

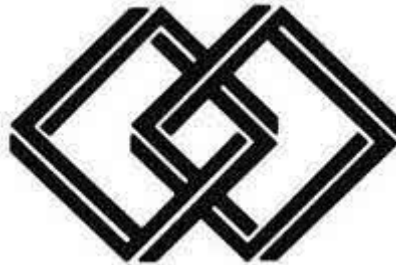
**O/0674/25**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF REGISTRATION NO. 3819949**

**IN THE NAME OF ASOS PLC**

**FOR THE FOLLOWING TRADE MARK:**



**IN CLASSES 14, 18 & 25**

**AND**

**AN APPLICATION FOR A DECLARATION OF INVALIDITY**

**UNDER NO. 506437**

**BY ERREA' SPORT S.P.A**

## **Background and pleadings**

1. ASOS plc (“the proprietor”) is the registered proprietor of UK trade mark registration number 3819949, which is shown on the cover page of this decision (“the proprietor’s mark”). The proprietor’s mark was filed on 15 August 2022 and became registered on 4 November 2022. It claims a priority date of 21 February 2022 (Liechtenstein). It stands registered for the following goods:

Class 14: Precious metals and their alloys; precious and semi-precious stones; horological and chronometric instruments; jewelry; body jewelry; bangles; bracelet; jewels with ornamental stones; jewelery containing precious and semi-precious stones; jewelry imitations; brooches being jewellery; chains being jewellery; jewelry amulets; chokers; earrings; bracelet; necklaces; tie clips; tie pins; cufflinks; costume jewellery; gems; decorative pins being jewellery; jewelry for the face; hat ornaments; foot jewelry; pins [jewellery]; medallions being jewellery; display coins being jewellery; medals; tie closures; rings being jewellery; shawl clips being jewellery; bracelet; chronometric instruments; clocks; wristwatches; chronographs for use as clocks; mechanical clocks; hanging clocks; pocket watches; watches to match clothing; electric clocks; clocks with memory function; clocks with telecommunication function; clocks with gps function; watch straps; watch straps; jewelry box; watch cases; cufflink cases; cases for tie pins; cases for clocks and watches; jewelry cases; key chains; key fobs; talismans for key rings and key chains; key chains for use as jewelry; fittings and accessories for the aforesaid goods.

Class 18: Leather and imitations of leather; luggage suitcases; bags; wallets and other carrier bags; general purpose carrier bags; sports bags; athletic bags; leather bags; imitation leather bags; all-purpose leather carry bags; all-purpose tote bags made of imitation leather; rucksacks; cosmetic bags sold empty; makeup

bags sold empty; empty shaving bags; credit card pockets; wallets; wallets for attachment to belts; purses; purses attached to the wrist; belt pouches; shoulder bags; handbags; leather laces; badges of leather; umbrellas and parasols; walking sticks; walking sticks; sticks with integrated seats; clothing for pets; components and accessories for the aforesaid goods.

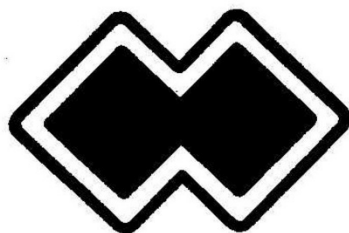
Class 25: Clothes, shoes, hats; sportswear; active wear; coats; jackets; dresses; hooded tops; sweatshirts; jeans; sweaters; cardigans; overalls; playsuits; hosiery; lingerie; underwear; sports bras; evening wear; pajamas; dressing gowns; sleep masks; leisure wear; shorts; skirts; socks; tights; suits; swimwear; beachwear; tops; tracksuits; pants; dungarees; sweatpants; chinos; leggings; vest; t-shirts; shirts; polo shirts; tunics; bibs, not of paper; tops; blouses; bodice; bralettes; camisole; corsets; capes; bikini tops; belts for clothing; suspenders for clothing; earmuffs; scarves; headdress; gloves; mittens; muffs; ties; hats; caps; caps; headbands; veil; bandanas; berets (berets); shower caps; earmuffs; boots; sports shoes; sneakers; sandals; shoes; shoes with heels; flip flops; slider sandals; sports shoes; footmuffs; fittings and accessories for the aforesaid goods.

2. On 18 August 2023, ERREA' SPORT S.p.A ("the applicant") made an application for a declaration of invalidity in respect of the proprietor's mark pursuant to section 47 of the Trade Marks Act 1994 ("the Act"). The application is based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Act. It is directed against the proprietor's goods in classes 18 and 25.

3. For the purposes of its claims under sections 5(2)(b) and 5(3), the applicant relies upon its UK trade mark registration number 909929845,<sup>1</sup> which is shown below:

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<sup>1</sup> The applicant's mark is a comparable mark based upon EU trade mark number 9929845. It was automatically created on 1 January 2021 in accordance with the Withdrawal Agreement between the UK and EU. The comparable mark is now recorded on the UK register (retaining its EU filing date) and has the same legal status as if it had been applied-for and registered under UK law.



(“the applicant’s mark”)

The applicant’s mark was filed on 29 April 2011 and became registered on 5 October 2011. It stands registered for a range of goods and services in classes 3, 9, 14, 16, 18, 25, 28, 35 and 41. For the purposes of the application, the applicant only relies upon the following goods:

Class 18: Bags; multipurpose sports bags; handbags; bags of leather and imitations of leather; small bags; canvas bags; bags for balls; bags; bags for campers; bags; travelling rugs; key holders; beach bags; bum-bags; cosmetic bags sold empty; school rucksacks; trunks; travelling bags; valises; rucksacks; umbrellas; walking sticks; parasols; leatherware; briefcases; satchels; sports bags; football bags.

Class 25: Sports clothing and leisurewear for men, women and children; jerseys; undershirts; t-shirts; tank-tops; sweatshirts; pullovers; polo-neck jerseys; shirts; skirts; trousers; shorts; bermuda shorts; jackets; coats; jeans; jerseys; ties; suits; combinations (clothing); full tracksuits for sports teams; training suits; sports kits; including kits for football; five-a-side football; volleyball; rugby and basketball; soccer clothing; five-a-side football; volleyball; rugby; basketball; tennis; cycling; golf; baseball; spinning; running and exercisewear in general not included in other classes; footwear; shoes; sports shoes; football boots and shoes; five-a-side football; volleyball; rugby; basketball; tennis; cycling; golf; baseball; spinning; running; gymnastics and exercise in general

not included in other classes; headwear; hats; caps; bonnets; head sweatbands; hats and berets for sport in general; bandannas; gloves (clothing); wristbands; socks; sweat-absorbent stockings; underwear; briefs; underpants; in particular for sport; namely leg warmers; bermuda shorts; elasticated t-shirts; beach clothes and swimwear; including bathing suits; swimming trunks; rainwear.

4. In its statement of grounds, the applicant contends that the competing marks are similar and the parties' goods are similar. On this basis, the applicant argues that there is a likelihood of confusion, including the likelihood of association, and requests that the proprietor's mark be declared partially invalid under section 5(2)(b).

5. Under section 5(3), the applicant claims that its mark enjoys a reputation in the UK in respect of all the goods relied upon. It submits that use of the proprietor's mark, without due cause, would take unfair advantage of, and/or be detrimental to, the repute and distinctive character of its marks. The applicant also argues that the relevant public would believe there is an economic connection between the users of the competing marks.

6. As for section 5(4)(a), the applicant claims that it has goodwill in relation to which it has used the signs shown below throughout the UK since 1994:



The applicant claims that these signs have been used in respect of *sports and fashion goods and accessories, which include clothes, headgear, footwear, bags, holdalls, cases, sports kit, wallets, document holders, towels, beachwear, sports supports, underwear*. The applicant contends that use of the proprietor's mark would be contrary to the law of passing off.

7. The proprietor filed a counterstatement denying the grounds of invalidity. It also puts the applicant to proof of use, reputation and goodwill in respect of its mark/signs.

8. Both parties are professionally represented; the applicant by Barker Brettell LLP and the proprietor by Rheia IP Limited. Both parties filed evidence. No hearing was requested but both parties filed written submissions in lieu. This decision is taken following careful consideration of all the papers before me.

### **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 applicant's evidence is given in the witness statements of Tracy Arch, together with three exhibits (TAA1-TAA3), and Rosanna Fabbiani, together with 12 exhibits (RF1-RD12). Ms Arch is a Trade Mark Attorney and Partner with the applicant's representatives. She provides evidence of sales of sportswear and leisurewear by the proprietor. Ms Fabbiani is the Managing Director of the applicant, having co-founded the company with her husband in 1988. She provides evidence of use of the applicant's mark/signs.

11. The proprietor filed evidence in the form of a witness statement from Amy Toms and 12 exhibits (AT1-AT12). Ms Toms is a Trade Mark Attorney at ASOS.com Limited, a wholly owned subsidiary of the proprietor, and has been Head of Trade Marks and Brand since September 2022. Ms Toms gives evidence of the proprietor's own history, commercial activities and recognition, as well as marketplace evidence (including use of third-party shape marks).

