

O/0684/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003752579

BY INVICTUS GAMES FOUNDATION

TO REGISTER THE TRADE MARK:

**INVICTUS  
GAMES**

IN CLASSES 18 AND 25

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 433900

BY INVICTA S.P.A.

## BACKGROUND AND PLEADINGS

1. On 9 February 2022, Invictus Games Foundation (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 25 February 2022. The applicant seeks registration for the following goods:

Class 18 Luggage and carrying bags; tote bags; sports bags; backpacks; rucksacks.

Class 25 Clothing, footwear, headwear.

2. The application was opposed by Invicta S.p.A. (“the opponent”) on 26 May 2022. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following trade marks:

# INVICTA

Comparable UK trade mark (EU) registration no. UK00900506451<sup>1</sup>

Filing date 1 April 1997; Registration date 1 December 1998.

**(“The First Earlier Mark”)**

# INVICTA

Comparable trade mark (IR) registration no. UK00801201001<sup>2</sup>

Filing date 13 December 2013; Registration date 23 April 2018.

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

<sup>2</sup> Following the end of the transition period of the UK’s withdrawal from the EU, all international (EU) trade mark designations registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A ‘comparable trade mark (IR)’ retains the same designation date (filing date), priority date (if applicable) and registration date of the international (EU) trade mark designation.

Priority date 14 November 2013

**(“The Second Earlier Mark”)**

3. The opponent relies upon some of its goods for which its earlier marks are registered, as set out in Annex 1 of this decision.

4. The opponent claims that there is a likelihood of confusion because the goods are identical and the marks are highly similar.

5. The applicant filed a counterstatement denying the claims made and put the opponent to proof of use.

6. A hearing took place before me on 10 April 2024. The opponent was represented by Simon Malynicz of Hogarth Chambers instructed by Bromhead Johnson LLP and the applicant was represented by Andrew Lomas of One Essex Court instructed by Clifford Chance LLP. I make this decision having taken full account of the oral submissions and all the papers, referring to them below as necessary.

**RELEVANCE OF EU LAW**

7. 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**

8. The opponent’s evidence consists of the witness statement of Livia Pasqualingo dated 14 November 2022. Ms Pasqualingo is a Trade Mark Attorney of Buzzi, Notaro & Antonielli d’Oulx in Italy. She is both fluent in Italian and English. Ms Pasqualingo’s statement is accompanied by 2 exhibits (LP1-LP2). It appears to me that the purpose of her evidence is to translate Mr Stasio’s statement because **exhibit LP1** contains

the witness statement of Aldo Rosario Di Stasio (the President of the opponent) dated 14 November 2022, which is accompanied by 15 exhibits (ARDS1-ARDS15) and is written in Italian. **Exhibit LP2** contains the English translated version of Mr Stasio's witness statement.

9. The opponent's evidence also consists of the witness statement of Mr Ross Timothy Manaton dated 14 November 2022. Mr Manaton is a Trade Mark Attorney and Partner of Bromhead Johnson LLP, the representatives of the opponent. Mr Manaton's statement is accompanied by 1 exhibit (exhibit RTM1).

10. The opponent's evidence also consists of the witness statement of Ms Marine Body dated 13 December 2022. Ms Body is a chartered Trade Mark Attorney of Bromhead Johnson LLP. Ms Body's statement is accompanied by 2 exhibits (MB1-MB2).

11. The applicant's evidence consists of the witness statement of Mr Samuel Peter Newell dated 26 May 2023. Mr Newell is the Director of the applicant, a position he has held since August 2018. Mr Newell's statement is accompanied by 14 exhibits (SN1-SN14).

12. The opponent's evidence in reply consists of the second witness statement of Ms Marine Body dated 19 October 2023. Ms Body's second witness statement is accompanied by 7 exhibits (MB3-MB9).

13. Whilst I do not propose to summarise the parties' evidence and submissions here, I have taken them into consideration and will refer to them below where necessary.

## **PRELIMINARY ISSUE**

### Hearsay

14. In Mr Lomas' skeleton argument, at paragraph 9, he states that "Pasqualingo is hearsay in the sense that it is merely a vehicle for leading the witness statement of Aldo Rosario di Stasio, which is exhibited in English as Exhibit LP2".

15. I bear in mind that at paragraph 42 of the judgement of Supreme Court in *TUI v Griffiths*,<sup>3</sup> it endorsed the general rule set in out in *Phipson on Evidence* (20th ed. Paragraph 12), with an emphasis on ensuring fairness. The general rule being that:

*“In general a party is required to challenge in cross-examination the evidence of any witness of the opposing party if he wishes to submit to the court that the evidence should not be accepted on that point. The rule applies in civil cases...”*

16. Therefore, at the hearing, I asked Mr Lomas to elaborate on his hearsay point, to which he replied:

“I do not push this too hard. I think the point being it is hearsay because Mr di Stasio’s evidence is not formally in if that makes sense. It is an exhibit to someone else’s. I do not think that takes us very far. It does not go to admissibility. It is a question of weight if anything”.

17. However, the filing of translated evidence is always done via a witness statement of the translator which exhibits the translated evidence. Therefore I do not consider that anything turns on Mr Lomas’ submissions.

BL O/448/22

18. The above decision is exhibited at **MB1**. I note that throughout the proceedings the opponent has heavily relied upon the outcome of this decision and stated that the relevant parts of this case should be taken into account.<sup>4</sup>

19. Whilst I appreciate that this case involves the same parties, the facts of the case differ, with the applicant’s applied for mark being different, and the opponent’s First Earlier Mark being subject to proof of use. On this basis, and as acknowledged by Mr Malynicz at the hearing, I am not bound by it, and therefore will not be referring to it any further.

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<sup>3</sup> [2023] UKSC 48

<sup>4</sup> Paragraph 6 of the opponent’s written submissions filed during the evidence rounds.

## Reputation of the later mark

20. As highlighted at paragraph 32 of its skeleton argument, the applicant claims that INVICTUS GAMES “has acquired and enhanced distinctive character/reputation by reason of the extensive and high profile use made of it” by the applicant. They have therefore filed its evidence above to support this. The applicant considers that a significant proportion of the UK will be aware of INVICTUS GAMES and its connection to Prince Harry, which is sufficient to distinguish between the marks at issue.

