Earlier Mark as containing the letters S and W, the marks are aurally identical.

Second Earlier Mark and the applicant's marks

52. The ampersand in the Second Earlier Mark will be pronounced as "and". Therefore if the S and W are pronounced in the same order in the applicant's marks, the parties' marks will be aurally similar to a high degree. However, if the applicant's marks are pronounced as WS (the opposite way round), then the marks will be aurally similar to no more than a medium degree.

Conceptual Comparison

First Earlier Mark and the applicant's marks

53. Conceptually, I have not been provided with submissions from either party as to what concepts would be assigned to the opponent's and applicant's marks. The applicant's marks, which consist of the letters SW/WS, will not be assigned any conceptual meaning, since the letters may stand for any number of word combinations. I also note that letters on their own do not convey a particular concept over and above their existence as letters in the English alphabet. The stylisation present in the applicant's marks, including the typeface used, and the circle and star elements, also adds no meaning. The First Earlier Mark, which consists of a decorative device to a significant proportion of consumers, will also not convey any particular meaning. On this basis, the marks are conceptually neutral. I also bear in mind that if the consumer saw the letters S and W in the First Earlier Mark, again, they do not convey any specific meaning. The letters in both marks may stand for any number of word combinations and therefore will not be assigned any conceptual meaning, making them conceptually neutral.

Second Earlier Mark and the applicant's marks

54. Both marks share the same letters S and W. I note that these letters are separated by the word "and" in the Second Earlier Mark. However, as noted above, the letters in

both marks may stand for any number of word combinations and therefore will not be assigned any conceptual meaning. The marks are conceptually neutral.

Distinctive character of the earlier mark

55. 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 C108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger [1999] ECR 1-2779, 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 promotion of 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)."

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

57. I will begin with the inherent distinctiveness of the opponent's marks. As the First Earlier Mark will be seen by a significant proportion of consumers as a decorative device, which conveys no particular meaning, it is inherently distinctive to a high degree. However, I also acknowledge that some consumers (but not a significant proportion) may see the very highly stylised letters S and W in the First Earlier Mark, which are presented inside a circle with two star devices. The letters S and W have no immediate conceptual meaning, since they may stand for any number of word combinations. There is also no evidence that these letters are commonly used in relation to the goods in issue, nor are they descriptive or allusive. On this basis I consider that the letters SW are inherently distinctive to a medium degree. However, the use of the highly stylised typeface that has been applied to the First Earlier Mark (in combination with the star and circle devices) results in a high degree of inherent distinctiveness overall.

58. The Second Earlier Mark consists of the letters S and W separated by an ampersand. The letters have no immediate conceptual meaning, since they may stand for any number of word combinations. However, there is no evidence that the letters S and W are commonly used in relation to the goods in issue, and they are neither descriptive nor allusive. Consequently, the Second Earlier Mark is inherently distinctive to a medium degree.

59. I also note that the opponent has pleaded enhanced distinctive character for its First and Second Earlier Marks. The opponent has provided the following evidence for clothing goods only:

a) **Annex 2** contains undated screenshots from "540 Brands" amazon store. I note that "540 Brands" is one of the opponent's licensees, and the amazon screenshots shows the sale of the opponent's hoodies, t-shirts, polo shirts, and caps.

b) **Annex 3** contains photos of "SMITH & WESSON" footwear being sold on the originalfootwear.com, which, as highlighted by Mr Perrault's witness statement, is for "law enforcement officers, military operators, first responders and other uniformed professionals".

60. However, in this instance, similarity has been established based upon the opponent's "articles of outer clothing", and I do not consider that any of the opponent's above clothing goods would fall within this broad category. Moreover, all of the remaining evidence, including its sales and advertising figures, are all in relation to the opponent's firearm goods. Consequently, it cannot assist the opponent in demonstrating enhanced distinctiveness for the goods that I have found to be similar to those in the application.

Likelihood of confusion

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

First Earlier Mark and the applicant's marks

62. The following factors must be considered to determine if a likelihood of confusion can be established:

- For the significant proportion of consumers who see the First Earlier Mark as a decorative device, the parties' marks are visually and aurally dissimilar, and conceptually neutral.