12. The applicant filed evidence in reply in the form of further witness statements from Ms Arch and Ms Fabbiani. The former is accompanied by one additional exhibit (TAA4), whilst the latter was filed alongside four additional exhibits (RF13-RF17). Ms Fabbiani provides more evidence on the applicant's goods, as well as evidence on the crossover between sportswear and leisurewear. Ms Arch produces a certified translation of one of the documents evidenced by Ms Fabbiani (that being RF17).

13. I have taken all the evidence into account in reaching my decision and will refer to it below where necessary.

### **Decision**

14. Sections 5(2)(b), 5(3) and 5(4)(a) of the Act have application in invalidation proceedings because of the provisions of section 47 of the Act, the relevant parts of which read as follows:

“47. (1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground—

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

[...]

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless—

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if–

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

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) 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.

[...]

(2E) 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.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c).

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are—

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

15. As the applicant’s mark is a comparable mark, paragraph 9 of part 1, Schedule 2A of the Act is relevant. It reads:

“9. (1) Section 47 applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the period of five years referred to in sections 47(2A)(a) and 47(2B) (the "five-year period") has expired before IP completion day–

(a) the references in section 47(2B) and (2E) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 47 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 47(2B) and (2E) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 47 to the United Kingdom include the European Union.”

16. The applicant’s mark qualifies as an ‘earlier trade mark’ pursuant to section 6(1) of the Act. As it had completed its registration process more than five years before the date on which the application for a declaration of invalidity was filed, it is subject to the use provisions set out above. Within its statement of grounds, the applicant made a statement of use in respect of all the goods relied upon. Within its counterstatement, the proprietor indicated that it would require the applicant to provide proof of use. Accordingly, I must first determine whether, or the extent to which, the applicant’s mark can be relied upon for its claims under sections 5(2)(b) and 5(3).

### **Proof of use**

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

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung 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]; *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]."

18. Section 100 of the Act is also relevant. It states:

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

19. Pursuant to the provisions set out above, the relevant periods for assessing whether there has been genuine use of the applicant’s mark are (i) the five-year period ending with the filing date of the application for invalidity, i.e. 19 August 2018 to 18 August 2023, and (ii) the five-year period ending with the priority date of the proprietor’s mark, i.e. 22 February 2017 to 21 February 2022.

20. Ms Fabbiani says that the applicant has been producing sportswear, accessories and leisurewear for over 36 years. A ‘Company Profile’ document has been provided, which includes a history of the applicant.<sup>2</sup> From this, I note that the applicant started in Parma, Italy, in 1988; set up a network of official dealers in 2002; opened its first single-branded store in Parma in 2005; and launched its first e-commerce site in 2013. The applicant’s mark can be seen throughout the document, both on its own and in conjunction with the word ‘errea’. It can be seen on a variety of sports clothing (including football shirts and rugby jerseys) and casual clothing.

21. Ms Fabbiani says that a core activity for the applicant is the manufacture and supply of custom match and training kits for sports teams, all sold under the name ‘ERREA’ and the applicant’s mark. In the UK, these custom goods are said to be sold through the applicant’s website (errea.com) and through an extremely large network of third-party sellers. In this connection, Ms Fabbiani provides the following:<sup>3</sup>

i) Printouts from the John Henry Sports website (UK), showing ‘ERREA’ branded training tops, training shorts, football socks, mitten gloves, tracksuits, rucksacks, jackets and hoodies. The applicant’s mark can be seen on the same.

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<sup>2</sup> Exhibit RF1

<sup>3</sup> Exhibit RF3

The printouts are undated, though I note that there are references to a 2022 'Teamwear Brochure' and the 2023 'ERREA' catalogue.

ii) A printout from the John Henry Sports Instagram page, showing an 'ERREA' branded football kit (top, shorts and socks) in a post dated 18 July 2019.

iii) Printouts from the Pro Soccer UK website, showing 'ERREA' branded socks, training tops, shorts, bags, jackets, football kits, footballs, t-shirts and polo shirts. The applicant's mark is visible on the goods. The printouts are undated.

iv) Printouts from the Total Teamwear UK website, showing 'ERREA' branded grip socks featuring the applicant's mark. The website states that this undertaking is a team/sportwear supplier based in Newport, Cardiff and Swansea. The printouts are undated.

v) A printout from the applicant's website, showing the locations of UK stores. There are numerous stores across the UK. The printout is not dated.

22. Ms Fabbiani says that the applicant is a well-known sponsor in the sporting industry. A document has been evidenced which shows the applicant's partnerships in 2017, 2018 and 2019.<sup>4</sup> Listed within the same are numerous football teams in, *inter alia*, England, Wales and Scotland; numerous national volleyball teams, including the Scottish national team; multiple rugby teams, including Wigan Warriors and the Wales national team; and other federations, including British Canoeing, Deaflympics GB and Archery GB. Sports news articles from *The Sun* and *The Guardian*, dated between 9 February 2022 and 15 August 2023, have also been provided; they contain photographs showing the applicant's mark on English football club kits.<sup>5</sup> In addition, articles from the applicant's website and the Rugby Shirt Watch website, dated 26 May 2019 and 18 October 2019, respectively, show the applicant's mark on the Wigan Warriors and Wales national team rugby league shirts.<sup>6</sup> An article from the UEFA website, dated 11 December 2020, discusses 'ERREA' being chosen as the UEFA Kit

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<sup>4</sup> Exhibit RF4

<sup>5</sup> Exhibit RF4

<sup>6</sup> Exhibit RF4

Assistance Scheme suppliers for 2022 to 2026; this means that the applicant was to supply football kits for Europe's national associations on the scheme during this period.<sup>7</sup> The applicant's mark can be seen on football shirts in the article. The aforementioned 'Company Profile' document also shows that the applicant sponsored Middlesbrough FC from 1994 to 2009; won 'Best Design in the Football League' for Burnley FC's away shirt in 2007; began producing national volleyball teams' kits in 2010, becoming the technical sponsor for the Italian men's and women's volleyball teams in 2017; and became technical sponsor of the Iceland football team in 2002, its shirts on display at Euro 2016 and the World Cup in 2018.

23. In the UK market, Ms Fabbiani says that much of the applicant's direct retail activity occurs online through its website. She provides printouts from the same, obtained via the Wayback Machine.<sup>8</sup> They are dated between 9 February 2019 and 6 June 2023. The applicant's mark is clearly displayed throughout. The mark can be seen on men's and women's tracksuits, trainers, shorts, hoodies, hats, jogging bottoms, jackets, sweatshirts, leggings and t-shirts. There is an option to select 'England' within the applicant's global website, and the UK is listed as one of the countries to which the applicant's goods can be delivered. Ms Fabbiani provides further printouts of the applicant's website alongside her second witness statement.<sup>9</sup> These were also obtained via the Wayback Machine and are dated between 2 September 2018 and 30 December 2020. The printouts show sports and casual clothing featuring the applicant's mark.

24. In addition to the applicant's website, Ms Fabbiani says that sales are made via third-party retailers. She provides a range of printouts from third-party websites,<sup>10</sup> but they are mostly undated. Those from within the relevant periods are dated 27 January 2022, 29 March 2023 and 4 February 2023 and are from the websites of Pro Soccer UK and Kitlocker. Whilst there is information about what goods were displayed on the webpages at those times (such as, for example, women's football kits or "lifestyle"), there are no images of the same.

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<sup>7</sup> Exhibit RF4

<sup>8</sup> Exhibit RF5

<sup>9</sup> Exhibit RF13

<sup>10</sup> Exhibit RF6

25. Extracts from a range of product catalogues and design books from between 2017 and 2023 have been evidenced.<sup>11</sup> The applicant’s mark (both with and without the word ‘errea’) can be seen in connection with tracksuits, polo shirts, hoodies, jogging bottoms, t-shirts, jackets, sweatshirts, shorts, sports socks, trainers, flip-flops and hats. The same kinds of goods can be seen in UK price lists for the applicant’s goods.<sup>12</sup> Some are from 2018 and 2019. Again, the applicant’s mark is clearly visible throughout the price lists, as well as on the goods themselves. One of the price lists is for the applicant’s “lifestyle” range, which appears to be casual (rather than sports) clothing; this price list is not dated, though Ms Fabbiani’s unchallenged narrative evidence is that the goods within were available for purchase “during the relevant period of time”. When read in the context of the rest of her statement, I take that to mean 2018 to 2023.