21. I note that the General Court (“GC”) has consistently held that the reputation of the later mark is in principle irrelevant to the assessment of the likelihood of confusion with an earlier mark.<sup>5</sup> In *Associazione Calcio Milan SpA (AC Milan) v EUIPO*<sup>6</sup> it upheld a decision of the Board of Appeal of the EUIPO to refuse registration of a composite trade mark which included the word MILAN. It rejected the Applicant’s argument that the Board of Appeal had failed to take into account in the context of the assessment of the likelihood of confusion, the high reputation of the sign constituting the mark applied for and of the football club AC Milan. The GC stated that:

“113. ....with regard to the applicant’s argument based on the reputation of the mark applied for in Germany, it should be noted, as EUIPO rightly pointed out, that only the reputation of the earlier mark, and not that of the mark applied for, must be taken into account in order to assess whether the similarity of the goods designated by the two marks is sufficient to give rise to a likelihood of confusion (see, to that effect, judgment of 3 September 2009, *Aceites del Sur-Coosur v Koipe*, C-498/07 P, EU:C:2009:503, paragraph 84 and the case-law cited). That case-law is in line with the objective of Article 8(1)(b) of Regulation No 207/2009, which is to provide adequate protection for the proprietors of earlier rights against subsequent applications for identical or similar European Union trade marks (judgment of 29 January 2019, *The GB Foods v EUIPO – Yatecomeré (YATEKOMO)*, T-336/17, not published, EU:T:2019:840, paragraph 49).

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<sup>5</sup> *The GB Foods SA v OHIM, Case T-336/17, Mayer Naman v OHIM, Case T-498/10 and Agatha Ruiz de la Prada de Sentmenat v OHIM, Case T-522/08.*

<sup>6</sup> T-353/20

114. Therefore, the applicant's argument based on the alleged reputation of the mark applied for is entirely irrelevant."

22. However in *Lionel Andrés Messi Cuccittini v EUIPO*<sup>7</sup> the Court of Justice of the European Union ("CJEU") rejected the argument that the GC was wrong to take into account the notoriety of Lionel Messi as a factor in the assessment of the likelihood of confusion. In rejecting the submissions it stated:

"44. In so far as JM-EV criticizes the General Court for disregarding Article 8(1)(b) of Regulation No 207/2009 by considering, in paragraph 62 of the judgment under appeal, that there was account of the notoriety of Mr Messi Cuccittini in the context of the assessment of the likelihood of confusion, within the meaning of that provision, it should be recalled that, according to settled case-law of the Court, the existence of a likelihood of confusion in the mind of the public must be assessed globally taking into account all the relevant factors of the case.

45. According to equally settled case-law, the overall assessment of the likelihood of confusion must, as regards the visual, phonetic, or conceptual similarity of the signs at issue, be based on the overall impression produced by them, taking into account, in particular, of their distinctive and dominant elements.

46. In the context of that overall assessment, the reputation of the earlier mark is, admittedly, a relevant factor for the purposes of assessing the likelihood of confusion.

47. However, as the Court has held, account must also be taken of the possible notoriety of the person applying for his name to be registered as a trade mark, since that reputation may obviously, have an influence on the perception of the mark by the relevant public (see, to that effect, judgment of 24 June 2010, *Becker v Harman International Industries*, C-51/09 P, paragraph 37 ).

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<sup>7</sup> Joined cases C-449/18P & C-474/18P

48. It follows that the General Court was right to consider, in paragraph 62 of the judgment under appeal, that the notoriety of Mr Messi Cuccittini constituted a relevant factor in order to establish a difference at the conceptual level between the term ‘Messi’ and the term ‘Massi’.”

23. The decision in *Messi* appears to suggest a narrow exception to the rule in *Associazione Calcio Milan*, namely that the reputation of the later mark only comes into play in the confusion assessment, in such cases where the notoriety of a famous person may influence the perception of the later mark by the relevant public. However, whilst the settled caselaw appears to only focus on names of famous people there is no reason why it could not apply to organisations with a well-known conceptual meaning but only in so far as the conceptual comparison assessment.<sup>8</sup> The relevance of the later mark’s reputation was discussed by Mr Allan James, the Registrar’s Hearing Officer, in *Extinction Rebellion* where he stated:<sup>9</sup>

“As Mr Phillip Harris, as the Appointed Person, explained in *Retail Royalty Company v Harringtons Clothing Limited* the reputation of a sign as a trade mark is not usually relevant to its conceptual meaning, which is to be derived from the ordinary meaning(s) of the word(s) or sign at the relevant date, i.e. the meaning(s) that can usually be found in dictionaries. This applies to the earlier mark as well as the later mark. So, for example, when comparing the conceptual similarity between BATMAN and BATSMAN (both for printed publications) it was appropriate to take into account that BATMAN is a wellknown fictional character from Gotham City, whereas BATSMAN historically describes what is now called a batter in cricket. There was no suggestion that the secondary meaning of BATMAN as a trade mark for comic books was relevant to the conceptual similarity between the marks. There are two reasons why the acquired reputation of a sign as a trade mark is irrelevant. Firstly, taking account of the trade mark meaning of the earlier mark when assessing the degree of conceptual similarity between it and the later mark would be ‘double counting’. This is because the reputation of the earlier mark

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<sup>8</sup> *This Ain’t Rock N’ Roll Limited v Jason and Christopher Kingsley*; TM Extinction Rebellion O/214/22

<sup>9</sup> O/214/22 para 52

is already taken into account as a factor which may increase the likelihood of confusion as part of the required evaluation of its distinctive character. Secondly, and more fundamentally, the assessments required under sections 5(2) and 5(3) of the Act necessarily requires the tribunal to assume that both marks will be used as trade marks and that average consumers will recognise them as such. Therefore, the public's existing recognition of one or both of the marks as trade marks adds nothing to the evaluation of the conceptual similarity between them.”

24. I therefore shall return to consider the applicant's reputation at the conceptual comparison later in my decision.

## **DECISION**

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

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

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

(a)...

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

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

26. The opponent's marks qualify as earlier marks in accordance with section 6(1)(aa) and 6(1)(ab) as their filing dates are earlier than the filing date of the applicant's mark. The First Earlier Mark completed its registration process more than five years before the filing date of the mark in issue and is, therefore, subject to proof of use pursuant to section 6A of the Act. However, the Second Earlier Mark had not completed its

registration process more than five years before the relevant date, and therefore the opponent may rely upon all of its goods without demonstrating it has used its Second Earlier Mark.