- For some consumers (but not a significant proportion) who see the First Earlier Mark as being composed of the letters S and W, the parties' marks are visually similar to a very low degree, aurally identical and conceptually neutral.
- I have found the First Earlier Mark (whether seen as a decorative device or consisting of the letters S and W) to be inherently distinctive to a high degree.
- I have identified the average consumer for the goods and services to be members of the general public and businesses, who will select the goods and services primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process.
- I have found the parties' goods and services to be identical to similar to between a low and medium degree.

63. I note that visual, aural and conceptual similarities do not always carry the same weight, for example, where goods and services are purchased by primarily visual means, greater weight will be attributed to the visual similarities or differences.[8] In this case, the goods and services will be brought primarily visually, and there is no visual similarity, or at best, only a very low degree of visual similarity between the marks. Even if the marks were considered to be aurally identical for a significant proportion of consumers, and even if the marks were considered to be conceptually identical (assuming I am wrong that there is no conceptual similarity), the visual differences are too great to override any aural and conceptual identity.

64. In the *RA* case referred to earlier in this decision, Mr Purvis Q.C. went on to say, in response to the opponent's argument that both parties' goods would be asked for as 'RA' goods, that in the case of a heavily stylised earlier mark, "*…taking the aural similarities alone tends to ignore the real substance and distinctive character of the mark and is likely to lead to an erroneous result*." That is the case here. Even if the goods or services are asked for as "SW", they will also be seen during the purchase. Moreover, any conceptual identity based upon the letters S and W will not be strong enough to displace the recollection of two entirely different visual impressions,

[8] *New Look v OHIM* T-117/03 to T-119/03 and T-171/03

especially as the consumer is paying a medium degree of attention during the purchasing process. Therefore, taking all of the above into account, even bearing in mind the principle of imperfect recollection, I do not consider that there is a likelihood of direct confusion.

65. It now falls to me to consider a likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C. sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

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

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

67. I consider that, having noticed that the competing marks are different, I see no reason why the average consumer would assume that they came from the same or economically linked undertakings. I do not consider that the average consumer would think that the opponent's First Earlier Mark was connected with the applicant, and vice

versa, on the basis that they both consist of the letters S and W. As noted above, the distinctive character of the earlier mark does not rest solely in the letters S and W, but is also attributable to the heavy stylisation of the First Earlier Mark. Therefore, on the basis that the stylisation of the opponent's mark is not replicated in the applicant's mark (and vice versa), it means that the average consumer is unlikely to make a connection between the two. It is more likely to be viewed as a coincidence that both marks use the letters S and W due to the propensity for many undertakings to adopt letters as indicators of trade origin and not an indication that there is a connection between the undertakings responsible for the marks. Therefore, taking all of the above into account, the parties' marks are clearly not natural variants or brand extensions of each other. I do not consider that the average consumer, paying a medium degree of attention during the purchasing process, would think that the applicant's trade mark was connected with the opponent, or vice versa. Even if the opponent's mark is brought to mind, this is mere association, not confusion: see *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81. I find there is no likelihood of indirect confusion.

Second Earlier Mark and the applicant's marks

68. The following factors must be considered to determine if a likelihood of confusion can be established:

- The marks are visually similar to between a low and medium degree.
- The marks are aurally similar to a high degree, or to no more than a medium degree, depending on how the applicant's mark is pronounced.
- The marks are conceptually neutral.
- I have found the Second Earlier Mark to be inherently distinctive to a medium degree.
- I have identified the average consumer for the goods and services to be members of the general public and businesses, who will select the goods and services primarily by visual means, although I do not discount an aural component.

- I have concluded that a medium degree of attention will be paid during the purchasing process.
- I have found the parties' goods and services to be identical to similar to between a low and medium degree.