26. Ms Fabbiani provides a ‘statement of sale and advertising volume’, which she signed on behalf of the company.<sup>13</sup> From the same, I note the following sales figures:

<b>Year<sup>14</sup></b>	<b>Sales (Global)</b>	<b>Sales (GB)<sup>15</sup></b>
2013/2014	€52,173,343	-
2014/2015	€53,080,845	-
2015/2016	€52,706,043	-
2016/2017	€53,214,258	-
2017/2018	€58,324,097	-
2018/2019	€59,976,867	€6,739,857
2019/2020	€52,451,810	€5,442,634
2020/2021	€40,244,717	€6,953,611
2021/2022	€64,002,952	€5,615,848
2022/2023	€70,032,553	€8,463,654
<b>Total</b>	<b>€556,207,485</b>	<b>€33,215,604</b>

<sup>11</sup> Exhibits RF8 and RF14

<sup>12</sup> Exhibit RF10

<sup>13</sup> Exhibit RF7

<sup>14</sup> Each year runs from July to June, e.g. 1 July 2013 to 30 June 2014.

<sup>15</sup> I have rounded these figures to the nearest euro.

27. To support the sales figures, Ms Fabbiani provides a selection of invoices dated between 28 August 2018 and 27 July 2023.<sup>16</sup> They demonstrate the sale of clothing goods to customers based across the UK, in locations such as Manchester, London, Bristol, Norwich, Middlesbrough, Stoke, Bangor and Dundee. The applicant’s mark is clearly displayed at the top of each invoice. Some of the purchases were in small quantities, whilst others were in very large quantities and appear to have been for football clubs.

28. The following advertising spend figures are provided in the ‘statement of sale and advertising volume’:

<b>Year</b>	<b>Advertising Spend</b>
2013/2014	€474,084
2014/2015	€188,351
2015/2016	€593,741
2016/2017	€733,583
2017/2018	€613,889
2018/2019	€1,057,383
2019/2020	€734,730
2020/2021	€517,809
2021/2022	€590,636
2022/2023	€810,477
<b>Total</b>	<b>€6,314,683</b>

29. There is no breakdown for the UK, but Ms Fabbiani confirms that the advertising extends to “main European markets”, including the UK. Ms Fabbiani explains that these figures were spent on producing catalogues, price lists and leaflets, as well as purchasing articles and “general” advertising. She states that the figures do not include the applicant’s investment in partnerships, which represents a further significant commitment.

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<sup>16</sup> Exhibit RF9

30. Ms Fabbiani says that the applicant's goods have been referred to in magazine articles. She provides a selection of such materials, which includes the following:<sup>17</sup>

i) An extract from a wumagazine.com article featuring joggers credited to the applicant and adorned with the applicant's mark. It is dated "Ottobre 2018", which Ms Fabbiani confirms is October 2018.

ii) A photograph of a model wearing joggers credited to the applicant and adorned with the applicant's mark. The evidence does not show the date or origin of the photograph, but Ms Fabbiani says it is from *Vanity Fair*, 26 September 2018. According to statistics from ABC, in 2023 *Vanity Fair* had an average circulation of 44,989 in the UK and Ireland.<sup>18</sup>

iii) Extracts from *Sport Week*, said to be dated 27 October 2018, 22 September 2018 and 1 December 2018. The applicant's mark can be seen on clothing worn by sports people, as well as more casual joggers and jackets. Ms Fabbiani says that *Sport Week* is one of Italy's largest sports newspapers. A printout from Cairorcs Media says that it had an average circulation of 100,474 between August 2020 and July 2021.<sup>19</sup>

31. In addition to these magazine articles, Ms Fabbiani has provided printouts from the applicant's Instagram page.<sup>20</sup> There are posts dated between 24 May 2019 and 20 June 2023, in which the applicant's mark can be seen on t-shirts, polo shirts, sweatshirts, tracksuits, hoodies, jackets and trainers. The evidence does not show how many individuals liked the posts or how many followers the page has.

32. Furthermore, Ms Fabbiani says that the applicant showed a range of clothing for Fall/Winter 2023/2024 at Milan Fashion Week in collaboration with the designer Francesca Liberatore. Printouts from the applicant's website have been provided,<sup>21</sup> which show a press article about this; it is dated 27 February 2023 and includes

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<sup>17</sup> Exhibit RF11

<sup>18</sup> Exhibit RF11

<sup>19</sup> Exhibit RF11

<sup>20</sup> Exhibit RF16

<sup>21</sup> Exhibit RF11

images of models wearing clothing adorned with the applicant's mark. There are also images from the show in posts on the applicant's Instagram account.<sup>22</sup>

33. According to Ms Fabbiani, another marketing tool employed by the applicant was creating a giant football shirt to celebrate the launch of the ProEvolution Soccer videogame. The football shirt featured the applicant's mark and was unveiled in Milan in December 2007. On 8 January 2008, Guinness World Records officially recognised it as the largest in the world. The footballer Gianluigi Buffon was photographed with a replica of the shirt.<sup>23</sup>

34. In addition to appearing on sports kits, Ms Fabbiani says that the applicant's mark is prominently displayed on advertising boards and media at sports venues, courts and pitches. She says that these are seen when attending the events and through television coverage. Some images showing the applicant's mark within football stadiums have been provided in the body of Ms Fabbiani's statement, but they are not dated.

35. The evidence has its limitations. For instance, no details of the size of the relevant market have been provided or the share of that market held by goods sold under the applicant's mark. Some of the evidence is either undated or from outside of the relevant periods. Moreover, some of the printouts from the internet do not show the goods offered or the applicant's mark. I also note that the advertising figures are global in nature and Ms Fabbiani does not state what proportion of them are relevant to the UK (or EU). Finally, there is no indication as to the level of engagement with the applicant's social media posts or how many followers the applicant's Instagram had from the relevant territories during the relevant periods.

36. That being said, an assessment of genuine use is a global assessment, which involves looking at the evidential picture as a whole.<sup>24</sup> The evidence shows that various items of sports clothing adorned with the applicant's mark were offered for sale on third-party websites during the relevant periods. The applicant sponsored an

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<sup>22</sup> Exhibit RF16

<sup>23</sup> Exhibit RF12

<sup>24</sup> *New Yorker SHK Jeans GmbH & Co. KG v OHIM*, Case T-415/09

extensive list of UK-based sports teams during the relevant period (some of which were national in nature), and the evidence shows that these teams would have worn kits bearing the applicant's mark.

37. The applicant has also provided printouts from its own website, showing its mark on various items of sports and casual clothing offered for sale during the relevant periods. Further, the applicant's mark was clearly visible in product catalogues, design books and pricelists from the relevant periods concerning an extensive range of sports and casual clothing.

38. The evidence shows that the applicant accrued around €33 million from sales of such goods in the UK during the relevant periods. These figures are supported by invoices demonstrating the sale of clothing to UK customers during the relevant periods. Even in the context of what must be a very large market, this level of turnover appears significant.

39. Additionally, although the evidence regarding the advertising spend is limited, Ms Fabbiani has confirmed that at least some of the sums given were spent in this territory. Similarly, although the social media evidence is limited, it at least shows that there was an attempt to promote goods bearing the applicant's mark via Instagram during the relevant periods. Finally, goods bearing the applicant's mark appeared in *Vanity Fair* in the relevant periods. Whilst no circulation figures for that particular edition have been provided, the evidence shows that, towards the end of the later relevant period, it had an average circulation of nearly 45,000 in the UK and Ireland.

40. To my mind, it is clear that the applicant has attempted to create and maintain a market for goods bearing its mark. Whilst the applicant's mark was often used in conjunction with the word 'errea', use of a mark encompasses both its independent use and its use as part of another mark or in conjunction with that other mark.<sup>25</sup> Moreover, as the General Court ("GC") held in *Hyphen GmbH v EU IPO*, Case T-146/15:

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<sup>25</sup> *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, paragraphs 32-35

“58. The joint use of a figurative element and a word element on the same textile or clothing item does not undermine the identification function of the registered mark; it is not unusual in the clothing sector to juxtapose a figurative element with a word element linked to the designer or manufacturer, without the figurative element losing its autonomous identification function in the overall impression.”

41. Taking all of the evidence into account, I am satisfied that the applicant has demonstrated genuine use of its mark in respect of various items of sports and casual clothing.

42. I must now determine a fair specification for the applicant’s mark. In doing so, I acknowledge that fair protection is not to be achieved by identifying and defining particular examples of goods for which there has been genuine use but, rather, the particular categories of goods they should realistically be taken to exemplify.<sup>26</sup> I must consider how the average consumer would fairly describe the goods shown in evidence.<sup>27</sup>

43. The evidence shows that the applicant’s mark has been used in connection with an extensive range of clothing goods such as, *inter alia*, sports kits, tracksuits, shorts, hoodies, jackets, sweatshirts, leggings, t-shirts, polo shirts and socks. Some appear to have been specifically for use in sport, whilst others can fairly be described as casual clothing. There is no mention of children’s clothing and none of the evidenced clothing appears to have been for children. To my mind, the average consumer would fairly describe the goods shown in evidence as *sports clothing and leisurewear for men and women*.<sup>28</sup> The other clothing terms in class 25 either fall within the scope of this category (such as, for example, *sweatshirts, shorts* and *sports kits*) or have not been shown in evidence (such as, for example, *suits, briefs* and *beach clothes*).