### **Proof of use**

27. I will begin by assessing whether there has been genuine use of the First Earlier Mark. The relevant statutory provisions are as follows:

28. Section 6A of the Act states:

“(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

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

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

(3) The use conditions are met if –

- (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his

consent in relation to the goods or services for which it is registered,  
or

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

(4) For these purposes –

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

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

(5)-(5A) [Repealed]

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

29. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the First Earlier Mark is the five years ending on the filing date of the applicant’s mark, i.e. 10 February 2017 to 9 February 2022. By virtue of paragraphs 7 and 8 of Part 1, Schedule 2A of the Act, use within the EU is relevant for the entirety of the relevant period which falls prior to IP Completion Day (31 December 2020). After that date, only use in the UK will be relevant.

30. 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 Bunderversvereinigung 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 Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a 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].”

### Evidence of use

31. I note the following from the opponent’s evidence:

- a) INVICTA was created in 1906, and in **exhibit ARDS2**, a brand profile document (which has a copyright date of 2017) shows and lists backpacks, outwear (including jackets), eyewear and footwear as goods which are sold under this mark.
- b) The opponent became part of the Seven Group in 2006 and Seven S.p.A is a licensee of the INVICTA marks, which is supported by the licence agreement dated 9 March 2017 contained in **exhibit ARDS3**. I note that the licence grants Seven S.p.A “exclusive licence for the trademarks INVICTA”, but the goods and territories of the agreement have been redacted.
- c) Mr Stasio states that the INVICTA mark had up to approximately 16% of the backpack market share in Italy during the relevant period, which is supported by **exhibit ARDS4**.
- d) At paragraph 10 of his witness statement, Mr Stasio states that with regard to “the category of goods that generally corresponds to class 18, approximately 999.00 products bearing the INVICTA mark have been sold from 2017 to 2021 across the European Union with a total turnover approximately €35.400.000.” He states that the figures from 2017 to 2020 are calculated all for the EU and the 2021 products are just from the UK, however, a breakdown by year of the €35.400.000 figure has not been provided.

e) I have also been provided with the following turnover for the “main European Union” countries from 2017 to 2020:

Italy	€34,900,00
France	€180,000
Luxembourg	€120,000
Greece	€36,000

f) The Italian turnover figure above includes sales made by its licensee to its third-party retailers which sell INVICTA branded products in other EU countries including the UK. Mr Stasio states that in relation to 2017 to 2021, “part of the turnover realised in Italy, amounting to approximately €6,000,000 concerns sales made to various commercial partners that promote INVICTA branded products also outside the territory of Italy”.

g) **Exhibit ARDS5** contains a selection of Seven S.p.A invoices to show sales of goods under the INVICTA mark during the relevant period “across the European Union including the UK”. The invoices are not presented in English; however, I note the following from them:

<b>Date</b>	<b>Customer location</b>	<b>Goods</b>
31/07/2019	London	MINISAC GLOSSY INVICTA VINTAGE
19/07/2019	London	JOLLY VINTAGE INVICTA MINISAC NEXT INVICTA VINTAGE MINISAC NEXT INVICTA ICON VAX BACKPACK INVICTA VINTAGE SHYLLA COLOUR INVICTA PREMIUM RECYCLED CHAT INVICA LEGACY MONVISO INVICTA LEGACY
22/02/2018	Vicopisano	WALLET YAP FANTASY INVICTA FACE LOOK WALLET INVICTA ACCESSORIES
31/10/2018	France	ZAINO ROUND INVICTA BENINI LIP P.BAG YAP INVICTA BUST.ROUND PLUS INVICTA BEAT
28/11/2018	France	DOUBLE POCKET WAIST BAG INVICTA MINISAC NEXT INVICTA ICON OLLIE PACK FANTASY INVICTA DUFFLE BAG INVICTA EASY WAY BUSINESS BAG INVICTA OFFICE

10/12/2018	France	JOLLY VINTAGE INVICTA ZAINO REV.CHECK INVICTA TWIST ZAINO FORMAT INVICTA CHECK AST.3 ZIP INVICTA PAINTED DAISIES AST.3 ZIP INVICTA PAINTED CAMOU
12/06/2019	Casalecchio Di Reno	TROLLY INVICTA BENINI II RECYCLED ZAINO DUFFY INVICTA PRIMEROSE ASSORT.BUSTINE INVICTA
28/06/2019	Rozzano	ZAINO ACTIVE INVICTA BENIN ZAINO STRONG INVICTA STONE ZAINI INVICTA ASSORTITI ZAINI TWIST INVICTA ASSORTITI
05/04/2019	Torino	PLUG PLUS TROLLY INVICTA FANTASY EAST COURIER INVICTA SIMPLE LUKE WAIST BAG INVICTA ACCESSORIES QUEEN MINI SHOULDER INVICTA
14/10/2019	Malta	BUMP PRO PLAIN INVICTA TROLLEY BUSINESS PACK INVICTA CARRY ON
28/03/2019	Spain	MINISAC NEXT INVICTA ICON MINISAC GLOSSY INVICTA VINTAGE CARLSON PLAIN INVICTA BACKPACK JELEK PLAIN INVICTA BACKPACK BUMP PRO PLAIN INVICTA TROLLEY TINDY PLAIN INVICTA TROLLEY
14/10/2019	Lussemburgo	UTILITY PACK INVICTA EASY WAY
09/11/2020	Cassola	ROUND PLUS BACKPACK INVICTA W&T EASY M PACKPACK ECO INVICTA URBAN JOLLY OFFICE INVICTA W&T ROUND PACKPACK INVICTA ROUND LUX BACKPACK INVICTA H.24 BACKPACK INVICTA LAPTOP COVER INVICTA BUSINESS PACK INVICTA CARRY ON MINI SHOULDER BAG INVICTA WORK TECH TOTE BAG OFFICE INVICTA TABLET BAG ECO INVICTA URBAN MINI SHOUL.BAG ECO INVICTA URBAN
21/05/2020	Soveria Mannelli	CARLSON PLAIN INVICTA BACKPACK CARLSON FANTASY INVICTA BACKPACK JELEK PLAIN INVICTA BACKPACK JELEK FANTASY INVICTA BACKPACK CARLSON 2 TONE INVICTA BACKPACK JELEK 2 TONE INVICTA BACKPACK TINDY FANTASY INVICTA TROLLEY CARLSON WASHED INVICTA BACKPACK LIP PENC. BAG INVICTA ACCESSORIES LESSEN SHOULDER INVICTA KIT WALLETS EXPO INVICTA ACCESSORIES
09/11/2020	Ancona	URBAN LUX BACKPACK INVICTA