69. Whilst a significant proportion of average consumers will recognise that the applicant's marks are composed of the letters S and W, I still do not consider that this would result in a likelihood of direct confusion with the opponent's Second Earlier Mark. This is on the basis that the presentation and stylisation of the letters in the applicant's marks is different. The Second Earlier Mark contains the ampersand between the letters, which are presented in a horizontal format, next to each other, whereas the applicant's mark consists only of the letters SW/WS, which are overlapping each other. Again, in this case, the purchasing process is predominantly visual and therefore the visual differences between the competing marks are of particular importance. The visual differences are also compounded by the fact that the competing marks are conceptually neutral and, as such, have no meaning which could link them together in the minds of consumers. Lastly, although the competing marks are aurally similar to a high degree (due to the verbalisation of the letters S and W), as the purchasing process for the goods and services is likely to be a primarily visual one, consumers are unlikely to select the goods and services without sight of the marks. In these circumstances, there is only limited potential for aural confusion and, in any event, aural similarity of a high degree between the marks is insufficient alone in the context of the necessary global assessment for a finding of direct confusion.[9] Therefore, taking all the above into account, even bearing in mind the principle of imperfect recollection, I am satisfied that the marks are unlikely to be mistakenly recalled or misremembered as each other. I do not consider there to be a likelihood of direct confusion.

70. Having noticed that the competing marks are different, I see no reason why the average consumer would assume that they came from the same or economically linked undertakings. I do not consider that the average consumer would think that the opponent's Second Earlier Mark was connected with the applicant, and vice versa, on

[9] BL O/010/16

the basis that they both consist of the letter's S and W, when they are presented in such different ways. I do not consider that the addition of the ampersand in the Second Earlier Mark (which is not present in the applicant's marks), and the overlapping presentation and stylisation of the letters in the applicant's marks (which is not present in the Second Earlier Mark) are natural variants or brand extensions of each other. As noted above, it is more likely to be viewed as a coincidence that both marks use the letters S and W due to the propensity for many undertakings to adopt letters as indicators of trade origin and not an indication that there is a connection between the undertakings responsible for the marks. Even if the opponent's mark is brought to mind, this is mere association, not confusion. I find there is no likelihood of indirect confusion.

71. The opposition under section 5(2)(b) fails.

Section 5(3)

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

> "5(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 (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark."

73. Section 5(3A) of the Act states:

> "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."

74. The Second and Third Earlier Marks qualify as earlier marks pursuant to section 6 of the Act. I also note that only the following goods are being relied upon for the opposition under section 5(3) of the Act:

The Second Earlier Mark

Class 13 Firearms, namely handguns and pistols, gun belts, gun cases, gun pouches; commemorative firearms; soft handgun cases; gun rugs; replica guns, framed half model guns; gun locks and trigger locks; recoil pads for shotguns/long guns; plastic "empty chamber" flags; plastic gun boxes; tear gas guns and starter pistols; CO2 pellet guns.

The Third Earlier Mark

Class 13 Firearms.

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

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

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

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas 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) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34.*

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

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

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation

> and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

76. The conditions of section 5(3) are cumulative. Firstly, the opponent's and applicant's marks must be identical or similar. Secondly, the opponent must show that the Second and Third Earlier Marks have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must have established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the Second and Third Earlier Marks being brought to mind by the later mark. Fourthly, assuming that the first, second and third conditions have been met, section 5(3) requires that one or more types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

77. The relevant date for the assessment under section 5(3) is the date of application i.e. 25 May 2022.

Reputation

78. In *General Motors*, Case C-375/97, the CJEU held that:

> "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."