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<sup>26</sup> *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10

<sup>27</sup> *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch)

<sup>28</sup> Although I have referred to ‘casual clothing’ in my assessment, the Cambridge Dictionary defines ‘leisure wear’ as clothes that are worn for relaxing in. It is my view that the clothing shown in evidence (excluding the sports clothing) would be covered by this term.

44. Although there are examples of headwear and footwear in the evidence, I do not consider these to be sufficient for the applicant to rely on *footwear; shoes; sports shoes; football boots and shoes; headwear; hats; caps; bonnets; head sweatbands; hats and berets for sport in general; bandannas*. Some have not been provided at all, whilst the occurrences of those which have been provided (such as trainers and beanie hats) are, in my view, too fleeting. There are no advertising or sales figures specifically provided in connection with these goods and the main focus of the evidence is clearly the applicant's clothing goods. In short, the evidence is not sufficiently solid in relation to these other goods.

45. It is not clear what is meant by the applicant's *including kits for football; five-a-side football; volleyball; rugby and basketball; five-a-side football; volleyball; rugby; basketball; tennis; cycling; golf; baseball; spinning; running [...]; five-a-side football; volleyball; rugby; basketball; tennis; cycling; golf; baseball; spinning; running; gymnastics and exercise in general not included in other classes*. It is possible that they are intended to form part of other terms, such as, for example, *sports kits*. However, given the punctuation that has been used, they appear as standalone terms. The terms describe different sports and activities, which are clearly not goods in class 25. They may not be relied upon by the applicant.

46. As for the applicant's class 18 goods, many of the same considerations apply as discussed at paragraph 44. There is no evidence of some of these goods being provided in connection with the applicant's mark (such as, for example, *parasols, briefcases and travelling rugs*). Although there are examples of bags in the evidence, I do not consider this to be sufficient for the purposes of the present assessment; the evidence is not sufficiently solid in relation to these goods.

47. Taking all of this into account, I find that the applicant may rely upon *sports clothing and leisurewear for men and women* for the purposes of the invalidation action.

## **Section 5(2)(b)**

### **Legislation and case law**

48. Sections 5(2)(b) and 5A of the Act read as follows:

“5(2) A trade mark shall not be registered if because -

[...]

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

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

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

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

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed

and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall 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**

50. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated, at paragraph 23 of its judgment, that:

“In assessing the similarity of the goods or services concerned, [...] 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.”

51. The relevant factors identified by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 for assessing similarity were:

- (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.

52. 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 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 that the responsibility for those goods lies with the same undertaking."

53. In *Gérard Meric v OHIM*, Case T- 133/05, the 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 für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark."

54. In *Gitana v OHIM*, Case T-569/11, the GC held that:

"45. Moreover, in respect of the relationship between the 'goods in leather and imitations of leather' in Class 18 covered by the trade mark sought and the goods in Class 25 covered by the earlier mark, it is apparent also from settled case-law that the 'goods in leather and imitations of leather' include clothing accessories such as 'bags or wallets' made from that raw material and which, as such, contribute, with clothing and other clothing goods, to the external image ('look') of the consumer concerned, that is to say coordination of its various components at the design stage or when they are purchased. Furthermore, the fact that those goods are often sold in the same specialist sales outlets is likely to facilitate the perception by the relevant consumer of the

close connections between them and support the impression that the same undertaking is responsible for the production of those goods. It follows that some consumers may perceive a close connection between clothing, footwear and headgear in Class 25 and certain 'goods made of these materials [leather and imitations of leather] and not included in other classes' in Class 18 which are clothing accessories. Consequently, clothing, shoes and headgear in Class 25 bear more than a slight degree of similarity to a category of 'goods made of these materials [leather and imitations of leather] and not included in other classes' in Class 18 consisting of clothing accessories made of those materials (see, to that effect, *PiraÑAM diseño original Juan Bolaños*, paragraph 42 above, paragraphs 49 to 51; *exē*, paragraph 42 above, paragraph 32; and *GIORDANO*, paragraph 42 above, paragraphs 25 to 27)."

55. The goods to be compared can be found at paragraphs 1 and 47.

56. Within its counterstatement, the proprietor accepts that the parties' goods are identical and/or similar. However, this is based on the applicant's specification as it appears in the register. The proprietor does not comment upon which of the goods are identical and which are only similar, or the level of similarity that exists between them. Moreover, the applicant's specification is now narrower as a result of my proof of use assessment. Without further detail from the proprietor, it is not clear whether it would concede that all its goods are identical or similar to the applicant's reduced specification. As such, I do not consider the proprietor's previous concession to be binding on me; I will proceed to conduct a full comparison in the ordinary way.

57. Before doing so, however, I note that the proprietor's comments in its counterstatement contained a caveat to the effect that its goods are only sold through its own website, meaning that the average consumer is highly unlikely to encounter the competing marks together. Within its written submissions, the proprietor also sought to distinguish the parties' goods by reference to their target markets. I must clarify that these matters will have no material bearing on the comparison which follows, nor can they in law. This is because, when assessing the likelihood of confusion, it is necessary to consider all the circumstances in which a mark might be

used.<sup>29</sup> Furthermore, since the way goods are marketed may vary in time and depend upon the wishes of the parties (or any potential successors in title), it is not appropriate to take into account the way in which the goods are actually marketed.<sup>30</sup> As a result, even though the proprietor has suggested the ways in which its mark may be used, the following comparison must take into account only goods for which the proprietor's mark is registered, as they appear in the register, and the applicant's goods framed by the fair specification. Any differences between the actual goods provided by the parties, their target markets, or how they reach those markets, are not relevant unless those differences are apparent from the competing specifications.

### Class 18

58. The proprietor's *bags; leather bags; imitation leather bags; all-purpose tote bags made of imitation leather; shoulder bags; handbags* could all be conceived by consumers as aesthetically complementary accessories to the applicant's [...] *leisurewear for men and women*. The respective goods are likely to be sold in the same retail outlets and consumers may expect them to be produced by the same undertakings. In view of this, I find that there is a low degree of similarity between the respective goods.

59. To my mind, the same cannot be said for the proprietor's *luggage suitcases; wallets and other carrier bags; general purpose carrier bags; sports bags; athletic bags; all-purpose leather carry bags; rucksacks; cosmetic bags sold empty; makeup bags sold empty; empty shaving bags; credit card pockets; wallets; wallets for attachment to belts; purses; purses attached to the wrist; belt pouches; components and accessories for the aforesaid goods* or for the *components and accessories for [...] the goods* I have discussed at paragraph 58. Although some of these goods are also bags, I do not consider that they would be sought to create a coordinated look with the applicant's *sports clothing and leisurewear for men and women*. Moreover, at least some of these goods (such as, for example, component parts for bags) are likely

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<sup>29</sup> *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06

<sup>30</sup> *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P

to reach the market through different trade channels to the applicant's goods and have different users. I find that there is no similarity between the respective goods.

60. As for the proprietor's *leather and imitations of leather; leather laces; badges of leather; umbrellas and parasols; walking sticks; walking sticks; sticks with integrated seats; clothing for pets; components and accessories for the aforesaid goods*, there is no obvious overlap in nature, method of use or intended purpose with the applicant's clothing goods.<sup>31</sup> Even if some of them are offered by large retail establishments who also offer clothing, they are unlikely to be found in the same sections of those outlets. Users may overlap, though only on a very general level. They are not in competition with one another. Moreover, they are not complementary in the sense outlined in the authorities. Taking all of this into account, I find that the respective goods are dissimilar.

#### Class 25

61. Although worded slightly differently, the proprietor's *sportswear and leisure wear* describe the same goods as the applicant's *sports clothing and leisurewear for men and women*. These goods are identical.

62. The proprietor's *active wear* refers to clothes that are worn for sports or other physical activities.<sup>32</sup> The term may be expressed differently to the applicant's *sports clothing [...] for men and women* but describes the same goods. These goods are identical.

63. The proprietor's *clothes* is a broad category which encompasses the applicant's *sports clothing and leisurewear for men and women*. These goods are to be regarded as identical in accordance with *Meric*.

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<sup>31</sup> In particular, even though the applicant's goods may be manufactured using leather or imitations thereof, that does not, in itself, mean that the respective goods are similar in nature: *Les Éditions Albert René v OHIM*, Case T-336/03, paragraph 61.