		JOLLY OFFICE INVICTA ROUND BACKPACK INVICTA PENSIL CASE INVICTA LEATHER COIN PURSE SQUARE INVICTA LEATHER WALLET WITH COIN HOLDER INVICTA LAPTOP COVER INVICTA CARD HOLDER INVICTA LEATHER TOTE BAG OFFICE INVICTA
11/03/2020	Germania	MINISAC GLOSSY INVICTA JOLLY COLOUR INVICTA VINTAGE STRIPE WAIST BAG INVICTA WAIST BAG COLOUR INVICTA
12/10/2020	Belgio	MONVISO 3 INVICTA TRAVEL JOLLY INVICTA SOLID RECYCLED
23/11/2020	Portogallo	MONVISO 1 INVICTA TRAVEL CARLSO INVICTA SOLID RECYCLED

- h) Whilst all of the goods are named INVICTA, it is not clear what all of the goods are. However, it is clear from the description of the goods listed above that some of them were bags, backpacks, wallets, and card holders.
- i) I note that the invoices did contain the total cost, but some of the goods were censored, and therefore the full amount did not pertain to just those INVICTA goods. Moreover, as the invoices are presented in another language, I am unable to determine the individual prices of the goods.
- j) **Exhibit ARDS5a** also contains a report of turnover achieved by the platform “Yoox”. However, firstly, I note that this report is not presented in English, and secondly, it does not specifically state what INVICTA goods the sales are in relation to.
- k) **Exhibit ARDS5a** contains screenshots showing the opponents bag goods dated 12 November 2022. Whilst I note that this is dated after the relevant period, I note that the goods can be cross-referenced with the above invoices. It shows that its JOLLY goods are a type of backpack, its TROLLEY goods are a type of travel bag with wheels, its SOLID INVICTA RECYCLED and MINISAC goods are also types of backpack. I also note that its goods are priced between €59 to €75.

- l) **Exhibit ARDS6** contains catalogue evidence titled “fall/winter 2018/19” and “office collection 2020”. The catalogues show backpacks, trolleys, pencil cases, shoulder bags, wallets, purses, diary books, bottles, and they use the following marks:



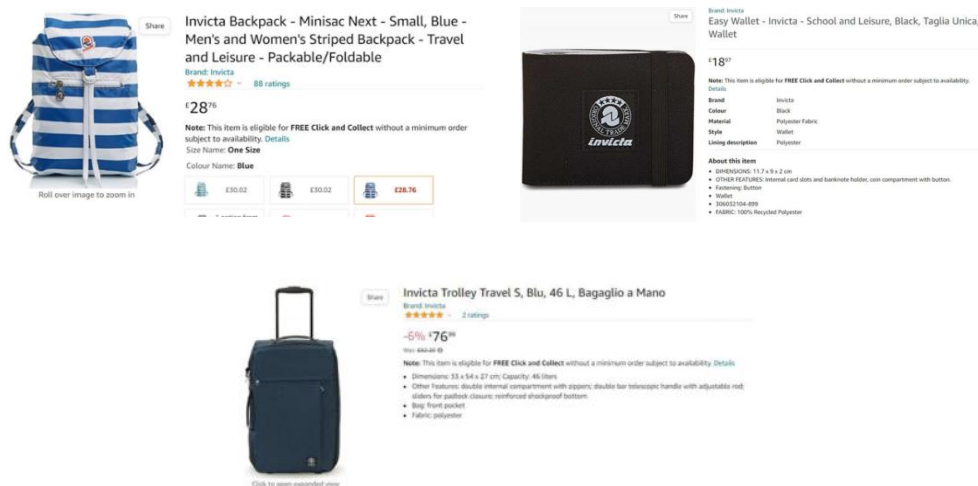
- m) Mr Stasio states that the INVICTA mark is printed or embossed directly onto the goods, labels, hand tags and on packaging such as boxes. The mark is also used on window signs and shopping bags. This statement is supported by photo and diagram examples contained in **exhibit ARDS7**, some of which are dated between 2016 and 2021.
- n) **Exhibit ARDS8** contains invoice and photo evidence that the opponent has attended exhibitions. The invoices show that the opponent has paid for a stand at the SEEK contemporary fashion trade show in July 2018, January 2019, July 2019, and January 2020. These invoices total between €14,000.00 to €21,000.00. The opponent also paid €1,500.00 to attend the Jacket Required trade show on 22 and 23 January 2020.
- o) **Exhibit ARDS10** contains photos of newspaper advertisements which Mr Stasio dates between 2019 to 2020, including the following:



p) A Google Ad campaign was performed in Italy between 3 June to 21 December 2020 which attracted 22,526,935 impressions. I note that **exhibit ARDS11** contains the following banners used in this campaign:



q) **Exhibit ARDS12** contains multiple screenshots of its Invicta backpacks, wallets, trolleys, hats, and jackets for sale on the platform Amazon UK. Whilst the screenshots are undated, the platform lists the first time these goods were available on the platform, including 1 May 2017, 23 November 2019, 5 March 2020, 22 April 2021, 11 May 2021, 16 November 2021, and 21 December 2021. I note that the screenshots include the following:



Form of the mark

32. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union (“CJEU”) found that (my emphasis):

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in Nestle, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition of a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at

issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1)”. (emphasis added)

33. The First Earlier Mark as registered is: INVICTA

34. The evidence I have outlined above includes instances of the following variants:



35. Both variant 1 and 2 consist of the word “Invicta” presented in red typeface, and the First Earlier Mark is a word mark which covers use in any standard typeface or colour. Whilst I note that both variants also consist of the abstract device element (the curved blue line overlapping a red circle), the wording “ORIGINAL TRADE MARK” and “since 1906”, and the star and linework elements, the word “Invicta” still continues to indicate origin within the composite marks. Variant 1 and 2 is, therefore, acceptable use of the First Earlier Mark.

#### Assessment of genuine use

36. As I have found the mark used in the evidence to be accepted, I will now consider an assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.<sup>10</sup>

37. As indicated in the case law cited above, use does not need to be quantitatively significant in order to be genuine. The assessment must take into account a number

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<sup>10</sup> *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as “warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark”.