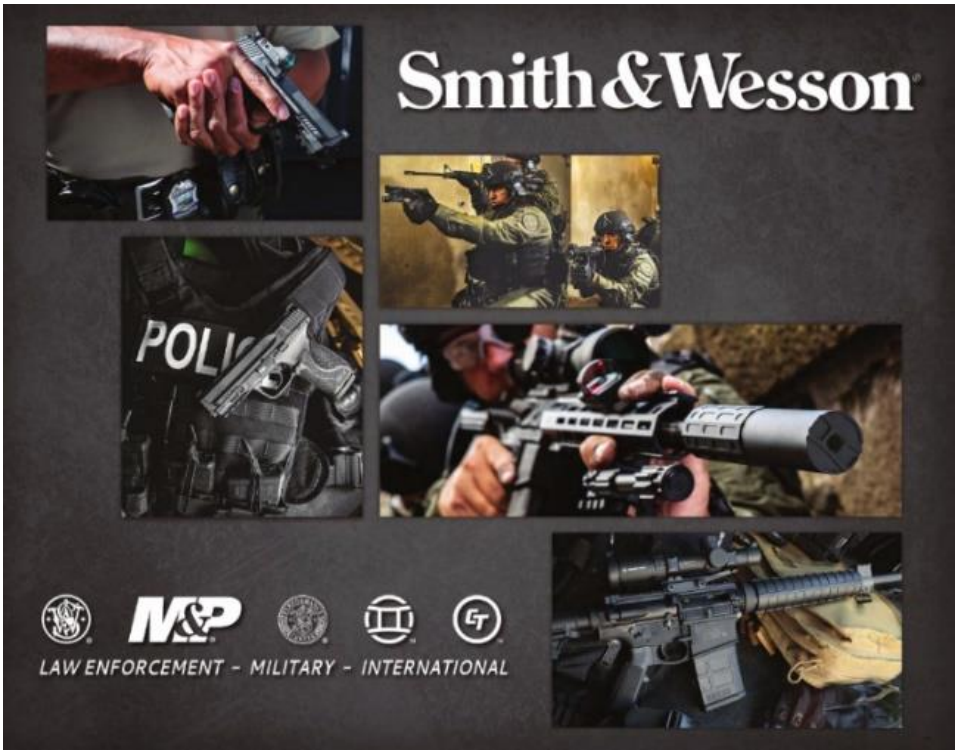
79. In determining whether the opponent has demonstrated a reputation for the goods in issue, it is necessary for me to consider whether its marks will be known by a significant part of the public concerned with the goods. In reaching this decision, I must take all of the evidence into account including "the market share held by the trade mark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertakings in promoting it."

80. I note that the Second Earlier Mark is a comparable UK trade mark (EU). Therefore, I can consider the evidence that both pertains to the EU until IP Completion Day (31 December 2020), and the UK, in order to determine its reputation in both territories. The Third Earlier Mark is a UKTM, therefore, it must have a reputation amongst a significant part of the UK public.

81. I note the following from the opponent's evidence:

a) Mr Perreault states that whilst the opponent "was initially known for revolvers", which they still produce, their range has expanded to include pistols, rifles and shotguns. The opponent's first pistol made was marketed in 1856 to 1857.

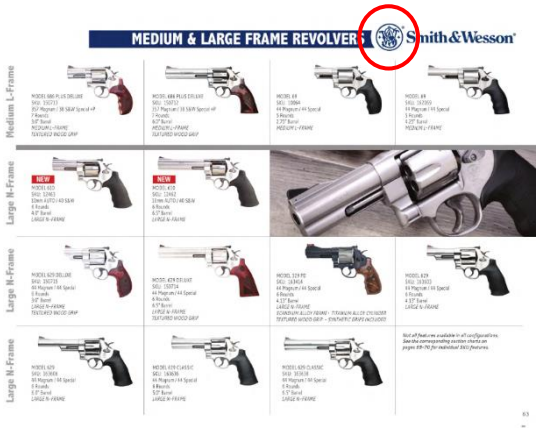
b) Mr Perreault states that **annex 1** contains the opponent's international catalogue from 2021. I note that the cover page is as follows:



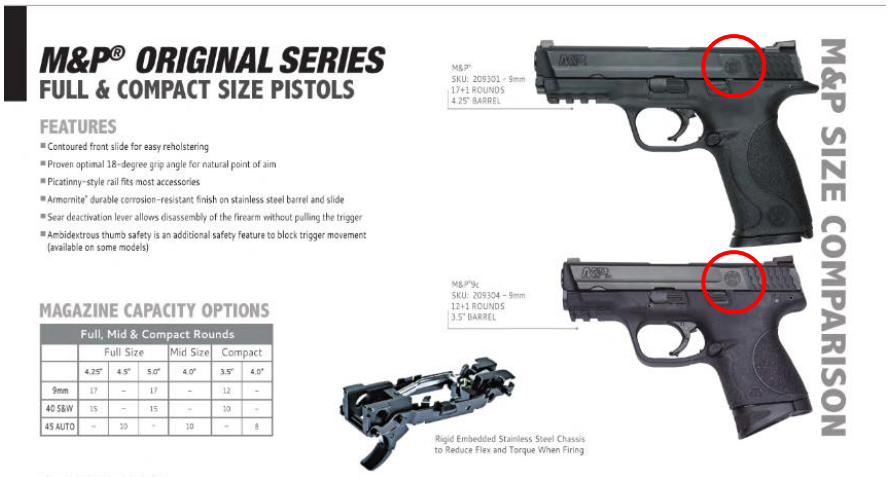
c) The catalogue contains different types of pistols, revolvers and rifles, as well as handcuffs. The majority of these goods are labelled as "M&P" (which is the opponent's sub-brand "Military & Police"), however, some of the pistols and revolvers are labelled as "S&W" as shown by following the table of contents:

d) I note that the S&W Governor Revolver on pages 66 to 67 uses the Second Earlier Mark (circled in red) as follows:

e) I also note that the Third Earlier Mark has been used on some of the catalogue pages (circled in red) as follows:



f) In paragraph 7 of his witness statement, Mr Perreault highlights that in the international catalogue it shows the M&P sub brand, and that “for the sake of clarity where a product features a sub brand such as M&P it will also include the Smith & Wesson branding including the stylised logo”. I consider that this submission is supported by the following example pages of the international catalogue whereby the M&P guns also have the Third Earlier Mark imprinted onto them (circled in red):



g) Mr Perreault states that the goods bearing the Third Earlier Mark for firearms are distributed in the UK by “Sportsman Gun Centre Ltd”.

h) Mr Perreault provides the following annual sales of goods branded with the Second Earlier Mark “in the United Kingdom since 2015 in Euros”:

Year	Sales values in the UK given in USD	
2012	Smith & Wesson Airguns	62,842.95
	Smith & Wesson Accessories (Mags, etc.)	2,619.67
		65,462.62
2013	Smith & Wesson Airguns	67,506.25
	Smith & Wesson Accessories (Mags, etc.)	2,815.31
		70,321.56
2014	Smith & Wesson Airguns	49,770.47
	Smith & Wesson Accessories (Mags, etc.)	2,804.69
		52,575.16
2015	Smith & Wesson Airguns	16,324.18
	Smith & Wesson Accessories (Mags, etc.)	2,810.86
		19,135.04
2016	Smith & Wesson Airguns	30,134.36
	Smith & Wesson Accessories (Mags, etc.)	4,191.20
		34,325.56

2017	Smith & Wesson Airguns	13,111.59
	Smith & Wesson Accessories (Mags, etc.)	97.29
		13,208.88
2018	Smith & Wesson Firearms	167,373.32
	Smith & Wesson Airguns	44,237.98
	Smith & Wesson Accessories (Mags, etc.)	2,034.35
		213,645.65
2019	Smith & Wesson Firearms	210,563.17
	Smith & Wesson Airguns	16,805.92
	Smith & Wesson Airsoft Guns	452.73
	Smith & Wesson Accessories (Mags, etc.)	911.85
		228,733.67
2020	Smith & Wesson Firearms	30,843.31
	Smith & Wesson Airguns	33,462.32
	Smith & Wesson Paintball Guns	9,104.16
	Smith & Wesson Airsoft Guns	1,858.11
	Smith & Wesson Accessories (Mags, etc.)	3,654.64
		78,922.54
2021	Smith & Wesson Firearms	182,653.00
	Smith & Wesson Airguns	62,755.92
	Smith & Wesson Paintball Guns	9,433.32
	Smith & Wesson Airsoft Guns	101,188.02
	Smith & Wesson Accessories (Mags, etc.)	2,657.65
		358,687.91
2022	Smith & Wesson Firearms	494,012.00
	Smith & Wesson Airguns	378,857.38
	Smith & Wesson Paintball Guns	2,616.00
	Smith & Wesson Airsoft Guns	178,366.72
	Smith & Wesson Accessories (Mags, etc.)	2,038.16
		1,055,890.26
2023 (January 1 – July 1)	Smith & Wesson Firearms	75,752.00
		75,752.00

i) Mr Perreault states that the opponent spends approximately $4,000-$5,000 on advertisements in Land Warfare International a publication by The Shephard Press Limited". Mr Perreault has not provided any clarification as to over what time period this amount is spent. I also note that the website for this is www.shephardmedia.com, but I have not been provided with any screenshot evidence in relation to this.

j) The approximate value of the promotional spend undertaken by the opponent's licensee Umarex GmbH & Co. KG. "to support goods sold by reference to the trade mark is estimated to be in the region of 2-3% of the total sales value. Therefore, given the values above this equates to" the following promotional spend:

Year	2%Promotional spend in the UK in USD	3%Promotional spend in the UK in USD
2012	1,309.25	1,963.88
2013	1,406.43	2,109.65
2014	1,051.50	1,577.25
2015	382.70	574.05
2016	686.51	1029.77
2017	264.18	396.27
2018	925.45	1388.17
2019	363.41	545.12
2020	961.58	1442.38
2021	3,520.70	5,281.05
2022	1,1237.57	1,6856.35

k) Mr Perreault states that advertising and marketing the opponent's products is very different to other sectors. There are specific events where the opponent's UK distributor represents them, such as at the British Shooting Show, which is an annual 3-day event at the NEC Birmingham, or the DSEI (Defence and Security Equipment International) which is a bi-annual convention hosted by Clarion Defence (UK) Limited.

l) **Annex 4** contains undated screenshots of the opponent's website, which is selling different types of firearms, with the Third Earlier Mark clearly used at the top left-hand corner:

m) This is supported by the following wayback machine screenshot dated 23 December 1996 which also uses the Third Earlier Mark in the background:

n) However, I appreciate that the date of the above screenshot is from a significantly long period of time before the relevant date.

o) Mr Perreault also provides the number of visitors that the opponent's website has had from January 2017 to May 2022:

MO/YR	Users	Oct-18	3636	Aug-20	5653
Jan-17	5345	Nov-18	3813	Sep-20	5060
Feb-17	4625	Dec-18	3640	Oct-20	5006
Mar-17	5105	Jan-19	4078	Nov-20	5437
Apr-17	4918	Feb-19	3772	Dec-20	4995
May-17	4792	Mar-19	6129	Jan-21	5613
Jun-17	4302	Apr-19	5399	Feb-21	4741
Jul-17	4525	May-19	4018	Mar-21	5026
Aug-17	4654	Jun-19	3374	Apr-21	4355
Sep-17	4342	Jul-19	3337	May-21	4768
Oct-17	5404	Aug-19	3697	Jun-21	7853
Nov-17	4492	Sep-19	3699	Jul-21	13725
Dec-17	4135	Oct-19	3708	Aug-21	12978
Jan-18	4735	Nov-19	3833	Sep-21	10015
Feb-18	5147	Dec-19	4095	Oct-21	11130
Mar-18	4908	Jan-20	5610	Nov-21	10821
Apr-18	3925	Feb-20	4427	Dec-21	10553
May-18	3548	Mar-20	4841	Jan-22	11347
Jun-18	3194	Apr-20	6114	Feb-22	5185
Jul-18	3621	May-20	5725	Mar-22	4719
Aug-18	3686	Jun-20	6229	Apr-22	4532
Sep-18	3533	Jul-20	5493	May-22	5726

p) **Annex 4** also contains screenshots of the opponent's social media platforms including YouTube, Instagram, Facebook, Twitter and Linkedin. Whilst Mr Perreault provides the amount of UK followers for each page, all of the screenshots are undated and therefore I am unable to determine the number of followers of each social media platform at the relevant date.

82. The evidence provided by the opponent is not without its limitations. For example, I have not been provided with any information as to how many of the international catalogues, which shows use of the Second and Third Earlier Marks, have been distributed in the UK (if any), and how many consumers would have seen them. I also note that whilst I have been provided with relatively low advertising figures, Mr Perreault has stated that advertising and marketing the opponent's products is very different to other sectors. I consider that this is most likely the case due to the strict laws around firearms in the UK. However, Mr Perreault has not provided any evidence of the ways in which they can advertise. He mentions that there are events where their UK distributor represents them and provides web links for these. Nevertheless, as

noted in the official letter from the registry dated 4 August 2023, “references to weblinks are not sufficient as the Hearing Officer will not undertake any independent research” and therefore if it is not filed in a durable form (such as print outs) “it will be disregarded in accordance with rules 62(2) and (3)”.

83. The UK sales figures provided in paragraph 81(h) above are not significantly high, but I consider that they are notable. I also consider that based upon the catalogue evidence, the opponent’s firearms are clearly sold under the Second and Third Earlier Marks. Therefore, taking all of the above into account, I consider that the above evidence is enough to conclude that the opponent has a limited reputation in the UK in relation to firearms under the Second and Third Earlier Marks.