<sup>32</sup> <https://dictionary.cambridge.org/dictionary/english/activewear>

64. The proprietor's *coats; jackets; hooded tops; sweatshirts; sweaters; cardigans; underwear; sports bras; shorts; skirts; socks; swimwear; beachwear; tops; tracksuits; pants; sweatpants; leggings; vest; t-shirts; shirts; polo shirts; tops; bikini tops* fall within the scope of the applicant's *sports clothing and leisurewear for men and women*, since they are all particular types of sportswear or leisurewear. As such, they are identical under the principle outlined in *Merix*. If that is not correct and some of these goods cannot accurately be described as sportswear or leisurewear, the respective goods remain highly similar. This is because they overlap in nature, purpose, method of use, trade channels and user. They are all items of clothing which are worn on the body and reach the market through the same retail outlets. They may also be produced by the same undertakings. Furthermore, if they are not the same goods, they will be in competition. For example, a consumer could reasonably choose a sports t-shirt over a regular t-shirt, and vice versa.

65. I do not consider that the proprietor's *pajamas; dressing gowns; suits; dresses; jeans; overalls; playsuits; hosiery; lingerie; evening wear; tights; dungarees; chinos; tunics; blouses; bodice; bralettes; camisole; corsets; capes* can fairly be described as sportswear or leisurewear. However, they still overlap in nature, method of use, intended purpose and user with the applicant's goods, notwithstanding the different settings they are likely to be worn in. The respective goods are likely to reach the market through the same trade channels and may be produced by the same undertakings. Taking all of this into account, I find that there is between a medium and high degree of similarity between the respective goods.

66. The proprietor's *shoes, hats; sleep masks; belts for clothing; suspenders for clothing; earmuffs; scarves; headdress; gloves; mittens; muffs; ties; hats; caps; caps; headbands; bandanas; berets (berets); earmuffs; boots; sports shoes; sneakers; sandals; shoes; shoes with heels; flip flops; slider sandals; sports shoes; footmuffs* can all be broadly described as items of footwear, headwear, or fashion accessories. They differ in nature with the applicant's goods, which are items of clothing. However, there is an overlap in method of use to the extent that they are worn on the body. There is also a degree of overlap in purpose, given the respective goods are all worn for, *inter alia*, their aesthetic properties. The respective goods share trade channels and may be located near items of leisurewear or sportswear, though I accept that this

may not always be the case. They are not in competition. Moreover, I do not consider them to be complementary; whilst clothing and accessories can have a sufficiently close connection to give rise to such a relationship, this is typically where they are both used to create a co-ordinated look. I do not consider that to be the case here. In light of all this, I find that there is a medium degree of similarity between the respective goods.

67. The proprietor's term *veil* also refers to an item of headwear. Again, these goods differ in nature when compared with the applicant's goods, being items of clothing. There is an overlap in method of use and purpose insofar as the respective goods are worn on the body for, *inter alia*, aesthetic properties. Users are likely to overlap, albeit on a relatively general level. There is no evidence as to how the proprietor's goods reach the market. In the absence of such evidence, it is my view that these goods are likely to reach the market through rather niche outlets, such as, for example, bridal shops, rather than outlets offering sports clothing or leisurewear. The respective goods are not in competition. Moreover, I do not consider the relationship between the respective goods to be such that they are complementary. They are not important or indispensable to one another, and I do not consider that veils and sports clothing or leisurewear are typically used to create a co-ordinated look. All in all, I find that there is a low degree of similarity between the respective goods.

68. The proprietor's *bibs, not of paper* include bibs worn for sports. They overlap in nature, method of use and purpose with the applicant's *sports clothing [...] for men and women*. This is on the basis that they may both be made from the same materials and worn on the body whilst playing sport. They are likely to reach the market through the same trade channels, such as sports retailers. Moreover, they are likely to be produced by the same undertakings; for instance, an undertaking producing training kits for football is also likely to produce bibs to be worn for football training. The respective goods share users. They are not in competition. Furthermore, I do not consider them to be complementary, since they are not important or indispensable to one another. Taking all of this into account, I find that there is between a medium and high degree of similarity between the respective goods.

69. In addition to the goods compared above, the proprietor's specification includes the term *fittings and accessories for the aforesaid goods*. This term differs from the actual goods, since they are not finished articles which are ready to wear. Rather, they are fittings and accessories for various items of clothing, footwear and headwear. They are removable and can be sold separately. The fittings and accessories of the proprietor's goods may target the same users and reach the market through the same trade channels as the applicant's goods. Whilst they are not in competition, there is scope for a degree of complementarity. This is on the basis that the fittings and accessories may be considered important to the applicant's complete products (or vice versa) and consumers may believe that responsibility for them lies with the same undertakings. Overall, I find that there is between a low and medium degree of similarity between them.

70. That leaves the proprietor's *shower caps; fittings and accessories for the aforesaid goods*. There is a very general overlap in nature and method of use between the same and the applicant's *sports clothing and leisurewear for men and women* to the extent that they are both technically worn on the body. These goods also share users in a broad sense. However, they are likely to be made from different materials and are worn for entirely different purposes. They may both be sold in large retailers, though are typically located in different sections of those outlets. The respective goods are not in competition. In addition, they are not important to the use of one another and, as such, are not complementary. Taking all of these factors into account, I do not consider that the superficial overlaps in nature and method of use are sufficient to result in any meaningful similarity between the respective goods overall; I find that they are dissimilar.

71. Some degree of similarity between goods is necessary to engage the test for likelihood of confusion; if there is no similarity at all, there is no likelihood of confusion to be considered under section 5(2)(b).<sup>33</sup> My findings above mean that this ground cannot proceed in respect of the following goods:

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<sup>33</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, paragraph 49

Class 18: Leather and imitations of leather; luggage suitcases; wallets and other carrier bags; general purpose carrier bags; sports bags; athletic bags; all-purpose leather carry bags; rucksacks; cosmetic bags sold empty; makeup bags sold empty; empty shaving bags; credit card pockets; wallets; wallets for attachment to belts; purses; purses attached to the wrist; belt pouches; leather laces; badges of leather; umbrellas and parasols; walking sticks; walking sticks; sticks with integrated seats; clothing for pets; components and accessories for the aforesaid goods; components and accessories for bags, leather bags, imitation leather bags, all-purpose tote bags made of imitation leather, shoulder bags and handbags.

Class 25: Shower caps; fittings and accessories for the aforesaid goods.

### **The average consumer and the purchasing process**

72. As the authorities indicate, I must determine who the average consumer is for the parties' goods and how they are likely to select those goods. The average consumer has been described in the following terms:<sup>34</sup>

“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 [...] 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.”

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<sup>34</sup> *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), paragraph 60

73. The average consumer of the goods at issue is a member of the general public.<sup>35</sup> The goods are likely to be purchased relatively frequently. Although the associated cost will vary, overall, they are relatively inexpensive and, as such, the purchasing process will not require an overly considered thought process. That being said, the average consumer will consider factors such as style, quality, size, fit and compatibility with other items when making a selection. In light of the foregoing, I find that the average consumer will demonstrate a medium level of attention.

74. The goods are typically sold in physical retail establishments and their online equivalents, where the goods are self-selected from rails and shelves, or after viewing images and information on webpages. As the GC stated in *New Look Limited v OHIM*, Cases T-117/03 to T-119/03 and T-171/03:

“50. [...] Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

In accordance with this, I find that visual considerations will dominate the purchasing process, but I do not discount aural considerations entirely.

### **Distinctive character of the earlier mark**

75. In *Lloyd Schuhfabrik Meyer*, 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

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<sup>35</sup> Whilst professionals and/or other businesses may also be relevant consumers of the goods at issue, they are likely to exhibit a higher level of attention than the general public. As it is the group with the lowest level of attention that must be taken into account in the global assessment, I will focus only on the general public for the purposes of this decision (see, for example, *Soundio A/S v EUIPO*, Case T-665/18, paragraph 24).

overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

76. Registered trade marks possess varying degrees of inherent distinctive character. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion.

77. The applicant’s mark is figurative and consists of a device, being two conjoined square/diamond shapes within a border outline. The distinctiveness of the mark lies in the device itself. Although the mark does not simply consist of standard geometric shapes, it is not particularly complex. There is no real semantic content. Overall, I find that the applicant’s mark has between a low and medium level of inherent distinctive character.

78. Evidence has been filed and I am now required to consider whether the applicant has demonstrated that its mark had an enhanced level of distinctive character at the relevant date, that being 21 February 2022.

79. I have already assessed the evidence and found that it demonstrates genuine use of the applicant's mark in the five years preceding the relevant date (as well as between 19 August 2018 and 18 August 2023). I acknowledge that the burden for establishing enhanced distinctive character is a much heavier one. This is because it requires a level of knowledge of the mark amongst average consumers leading to the mark having a greater capacity to identify the goods as coming from a particular undertaking, not simply that there has been an attempt to create or maintain a market for goods under the mark. I also accept that, as previously outlined, the evidence is not without its limitations.