38. The evidence provided by the opponent is not without its limitations. I note that some of the evidence filed is in regard to its class 25 goods (including **exhibits ARSD5a, ARSD5b and ARDS12**). However, the evidence above confirms that 999,000 INVICTA class 18 goods have been sold in the EU from 2017 to 2021 amounting to €35,400,000. This is supported by the individual turnover evidence from Italy, France, Luxembourg and Greece contained in paragraph 31(e) above. The opponent also had up to approximately 16% of the backpack market share in Italy during the relevant period. This evidence is supported by Amazon screenshots, invoices, catalogues, and Google ads, and therefore I am satisfied that the First Earlier Mark has been put to genuine use in the EU for bags.

#### Fair Specification

39. While I have concluded that there is genuine use, I do not consider that the use is sufficient to allow the opposition to continue in respect of all of the goods relied upon.<sup>11</sup>

40. Clearly, the opponent sells a variety of bags, however, the majority of the evidence pertains to rucksacks, backpacks, and trolley bags. The First Earlier Mark’s specification has the terms rucksacks and backpacks, and the opponent’s trolley bags are clearly a type of “travelling bag”. I therefore consider that the term “trunks and travelling bags” needs to be narrowed down to reflect the opponent’s travelling bags only (which I consider to be an appropriate sub-category).

41. I also note that a significant part of the evidence pertains to the opponent’s purses and wallets, which are terms included within First Earlier Mark’s specification.

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<sup>11</sup> *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch).

42. I note that whilst the First Earlier Mark's specification covers the term "handbags", I do not consider that there is enough evidence of use for the opponent to keep this term.

43. For the remaining goods the opponent has under its First Earlier Mark, including "leather and imitations of leather, and goods made of these materials and not included in other classes", "attaché cases", "beach bags", "briefcases", "card cases [notecases]", "chain mesh purses, not of precious metal", "haversacks", "shopping bags", "sling bags for carrying infants", "vanity cases [not fitted]", "wheeled shopping bags", "schoolbags" and "school satchels", there has been no evidence of use filed for these.

44. Consequently, I consider a fair specification for the First Earlier Mark to be:

Class 18      Pocket wallets; purses; rucksacks; backpacks; trolley bags.

#### **Section 5(2)(b) - case law**

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

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely

upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

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

### Comparison of goods

46. The competing goods are as follows:

Opponent's goods	Applicant's goods
<p><b><u>First Earlier Mark</u></b></p> <p><u>Class 18</u> Pocket wallets; purses; rucksacks; backpacks; travelling bags.</p> <p><b><u>Second Earlier Mark</u></b></p> <p><u>Class 25</u> Articles of clothing, footwear, headgear; active wear, sportswear, namely trousers, sport suits, shorts; swimwear, bathing suits, bikinis, slips, swimsuit shorts, swimming caps; pareos, bras, ponchos; underwear, namely bodies, boxers, T-shirts, tank tops, bras, culottes, leotards, shorts, slips, thongs; leather wear and lounge bathrobes, nightdresses, pajamas; apparel of any design and nature made from fabrics of any nature, namely, pants, trousers, work clothing and work overalls, jeans, shorts, jackets, coats, waistcoats, overcoats, raincoats, hosiery, knitwear, sweaters, cardigans, fleece tops and bottoms, jumpers, twin sets, woven</p>	<p><u>Class 18</u> Luggage and carrying bags; tote bags; sports bags; backpacks; rucksacks.</p> <p><u>Class 25</u> Clothing, footwear, headwear.</p>

<p>shirts; dresses, training and track suits, bodies, shirts, plush shirts, polo shirts, nightshirts for men, T-shirts, undershirts, cut and sew tops, dresses, skirts, trousers-skirts, gowns; socks; dressing gowns; bands; balaclavas, scarves, silk scarves, neck and face masks (bands); gloves and mittens, ski gloves; headwear, namely hats, caps, bandanas, basques, visors, wrist bands; belts and ties; footwear, shoes, dress shoes, sneakers, boots, chaps, sandals, slippers, sport and athletic shoes, studded shoes, mountaineering shoes; ski boots and trekking boots, gaiters, heeled shoes, bands for protecting face and ear from cold.</p>	
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47. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

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

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

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

49. 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.”

## Class 18

*Backpacks; rucksacks.*

50. The above terms appear identically in the First Earlier Mark’s and applicant’s specification.

*Luggage and carrying bags.*

51. While expressed slightly differently, the applicant's above goods are self-evidently identical to "travelling bags" in the First Earlier Mark's specification. However, if I am wrong in this finding, the goods overlap in trade channels, nature, purpose, method of use and user, making them similar to a high degree.

*Tote bags; sports bags.*

52. I consider that the First Earlier Mark's "backpacks" and "rucksacks" are similar to the applicant's above goods. All of the goods are types of bags, which are used to contain the users' goods, and can be worn on their shoulder. Therefore the goods overlap in nature, purpose, and method of use. All of the goods would all be sold by the same undertakings which specialise in bags, which will also be available in the same aisles of general retail stores. The goods are not complementary, but they may be in competition, with the user choosing one bag over the other to carry and contain their goods. Taking the above into account, I consider that the goods are similar to a high degree.

### Class 25

*Clothing, footwear, headwear.*

53. While expressed slightly differently, the applicant's above goods are self-evidently identical to "articles of clothing, footwear, headgear" in the Second Earlier Mark's specification.

### **The average consumer and the nature of the purchasing act**

54. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The*

*Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

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

55. The average consumer for the goods will be members of the general public. The cost of purchase is likely to vary, and the goods will be purchased relatively frequently. However, various factors are still likely to be taken into consideration during the purchasing process, such as materials used, cut, aesthetic appearance and durability. Consequently, I consider that a medium degree of attention will be paid by the average consumer when selecting the bag and clothing goods.

56. The goods are likely to be obtained by self-selection from the shelves of a retail outlet, online or catalogue equivalent. Alternatively, the goods may be purchased following the perusal of advertisements. This means that visual considerations will be the most significant.<sup>12</sup> However, I do not discount that there will also be an aural component to the purchase of the goods, as advice may be sought from a sales assistant or representative and word-of-mouth recommendations may play a part.

### **Comparison of the trade marks**

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

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<sup>12</sup> *New Look Limited v OHIM*, Joined cases T-117/03 to T-119/03 and T-171/03, paragraph 50

components. The CJEU stated, at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

59. The respective trade marks are shown below:

Opponent's trade marks	Applicant's trade mark
<b>INVICTA</b>	 The logo for INVICTUS GAMES consists of the word "INVICTUS" stacked above the word "GAMES". The letters "I" and "AM" in both words are colored yellow, while the remaining letters are grey.