Link

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

> The degree of similarity between the conflicting marks
>
> The Second Earlier Mark and the applicant’s marks are visually similar to between a low and medium degree, aurally similar to a high degree and conceptually neutral.
>
> The Third Earlier Mark (which is the same as the First Earlier Mark relied upon under section 5(2)(b)) and the applicant’s marks are (for a significant proportion of consumers) visually and aurally dissimilar, and conceptually neutral. However, for those who see the Third Earlier Mark as being composed of the letters S and W, the parties’ marks are visually similar to a very low degree, aurally identical and conceptually neutral.
>
> 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 and services, and the relevant section of the public

I note that all of the applicant's class 25, 26, 28, 32 and 35 goods and services are dissimilar to the opponent's firearms.

Class 25, 26, and 28 goods

The goods clearly do not overlap in nature, method of use or purpose as the opponent's goods are firearms which are weapons such as guns that are carried or held in the user's hand and used to fire a projectile. The applicant's clothing, hat bands and hair pins are to be worn on the user's body, including for fashionable purposes, the applicant's sports balls are used for sporting purposes and the applicant's sports drinks are consumed to quench the users' thirst. Whilst I note that the opponent's evidence shows that it is possible for there to be an overlap in trade channels, and that an undertaking could sell both firearms and clothing, I do not consider that this is common practice. I also do not consider that the same undertakings would sell firearms, hat bands, hair pins, sports balls and sports drinks. The goods are clearly neither in competition nor complementary. I therefore consider that they are dissimilar.

Class 32 and 35 services

The opponent's firearm goods and the applicant's marketing and retail services clearly do not overlap in nature, method of use or purpose. I do not consider that there would be an overlap in trade channels, and the goods and services are neither in competition nor complementary. Whilst there may be an overlap in user, this is not enough on its own to establish similarity. Therefore the goods and services are dissimilar.

The strength of the earlier marks' reputation

The opponent enjoys a limited reputation in the UK for firearms.

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

The Second Earlier Mark is inherently distinctive to a medium degree.

The Third Earlier Mark (which is the same as the First Earlier Mark relied upon under section 5(2)(b)) is inherently distinctive to a high degree.

I have summarised the opponent's evidence in paragraphs 81 to 83 above, in relation to the opponent's limited reputation for firearms. I recognise that reputation is not the same as enhanced distinctive character, but the same factors are to be taken into account in both assessments. Therefore, the evidence is, for the reasons set out above in relation to reputation, sufficient to slightly enhance the distinctiveness of the opponent's Second and Third Earlier Marks. On this basis, I find the Second Earlier Mark is inherently distinctive to between a medium and high degree, and the Third Earlier Mark is enhanced to just above a high degree.

Whether there is a likelihood of confusion

As there is no similarity of the goods and services, there can be no likelihood of confusion.

85. I am now required to determine whether, in this particular case, the relevant public would bring the Second and Third Earlier Marks to mind when confronted with the applicant's marks. That is, to make a link between them. However, the parties' goods and services are dissimilar, and the opponent's limited reputation is not strong enough to bridge the gap between them. I consider that the distance between the goods and services is sufficient to offset any similarity between the marks (which is limited to, at best, them sharing the letters S and W) and, therefore, I do not consider that the requisite link will be made in respect of the goods and services. As I have found there to be no link between the marks in the minds of the average consumer in the UK, there can be no resulting damage caused to the opponent's Second and Third Earlier Marks.

86. The opposition based upon section 5(3) fails.

CONCLUSION

87. The opposition is unsuccessful, and the application may proceed to registration.

COSTS

88. Award of costs are governed by TPN 2/2016. The applicant has been successful and would normally be entitled to a contribution towards their costs.

89. However, as the applicant is unrepresented, at the conclusion of the evidence rounds the tribunal wrote to the applicant and invited them to indicate whether they intended to make a request for an award of costs. The applicant was informed that, if so, they should complete a Pro Forma, providing details of their actual costs and accurate estimates of the amount of time spent on various activities associated with the proceedings. They were informed that "if the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time) may not be awarded".

90. The applicant did not file a completed Pro Forma and paid no official fees. That being the case, I make no award of costs in this matter.

Dated this 12th day of July 2024

L FAYTER

For the Registrar