80. Nonetheless, I remind myself that various items of sports and casual clothing adorned with the applicant's mark were offered for sale on the websites of the applicant and third parties before the relevant date. The applicant generated up to around €24 million in turnover before the relevant date;<sup>36</sup> even in the context of what must be a very large market, this level of turnover appears significant. The supporting invoices demonstrate that sales of goods bearing the applicant's mark were geographically widespread in the UK (albeit not particularly longstanding). Moreover, the applicant's mark adorned the kit of an extensive list of UK-based sports teams before the relevant date. Under this assessment, I also take into account the applicant's sponsorship of Middlesbrough FC between 1994 and 2009 and its award-winning kit for Burnley FC in 2007.<sup>37</sup> To my mind, given the extensive (and, in some cases, longstanding) sports sponsorships, it is highly likely a significant number of people in the UK were exposed to the applicant's mark prior to the relevant date.

81. On the balance of all the evidence, I am satisfied that the distinctive character of the applicant's mark had been enhanced above its inherent characteristics at the relevant date. However, given the evidential limitations (such as, for instance, the lack of any specific advertising figures or market share information), I am only able to conclude that this enhancement was to a medium level.

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<sup>36</sup> Although this figure differs from that given at paragraph 38, this is to reflect the fact that the turnover from 2022/2023 was generated through sales after the relevant date, as well as a proportion of those from 2021/2022 which likely occurred after the relevant date (given that the accounting period for that year runs until 30 June 2022).

<sup>37</sup> Whilst these did not factor into my assessment of genuine use, an assessment of enhanced distinctive character is not limited to any specific five-year period(s).

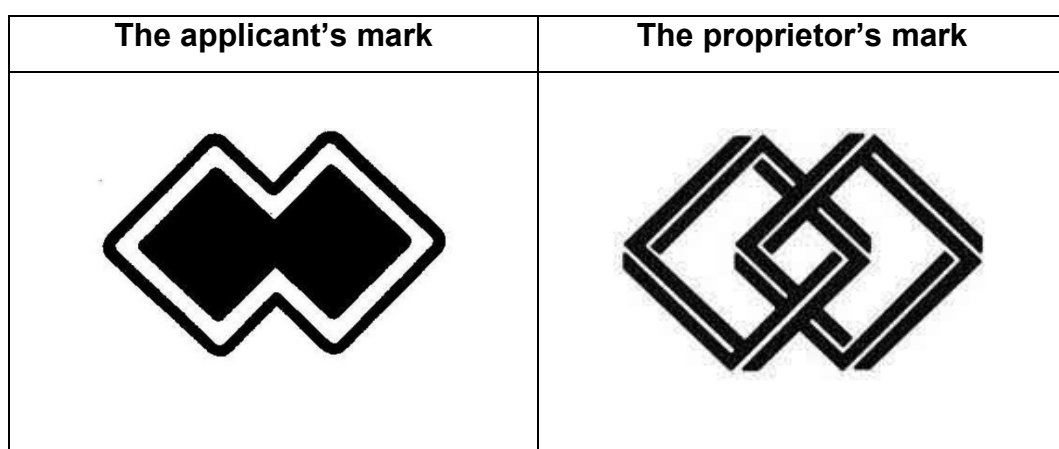
## Comparison of trade marks

82. It is clear from *Sabel* that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo* 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.”

83. Therefore, it would be wrong to dissect the trade marks artificially, though it is necessary to take into account the distinctive and dominant components of the marks; due weight must be given to any other features which are not negligible and hence contribute to the overall impressions created by the marks.

84. The marks to be compared are as follows:



85. The applicant's mark is figurative and consists of a device, being two conjoined square/diamond shapes within a border outline. The shapes and border outline are

black, whilst the space in between is white. There are no other elements which contribute to the overall impression, which lies in the device itself.

86. The proprietor's mark is figurative and consists of a device, being two interlinked square/diamond shapes. They are black with a white thin line detail, whilst the interior is white. The overall impression of the mark lies in the device itself.

87. Visually, the marks are similar in that the devices are both roughly the same shape, i.e. the overall impact both marks create is two conjoined squares/diamonds. The competing marks are visually different insofar as the more specific design features are different. For instance, the applicant's mark has a block black interior, whereas the two shapes interlink/overlap at the centre of the proprietor's mark. Balancing the similarities against the differences, I find that there is a medium degree of visual similarity between the competing marks.

88. There are no verbal elements in the competing marks and, to my mind, consumers will make no attempt to articulate the respective devices.<sup>38</sup> As such, the aural position is neutral.

89. For a conceptual message to be relevant, it must be capable of immediate grasp.<sup>39</sup> The roughly square/diamond shapes in the marks do not convey any clear and obvious meaning. In my view, as neither of the marks has any real semantic content, the conceptual position is, effectively, neutral.

### **Likelihood of confusion**

90. 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. One such factor is the interdependency principle, i.e. a lesser degree of similarity between the competing marks may be offset by a greater degree of similarity between the respective goods, and vice versa. As mentioned above, it is

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<sup>38</sup> *Dosenbach-Ochsner AG Schuhe und Sport v OHIM*, T- 424/10, paragraph 46

<sup>39</sup> *The Picasso Estate v OHIM*, Case C-361/04 P

necessary for me to keep in mind the distinctive character of the applicant's mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be mindful 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 they have retained in their mind.

91. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. In *L.A. Sugar Limited v By 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 recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

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

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite

distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

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

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

92. These three categories are not exhaustive. Rather, they were intended to be illustrative of the general approach.<sup>40</sup> However, indirect confusion has its limits; such a finding should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark.<sup>41</sup> It has also been emphasised that, where there is no direct confusion, there must be a proper basis for finding indirect confusion.<sup>42</sup>

93. Earlier in this decision, I concluded that:

- The parties’ goods are identical or similar to at least a low degree;
- The average consumer is a member of the general public, who will demonstrate a medium level of attention during the purchasing process;
- The purchasing process is likely to be predominantly visual in nature, though aural considerations have not been excluded;

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<sup>40</sup> As was confirmed by the Court of Appeal in *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, paragraph 12.

<sup>41</sup> *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

<sup>42</sup> See the Court of Appeal’s comments in *Liverpool Gin Distillery*, paragraph 13.

- The applicant's mark has between a low and medium level of distinctive character, which has been enhanced to a medium level through use;
- The overall impressions of the competing marks lie in the respective devices themselves;
- The competing marks are visually similar to a medium degree, whereas they are aurally and conceptually neutral.

94. Within its counterstatement, the proprietor argues that the relevant public is accustomed to noticing differences between trade marks consisting of geometric shapes. It also highlights that there are a number of such trade marks which, according to the proprietor, co-exist on the register. Examples of such trade marks are annexed to the proprietor's counterstatement, and I note that Ms Toms also provides a list of geometric trade mark registrations along with printouts from the websites associated with them.<sup>43</sup> This line of argument was also taken in the proprietor's written submissions, within which it argues that consumers are well-versed in differentiating between logos and brands used in the same sector, and that the evidence demonstrates that relatively simple designs can be readily identified by consumers.

95. I must clarify that the mere existence of these other registrations will not carry any weight in the global assessment which follows.<sup>44</sup> Moreover, the evidence provided by Ms Toms falls a long way short of establishing that the marks identified are actually in use and that consumers have become accustomed to differentiating between them. The printouts from third-party websites are all undated and it is not clear whether at least some of the websites target the UK. Nothing else has been provided which could indicate that the average consumer is more attuned to noticing small differences between geometric trade marks. As such, I reject this line of argument.

96. Turning to the global assessment, I acknowledge that there are differences between the competing marks. As previously outlined, the more specific design

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<sup>43</sup> Exhibit AT10

<sup>44</sup> See the GC's comments in *Zero Industry Srl v OHIM*, Case T-400/06, paragraph 73

features in the respective devices differ. I also accept that the applicant's mark is factually distinctive to no more than a medium degree. Nevertheless, the competing marks both roughly consist of two conjoined squares or diamonds and have the same (or a very highly similar) peripheral shape. Considering the level of visual similarity between the competing marks, the imperfect recollection of the average consumer, and the goods not being an overly considered purchase, it is my view that the more specific design features may not be sufficient to distinguish the proprietor's goods from those of the applicant. In my view, the average consumer – paying no more than a medium level of attention when encountering the marks visually – may not recall the competing marks with sufficient accuracy to differentiate between them. To my mind, it is likely that the average consumer may misremember or imperfectly recall the specific design features (such as whether the interior is black or white, or whether the interior corners of the square/diamond shapes overlap). The average consumer is most likely to accurately recall the rough shapes and positioning thereof, as well as the overall shape of the device as a whole. In consideration of all the above, I find that there is a likelihood of direct confusion, even in respect of goods that are similar to a low degree.

97. Even if the average consumer immediately notices and recalls the different design features in the competing marks, they will also recognise the shared use of two conjoined roughly square/diamond shapes and the same (or very highly similar) peripheral shape. Whether consciously or unconsciously, this will lead the average consumer through the mental process described above in *L.A. Sugar*. It is my view that the differences between the competing marks lend themselves to the use of variant brands or a re-branding exercise; when encountering the marks visually and paying no more than a medium level of attention, the average consumer may view the proprietor's mark as a variant, or an updated version, of the applicant's mark with more detailed design features. I am satisfied that, on this basis, the average consumer may assume a commercial association between the parties. Consequently, I consider there to be a likelihood of indirect confusion, even in relation to goods that are similar to a low degree.