60. The opponent's First and Second Earlier Marks consist of the word "INVICTA". There are no other elements to contribute to the overall impression which lies in the word itself.

61. The applicant's mark consists of the words "INVICTUS GAMES", stacked on top of one another, with the letters "I" and "AM" presented in the colour yellow, and the remaining letters presented in grey. At the hearing, Mr Malynicz stated that the colourisation of the applicant's mark "will not be necessarily noticed by all consumers",

and that the words “stacked” on top of one another simply indicates that “INVICTUS” is read first followed by “GAMES”, which is exactly the same as if they were side by side. However, I disagree. The words “I AM” are presented in a contrasting yellow colour to the grey, and the word “GAMES” is not placed directly in the centre underneath the word INVICTUS. It is instead placed more towards the left-hand side of the mark. I consider that this is important because it allows the “I” and “AM” element to be directly stacking each other, to create a yellow triangular formation of letters, near the centre of the mark. On this basis, I consider that the words “I AM” will be noticed by a significant proportion of consumers, however, I consider that they will be noticed secondary to the words “INVICTUS GAMES” (as they appear within these words). Taking all the above into account, I consider that the get-up of the mark (being the stacking of the words, and the use of the yellow and grey letters) and the words INVICTUS GAMES and I AM play an equal role in the overall impression of the mark.

62. Visually, the marks overlap in the letters I, N, V, I, C and T. This acts as a visual point of similarity. I note that these letters are at the beginning of the marks, to which the average consumer tends to pay more attention to.<sup>13</sup> However, the opponent’s marks end in the letter “A”, and the word on the first line of the applicant’s mark ends in the letter’s “U” and “S”, which is followed by the word “GAMES”. These act as visual points of difference. I also note that the applicant’s mark is presented in a yellow and grey colour way, to which the letters “I AM” are presented in yellow, which will lead the average consumer to notice and read them secondary to INVICTUS GAMES within the mark. These also act as visual points of difference. Consequently, I consider that the marks are visually similar to at least a medium degree.

63. Aurally, the opponent’s marks will be pronounced as IN-VICT-AH. As noted above, due to the use of the colour yellow on the letters “I AM” in the applicant’s mark, I consider that this element will be recognised secondary to the words “INVICTUS GAMES”. On this basis, I do not consider that they will be articulated, and therefore, the applicant’s mark is likely to be pronounced as IN-VICT-US GAMES. Therefore as the first two syllables of the marks are identical, I consider that the marks as a whole are aurally similar to a medium degree.

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<sup>13</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

64. Conceptually, at the hearing, Mr Malynicz submitted that the words “INVICTA” and “INVICTUS” “are not recognisable words to the average consumer”, and that whilst those with a “classical education may know [Invictus] means unconquered [...] most people will think of it as a Latin word that they do not understand or maybe even a made-up word”. On this basis, Mr Malynicz states that the marks are conceptually neutral. I also note that the opponent has filed evidence in **exhibits MB2, MB8, and MB9** to show that the meaning of “Invicta” is “undefeated and unconquered” in Latin and is also the motto for Kent, a county in England.

65. Mr Lomas submitted that the marks are dissimilar, on the basis that its INVICTUS GAMES mark will bring to mind the fame and repute of its patron Prince Harry, and they will also link it with the event for disabled servicemen and women. The applicant also submits that the opponent’s INVICTA mark is a meaningless word to the general public.

66. I note that the applicant has provided evidence in the form of Mr Newell’s statement and accompanying **exhibits SN1 to SN14** to support Mr Lomas’ assertion that the applicant has a reputation. I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

67. Mr Newell states that the Invictus Games took place in London in September 2014, and then in the USA in 2016, Canada in 2017, Australia in 2018 and the Netherlands in 2022. I note that this is supported by evidence from **SN3 to SN12** showing the significant press coverage of these games being reported in UK articles such as The Mail Online and The Guardian. Moreover, **exhibit CSN1** contains UK broadcasting figures from September 2014 in regard to the games on BBC2 and BBC2 Scotland, and its UK viewing figures for 2014 to 2018 and 2020. I consider that the viewing figures are notable, for example, from 2014 to 2018 the total viewing figures amounted to 65,811,400 (as per the BBC audience portal).

68. I note that the opponent has filed evidence at, for example, **exhibit MB4**, to compare the INVICTUS GAMES broadcasting figures against the UEFA Euro 2020 final, which had an average of 29.85 million views in just one broadcast, to show that these viewing figures are, as Mr Malynicz submitted at the hearing, “not large

numbers”. However, whilst these figures do not mirror those such as the Euros, which is an established world-wide football event which has been going since 1960, I still consider that the applicant’s viewing figures are significant, especially for a charitable sporting event which was only established in 2014. The games are also televised on the BBC, which is a prominent British Broadcasting corporation in the UK. These figures are also supported by **exhibits SN2 to SN14** which contains a significant amount of press coverage from April 2014 to April 2022. This includes coverage from The Mirror, The Mail Online, The Independent, The Sun and BBC News. I also note that a lot of the press coverage evidence mentions, or depicts Prince Harry (and his wife Megan Markle), either attending the games, meeting with participants and the UK team, or wearing items of clothing branded with the INVICTUS GAMES mark. Moreover, many of the article’s comment or make reference to the fact that Prince Harry is a Patron of the Invictus Games.

69. At the hearing, Mr Malynicz submitted that the applicant’s reputation for clothing and bags is “non-existent” as there is “no evidence of use of the mark by the foundation, in a trade mark sense, for clothing or bags”. He also submitted that even if the applicant were to show it had an extensive reputation, it is not the same as “saying it has an extensive reputation for the relevant goods”. Whilst I have been provided with social media evidence in **SN1** and the article evidence in **SN2 and SN3**, and **SN5 to SN12**, that the INVICTUS GAMES mark has been used on bags and clothing, since 2014/2015, I have not been provided with any UK sales figures for these goods, a breakdown of the number of class 18 and 25 goods sold under this mark, or any supporting invoice evidence.