## **Conclusion**

98. The applicant's claim under section 5(2)(b) is partially successful.

## **Section 5(3)**

### **Legislation and case law**

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

“(3) A trade mark which-

is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.

100. Section 5(3A) states:

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected”.

101. As the earlier trade mark is a comparable mark, paragraph 10 of Part 1, Schedule 2A of the Act is relevant. It reads:

“10.— (1) Sections 5 and 10 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the reputation of a comparable trade mark (EU) falls to be considered in respect of any time before IP completion day, references in sections 5(3) and 10(3) to—

(a) the reputation of the mark are to be treated as references to the reputation of the corresponding EUTM; and

(b) the United Kingdom include the European Union.”

102. 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'Oréal v Bellure*, Case C-323/09, *Marks and Spencer v Interflora* and Case C-383/12P, *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-Salomon*, 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'Oréal 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'Oréal v Bellure*).

103. The conditions of section 5(3) are cumulative. Firstly, the applicant must show that its mark is similar to the proprietor's mark.<sup>45</sup> Secondly, the applicant must show that its mark has achieved a level of knowledge, or reputation, amongst a significant part of the public. Thirdly, the applicant must establish that the public will make a link between the marks, in the sense of its mark being brought to mind by the proprietor's mark. Finally, assuming the foregoing conditions have been met, section 5(3) requires that one or more types of damage claimed by the applicant will occur. It is not necessary for the purposes of section 5(3) that the goods are 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.

104. The relevant date for the assessment under this ground is the priority date claimed by the proprietor's mark, that being 21 February 2022.

## **Reputation**

105. In *General Motors*, 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.

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<sup>45</sup> Given my findings at paragraphs 85 to 89, this condition is satisfied.

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.”

106. Firstly, I do not accept the proprietor’s submission that the applicant cannot have a reputation because i) it did not appear in the top 20 sports/outdoor retailers in a Statista Consumer Insights report in 2023, ii) no results were found on the websites of some of those retailers for ‘errea’, or iii) a search on Google for ‘errea uk’ predominantly returned results relating to the applicant’s own website.<sup>46</sup> The Statista report was based on an online survey of only 1,243 respondents, with no indication as to what questions or prompts the respondents were given. Moreover, the printouts from Decathlon, Footlocker, Go Outdoors, JD Sports, Regatta and Sports Direct are not dated, so do nothing to show the position at the relevant date. In any event, merely because a certain brand is not available through a selection of websites does not establish that the mark has no reputation; it may be the case that knowledge amongst the relevant public has been created through other means. Finally, the Google search results are not dated. As such, they cannot be relied upon as showing the position at the relevant date. In addition, it is my understanding that internet searches use algorithms which become tailored to a user based upon their search history; search results will also vary over time and are dependent upon who is doing the search.

107. I have already assessed the applicant’s evidence. For the same reasons as given at paragraph 80, I am satisfied that the applicant’s mark had a qualifying reputation in the UK at the relevant date in respect of *sports clothing and leisurewear for men and women*. However, on the balance of the evidence before me, I find that this reputation was no more than moderate.

108. I do not agree with the proprietor’s submission that such a reputation should be limited to those with an awareness of the professional sporting industry. This is because the goods shown in evidence are not limited to professional sports clothing;

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<sup>46</sup> Evidence in support of this submission is at Exhibits AT11 and AT12

as previously explained, there is also evidence of more casual clothing of the kind which is available to the general public. Even if the evidence was limited to the professional sports clothing, I have already indicated that the extent of the applicant's sports sponsorships is highly likely to have led to a significant number of people in the UK being exposed to the applicant's mark. This is particularly the case, given that sports kits are generally visible to individuals watching the sports (including members of the general public). To my mind, restricting the applicant's reputation to being only amongst those in the professional sporting industry would be artificial.

## **Link**

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

### The degree of similarity between the conflicting marks

I have found that there is a medium degree of visual similarity between the competing marks. The aural and conceptual position is 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 or services, and the relevant section of the public

I have found that the parties' goods are identical or similar to at least a low degree. The goods will be purchased by the general public. A medium level of attention will be exhibited during the purchasing process. The goods will be purchased on a predominantly visual basis.

### The strength of the earlier mark's reputation

I have found that the applicant's mark has a moderate reputation.

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

I have found that the applicant's mark possesses between a low and medium level of inherent distinctive character, which has been enhanced to a medium level through use.

Whether there is a likelihood of confusion

I have found that there is a likelihood of direct and indirect confusion where the parties' goods are identical or similar.

110. I have already found that the average consumer is likely to mistake one mark for the other or assume that there is an economic connection between the responsible undertakings. Therefore, to my mind, it is highly likely that a significant part of the relevant public will make the requisite link between them. Even if there was no likelihood of confusion, it is my view that, taking into account the visual similarities between the competing marks, as well as the moderate repute and distinctive character of the applicant's mark, I would have found that a significant part of the relevant public will make a link between the competing marks. This is particularly the case, given that the goods are not of a kind which require an overly considered purchase.

111. This finding does not extend to the goods that I have found to be dissimilar. Whilst I acknowledge that the provisions of section 5(3) afford additional protection to take into account the repute and distinctiveness of earlier trade marks, it remains my view that the competing marks would not be directly or indirectly confused. It is equally my view that the applicant's mark will not be called to mind by the proprietor's mark in the context of these goods. Although the marks share the same visual similarities, the reputation is not sufficiently strong, or the applicant's mark sufficiently distinctive, to overcome the distance between the parties' goods. On this basis, I do not consider that the requisite link would be made. The applicant's claim under this ground cannot proceed for these goods.

## Damage

112. I must now assess whether any of the pleaded types of damage will arise.

### Unfair advantage

113. The taking of unfair advantage of the distinctive character or reputation of an earlier trade mark means that consumers are more likely to buy the goods of the later trade mark than they would otherwise have been if they had not been reminded of the earlier trade mark. As a result, the marketing of the later mark will not require as much effort or investment due to the familiarity that the relevant public would already feel with it or the message they are sent about what to expect. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J (as he then was) concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

114. In its written submissions, the proprietor criticises the applicant for having offered no evidence that use of its mark would take unfair advantage of the repute or distinctive character of the applicant's mark. However, it is not necessary for evidence of actual damage to be adduced. As the CJEU explained in *Intel*:

“38. The proprietor of the earlier trade mark is not required [...] to demonstrate actual and present injury to its mark for the purposes of Article 4(4)(a) of the Directive. When it is foreseeable that such injury will ensue from the use which the proprietor of the later mark may be led to make of its mark, the proprietor of the earlier mark cannot be required to wait for it actually to occur in order to be able to prohibit that use.”

Rather, the authorities make it clear that it is permissible and sufficient to conclude from the evidence that there is a serious risk of damage occurring in the future.<sup>47</sup>

115. I have already found that there is a likelihood of direct and indirect confusion. Therefore, even if there is no intention on the part of the proprietor, it is clearly foreseeable that it would secure an unfair commercial advantage, benefitting from the applicant’s reputation without paying financial compensation and diverting sales to the proprietor. Even if there was no direct or indirect confusion, it is my view that, upon encountering the proprietor’s mark, the relevant public will be reminded of the applicant’s mark; the proprietor’s mark will appear instantly familiar, making it easier for the proprietor to establish its mark and sell its goods without incurring the marketing costs that would ordinarily be required. The proprietor’s mark will be able to attract more customers than would be the case if the applicant’s mark was not brought to mind. This will essentially allow the proprietor’s mark to ‘free ride’ on the reputation of the applicant’s mark and gain an unfair commercial advantage.

116. As damage is made out on the basis of unfair advantage, I do not consider it necessary to go on to consider any of the other types of damage pleaded by the applicant.

### **Due cause**

117. Within its written submissions, the proprietor submits that there is no evidence that its use of its mark is without due cause. The implication of this is that the burden

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<sup>47</sup> See, for example, *Environmental Manufacturing*, paragraph 42 and *Aktieselskabet af 21. november 2001 v OHIM*, Case C-197/07P.

is on the applicant to demonstrate a lack of due cause. This is not correct. In *Leidseplein Beheer BV v Red Bull*, Case C-65/12, the CJEU explained that:

“44. Where the proprietor of the mark with a reputation has demonstrated the existence of one of the forms of injury referred to in Article 5(2) of Directive 89/104 and, in particular, has shown that unfair advantage has been taken of the distinctive character or the repute of that mark, the onus is on the third party using a sign similar to the mark with a reputation to establish that he has due cause for using such a sign (see, by analogy, Case C-252/07 *Intel Corporation* [2008] ECR I-8823, paragraph 39).” (my emphasis)

From this, it is clear that the burden of establishing due cause is on the proprietor, i.e. it was for the proprietor to demonstrate that it has due cause, not for the applicant to demonstrate that it has not.

118. Due cause was not pleaded by the proprietor. In fact, the concept was not mentioned until its final written submissions and, even then, only to criticise the applicant for not demonstrating a lack of due cause. Accordingly, the defence of due cause is not open to the proprietor. I should add that, even if it had been pleaded, I would have found the evidence to be insufficient for this purpose. Later in *Leidseplein Beheer BV v Red Bull*, the CJEU stated that:

“60. Consequently, it follows [...] that the proprietor of a trade mark with a reputation may be obliged, pursuant to the concept of ‘due cause’ within the meaning of that provision, to tolerate the use by a third party of a sign similar to that mark in relation to a product which is identical to that for which that mark was registered, if it is demonstrated that that sign was being used before that mark was filed and that the use of that sign in relation to the identical product is in good faith. In order to determine whether that is so, the national court must take account, in particular, of:

- how that sign has been accepted by, and what its reputation is with, the relevant public;

- the degree of proximity between the goods and services for which that sign was originally used and the product for which the mark with a reputation was registered; and
- the economic and commercial significance of the use for that product of the sign which is similar to that mark.”

Although the proprietor has filed evidence relating to its own commercial activities, none of it relates to the mark at issue in these proceedings. As such, there is nothing prior to the filing of the proprietor’s mark that is capable of giving rise to a defence of due cause.

## **Conclusion**

119. The applicant’s claim under section 5(3) is partially successful.

### **Section 5(4)(a)**

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

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

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

(aa) [...]

(b) [...]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

121. Subsection (4A) of section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

122. In *Discount Outlet v Feel Good UK* [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

123. Halsbury’s Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

“Establishing a likelihood of deception generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

(a) the nature and extent of the reputation relied upon,

(b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;

(c) the similarity of the mark, name etc used by the defendant to that of the claimant;

(d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action".

## Relevant date

124. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11, Mr Daniel Alexander QC, as the Appointed Person, endorsed the Registrar's assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

"43. In *SWORDERS TM O-212-06* Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.'

125. Although the proprietor has filed evidence in relation to its own business, none of it relates to the mark at issue in these proceedings. As there is no evidence that the proprietor's mark has been used, the relevant date for the purposes of the applicant's claim under this ground is the priority date claimed by the proprietor's mark, namely 21 February 2022.

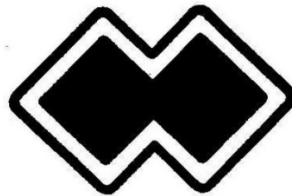
## Goodwill

126. The first hurdle for the applicant is to show that it had the necessary goodwill in the sign relied upon at the relevant date. Goodwill was described in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), in the following terms:

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a

business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

127. I have already found that the evidence provided by the applicant is sufficient for establishing genuine use, enhanced distinctive character, and a reputation in respect of a registered mark identical to one of the signs relied upon under this ground. For the same reasons as given at paragraphs 36 to 43, I am satisfied that the applicant has demonstrated that its business in *sports clothing and leisurewear for men and women* enjoyed a moderate level of goodwill at the relevant date.<sup>48</sup> I am also satisfied that the sign shown below was distinctive of that goodwill:



In my view, this goodwill does not extend to any other goods for which use of the sign has been claimed for the same reasons as given at paragraphs 43 to 46.

### **Misrepresentation and damage**

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

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] *R.P.C.* 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the

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<sup>48</sup> These goods fall within the scope of the pleaded goods *sports and fashion goods and accessories, which include clothes [...]*.

public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]"

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101."

And later in the same judgment:

"[...] for my part, I think that references, in this context, to "more than *de minimis*" and "above a trivial level" are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion."

129. In *Marks and Spencer PLC v Interflora* [2012] EWCA (Civ) 1501, Lewison LJ cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that "a substantial number" of the relevant public are deceived, which might not mean that the average consumer is confused. However, considering the Court of Appeal's later judgment in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes.<sup>49</sup> This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

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<sup>49</sup> Although this was an infringement case, the principles are equally applicable to section 5(2) of the Act: *Soulcycle Inc v Matalan Ltd* [2017] EWHC 496 (Ch).

130. I have already found that there is a likelihood of confusion between the proprietor's mark and a registered mark identical to the applicant's sign. For the same reasons given at paragraphs 96 and 97, I find that a substantial number of members of the public will be deceived into believing that the goods provided under the proprietor's mark and the applicant's sign are offered by the same or economically linked undertakings. In such circumstances, I consider that damage though diversion of sales is entirely foreseeable.

131. As for the goods which are dissimilar (and for which there could be no likelihood of confusion under section 5(2)(b) of the Act), I do not consider that a substantial number of members of the public will be deceived. Whilst I acknowledge that there is no requirement for the parties to be operating in a common field of activity, the proximity of the parties' activities is a relevant factor.<sup>50</sup> In my view, the applicant's goodwill is not sufficiently strong, and its sign is not sufficiently similar to the proprietor's mark, to counterbalance the distance between the parties' goods. As there will be no misrepresentation in respect of these goods, there can be no damage.

132. I should add that I do not consider the applicant's other sign puts it in a more favourable position. This other sign is no more similar to the proprietor's mark; all other factors being equal, the risk of confusion/deception is not increased.

## **Conclusion**

133. The applicant's claim under section 5(4)(a) is partially successful.

## **Overall outcome**

134. The application for invalidation has been partially successful. Subject to a successful appeal against this decision, the proprietor's mark will be declared invalid in respect of the following goods:

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<sup>50</sup> See the comments of Millet LJ in *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA).

Class 18: Bags; leather bags; imitation leather bags; all-purpose tote bags made of imitation leather; shoulder bags; handbags.

Class 25: Clothes, shoes, hats; sportswear; active wear; coats; jackets; dresses; hooded tops; sweatshirts; jeans; sweaters; cardigans; overalls; playsuits; hosiery; lingerie; underwear; sports bras; evening wear; pajamas; dressing gowns; sleep masks; leisure wear; shorts; skirts; socks; tights; suits; swimwear; beachwear; tops; tracksuits; pants; dungarees; sweatpants; chinos; leggings; vest; t-shirts; shirts; polo shirts; tunics; bibs, not of paper; tops; blouses; bodice; bralettes; camisole; corsets; capes; bikini tops; belts for clothing; suspenders for clothing; earmuffs; scarves; headdress; gloves; mittens; muffs; ties; hats; caps; caps; headbands; veil; bandanas; berets (berets); earmuffs; boots; sports shoes; sneakers; sandals; shoes; shoes with heels; flip flops; slider sandals; sports shoes; footmuffs; fittings and accessories for the aforesaid goods.

135. The proprietor's mark will remain registered for the following goods, against which the application for invalidation has failed or was not directed:

Class 14: Precious metals and their alloys; precious and semi-precious stones; horological and chronometric instruments; jewelry; body jewelry; bangles; bracelet; jewels with ornamental stones; jewelery containing precious and semi-precious stones; jewelry imitations; brooches being jewellery; chains being jewellery; jewelry amulets; chokers; earrings; bracelet; necklaces; tie clips; tie pins; cufflinks; costume jewellery; gems; decorative pins being jewellery; jewelry for the face; hat ornaments; foot jewelry; pins [jewellery]; medallions being jewellery; display coins being jewellery; medals; tie closures; rings being jewellery; shawl clips being jewellery; bracelet; chronometric instruments; clocks; wristwatches; chronographs for use as clocks; mechanical clocks; hanging clocks; pocket watches; watches to match clothing;

electric clocks; clocks with memory function; clocks with telecommunication function; clocks with gps function; watch straps; watch straps; jewelry box; watch cases; cufflink cases; cases for tie pins; cases for clocks and watches; jewelry cases; key chains; key fobs; talismans for key rings and key chains; key chains for use as jewelry; fittings and accessories for the aforesaid goods.

Class 18: Leather and imitations of leather; luggage suitcases; wallets and other carrier bags; general purpose carrier bags; sports bags; athletic bags; all-purpose leather carry bags; rucksacks; cosmetic bags sold empty; makeup bags sold empty; empty shaving bags; credit card pockets; wallets; wallets for attachment to belts; purses; purses attached to the wrist; belt pouches; leather laces; badges of leather; umbrellas and parasols; walking sticks; walking sticks; sticks with integrated seats; clothing for pets; components and accessories for the aforesaid goods; components and accessories for bags, leather bags, imitation leather bags, all-purpose tote bags made of imitation leather, shoulder bags and handbags.

Class 25: Shower caps; fittings and accessories for the aforesaid goods.

### **Costs**

136. As both parties have achieved what I regard as a roughly equal measure of success, I direct that both parties should bear their own costs.

**Dated this 22<sup>nd</sup> day of July 2025**

**James Hopkins  
For the Registrar**