70. Regardless, when assessing the conceptual similarity of two marks this is usually done without reference to the goods and services in question.<sup>14</sup> Therefore when looking at the reputation of the applicant’s mark, the nature of the goods is irrelevant. I remind myself of the authority of *The Picasso Estate v OHIM*<sup>15</sup> where the goods in issue were class 12 vehicles. Nonetheless, the court had found that the CFI should have taken account of the conceptual meaning of PICASSO (the famous painter) when

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<sup>14</sup> Mr Philip Johnson, sitting as the AP in *Viñedos Emiliana SA v Consorzio Tutela Vini Emilia*, (2) Chiarli 1860 – Pr.I.V.I Srl And (3) Medici Ermete E Figli Srl O/054/22.

<sup>15</sup> Case C-361/04 P

assessing the degree of similarity (and therefore the likelihood of confusion) between that mark and the later-filed trade mark PICARO.

71. At the hearing, Mr Malynicz made reference to the *Interflora* principle,<sup>16</sup> and the established case law that you only have to show that a significant proportion would have been aware of the applicant's reputation. However, he went on to assert that "there is just no way that the applicant has come anywhere near educating substantially all of the relevant public". Firstly, I consider that these assertions directly contradict each other. Secondly, exhibited at **MB5** of Ms Body's witness statement is a screenshot of a table titled "population of the United Kingdom (2023 and historical)" which was taken from the website "Worldometer.info", which was last updated on 16 July 2023. This screenshot shows that in 2015 to 2023, the UK had a population of between 65,000,000 to 68,000,000 people. As noted above, between 2014 to 2018 the total BBC viewing figures for INVICTUS GAMES amounted to 65,811,400. Whilst I appreciate that this amount is calculated from a four-year period, I still consider that the total viewing figures supports the applicant's assertion that a significant proportion of UK consumers would have known about the INVICTUS GAMES and its connection with Prince Harry, at the relevant date.

72. Whilst I acknowledge that cases of the applicant's reputation being parlayed into conceptual meaning (such as C-361/04 P *PICASSO/PICARO* and C-449/18 *MESSI*) are exceptions rather than the rule, the "reputation" element in those cases related to the fame attached to the names of the individuals for their roles in society.<sup>17</sup> In this case, the evidence shows that the individual, Prince Harry, is highly connected to the Invictus Games, by virtue of being a patron. This has been highly covered in the media, in some of the biggest newspapers, and the games itself have been televised since 2014 in the UK on one of the biggest UK Broadcasting corporations. On this basis, I consider that the evidence shows that the reputation of Prince Harry has attached itself to the words "INVICTUS GAMES", and that consumers when seeing the applicant's INVICTUS GAMES mark will automatically associate it with the applicant (a charitable organisation that hosts sporting events for injured veterans) and will bring to mind the association of its Patron Prince Harry.

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<sup>16</sup> *Interflora Inc v Marks and Spencer plc* [2015] EWCA Civ 1403, [2014] FSR 10 from [107] to [130]

<sup>17</sup> *Retail Royalty Company v Harringtons Clothing Limited*, O/593/20 paragraph 76

73. Therefore, conceptually, the INVICTUS GAMES element of the applicant's mark will evoke and bring to mind the charitable event hosted for injured veterans, and the fame of Prince Harry. I consider that the secondary "I AM" element of the applicant's mark does not alter the above conceptual message. Furthermore, I agree with Mr Malynicz that the opponent's INVICTA mark will be perceived to a significant proportion of average consumers as either an invented word, or an invented word which derives from Latin. On this basis, the marks are conceptually dissimilar.

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

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

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

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

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

76. I will begin with the inherent distinctiveness of the opponent's earlier mark. As highlighted above, I consider that the word INVICTA will be perceived to a significant proportion of average consumers as either an invented word, or an invented word which derives from Latin. On this basis, the mark is inherently distinctive to a high degree.

77. I also note that the opponent has pleaded enhanced distinctiveness. The relevant market for assessing this is the UK market.

78. Mr Stasio provided an overall turnover figure for 2017 to 2021 which amount to approximately €35.400.000. Whilst he also confirmed that the 2021 turnover figures were for products just for the UK only, he never provided a breakdown of the overall figure year-by-year, and therefore I am unable to determine the amount that only pertains to the UK. I note that the majority of the opponent's remaining evidence also pertains to the EU. The only evidence which specifically pertains to the UK is the two London 2019 invoices and the Amazon UK screenshots of its goods being available on the platform from 2017 to 2021. Mr Stasio did not provide any specific sales figures which were made specifically from its Amazon UK platform, or example invoices for this. I also note that as both invoices were to London it does not show geographical spread of the mark across the UK. I also note that there was no evidence of how many of its brochures were distributed to and across the UK. Whilst Mr Stasio provided market share figures for Italy, none has been provided for the UK. I also do not have any specific advertising figures or specific examples of advertisements distributed in the UK.

79. Therefore, taking the above into account, I do not consider the evidence sufficient to establish enhanced distinctiveness.

## **No evidence of actual confusion and honest concurrent use**

80. At paragraph 26 of Mr Newell's witness statement, he states that to the best of his knowledge and belief, there has never been "any real instances of confusion with the opponent (other than the one citation raised by the opponent in a local newspaper which I believe is nothing more than a typographical error)".

81. The newspaper article that Mr Newell refers to is exhibited at **RTM1**, whereby an article on [www.centrallifetimes.com](http://www.centrallifetimes.com), dated 30 May 2017, is titled "Michael on Invicta games duty". Directly below this title is a photo of a man standing next to Prince Harry wearing a top with the applicant's mark on it. However, I note that within the rest of the article itself, it refers to the games throughout as "Invictus Games".

82. Whether there is or is not actual confusion is of little or no significance, as it does not necessarily reflect the actual position regarding whether the average consumer would be aware of the respective marks on the market nor whether the consumer has been consistently exposed to them side by side in comparable market environments.<sup>18</sup> The absence of confusion is unlikely to be a determinative factor therefore, as it may be as a result of differences extraneous to the earlier mark.<sup>19</sup> It is not necessary, therefore, for the opponent to provide evidence of actual confusion as the assessment must be based on an objective test of all the relevant factors.

83. I also note that in paragraph 52 of the applicant's skeleton argument, it states that "the absence of any actual confusion is germane as it points to a period of honest concurrent use". At the hearing, Mr Lomas did not make any reference to honest concurrent use, and therefore, I asked him whether the evidence filed by the applicant, including the witness statement of Mr Newell, was filed in support of an honest concurrent use defence. Mr Lomas' responded by clarifying that it is "not a freestanding defence", but "all honest concurrent use does as a defence is to say there is not impact on the essential function of the earlier mark". Therefore the applicant's reference to it is in support of there being an absence of actual confusion.

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<sup>18</sup> *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41

<sup>19</sup> *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283

84. In *Extinction Rebellion*, the Hearing Officer considered the conflicting views of the CJEU and GC in so far as the reputation of the later mark and its relevance to the likelihood of confusion assessment. He stated:

“59.....Where the earlier mark is unused, or used over a short period of time, or on a small scale, **or in a different sector of the market, the likelihood of confusion with the later mark remains untested. In these circumstances, the use and ‘reputation’ of the later mark is indeed irrelevant.** Further where the later mark has been used on a more extensive scale than the earlier mark, it will do the applicant for registration no good to argue that the public will, or already do, confuse the goods/services marketed under the earlier mark with goods/services marketed under its own better-known mark. [so called wrong way round confusion]. This is because in *Comic Enterprises Ltd v Twentieth Century Fox Film Corp*<sup>20</sup> the Court of Appeal.. held that even “wrong way round” confusion infringes the rights of the proprietor of the earlier mark under section 10 of the Act. Therefore, it also constitutes a likelihood of confusion for the purposes of section 5 of the Act.” **(My emphasis)**

85. I also bear in mind that in *Roger Maier and Another v ASOS*<sup>21</sup> Kitchen L.J. (as he then was) said:

“..the absence of actual confusion despite **side by side use** may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion.” **(My emphasis)**

86. For the honest concurrent use defence to be successful, the applicant must show that the relevant public has shown itself able to distinguish between the goods, bearing the marks in question, without any confusion as to trade origin. Whilst in this case, I have clearly been provided with evidence by both parties that they have existed between 2017 to 2022, the marks have not been used side by side, or in other words, not used in the **same comparable market**. Whilst the applicant has established that

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<sup>20</sup> [2016] EWCA Civ 41

<sup>21</sup> [2015] EWCA Civ 220

INVICTUS GAMES has a reputation which conceptually evokes to a significant proportion of average consumers that it is charitable sporting event for injured veterans with Prince Harry as its patron, the evidence in regard to its class 18 and 25 goods is limited. As noted in paragraph 69 above I haven't be provided with sales figures or supporting invoices, and based on this alone I am confident to conclude that the applicant's evidence does not establish that the applicant commercially exploits the mark for the goods applied for, that being class 18 bags and class 25 clothing.

87. For the sake of completeness, the exceptional circumstances outlined in *Budejovicky Budvar NP v Anheuser-Busch Inc*,<sup>22</sup> and those factors in *Victoria Plum Ltd v Victorian Plumbing Ltd*<sup>23</sup> are not present in the case before me. I also note that in *Budejovicky Budvar*, paragraph 82 makes reference to the "long period of honest concurrent use between the marks", and in *Match Group, LLC & Ors v Muzmatch Ltd & Anor*<sup>24</sup> Arnold LJ held use which was initially infringing could eventually cease to be infringing if the trade mark proprietor took no action, there was substantial parallel trade for a long period, and as a result the trade marks came to be understood by the relevant class of consumers as denoting the goods/services of more than one trader.

88. In this case, the applicant's evidence confirms that the first INVICTUS GAMES was in 2014, and while Mr Stasio states that INVICTA was created in 1906, all of its evidence pertains to 2017 onwards. Therefore, on the basis that the evidence only shows the marks being used between 2017 to 2022, I do not consider that this is a significant period of time. Therefore, taking all of the above into account, I reject the applicant's claim of honest concurrent use.

### **Likelihood of confusion**

89. 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

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<sup>22</sup> Case C-482/09, EU:C:2011:605

<sup>23</sup> [2016] EWHC 2911

<sup>24</sup> [2023] EWCA Civ 454 at [115] to [117]

the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

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

- I have found the marks to be visually similar to at least a medium degree.
- I have found the marks to be aurally similar to a medium degree.
- I have found the marks to be conceptually dissimilar.
- I have found the opponent's mark to be inherently distinctive to a high degree.
- I have identified the average consumer for the goods to be members of the general public, who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process.
- I have found the parties' goods to be identical or similar to a high degree.

91. At the hearing Mr Maylicz argued that a likelihood of direct confusion would occur because people may read INVICTUS as INVICTA. However, taking all of the above into account, and even bearing in mind the principle of imperfect recollection, I am satisfied that the marks are unlikely to be mistakenly recalled or misremembered as each other. I recognise that conceptual differences do not always overcome visual and/or aural similarities,<sup>25</sup> and whether or not the conceptual differences are sufficient to outweigh the visual and aural similarities must be decided on the facts of each

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<sup>25</sup> *Nokia Oyj v OHIM*, Case T-460/07

particular case. In this decision, I have concluded that the marks are visually similar to at least a medium degree, aurally similar to a medium degree, and that the distinctiveness of the earlier mark is high. However, I am of the view that the difference created by the distinct conceptual hook (and reputation) of the words “INVICTUS GAMES” in the applicant’s mark, when compared to the invented word “INVICTA” in the opponent’s marks, is sufficient to alert consumers to the fact that the marks at issue do not feature the same word. In short, I do not consider that the consumer will, regardless of the shared use of the same first five letters, misread INVICTUS for INVICTA, or vice versa.<sup>26</sup> This is on the basis that the words “INVICTUS GAMES” in the applicant’s mark has a reputation, which conceptually evokes and brings to mind the charitable event hosted for injured veterans, and the fame of Prince Harry and the opponent’s INVICTA marks will be perceived either an invented word, or an invented word which derives from Latin. Moreover, I do not consider that the secondary “I AM” element, which will be recognised due to the get-up of the mark (including the use of the yellow and grey colours, and the stacking of the words INVICTUS GAMES) will be overlooked by the average consumer. I also bear in mind that all of the above elements in the applicant’s mark play an equal and important role in the overall impression. Consequently, I do not consider there to be a likelihood of direct confusion.

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

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

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<sup>26</sup> I say this in reliance upon the case of *CureVac GmbH v OHIM* in which it was determined that similar beginnings are not necessarily important or decisive.

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.”

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

94. At the hearing, Mr Malynicz submitted that if the differences were noticed by the consumer, they would think the applicant’s mark was indicative of a “sport line of bags or clothing” from INVICTA. Albeit not expressly said by Mr Malynicz, I consider that his argument still relies upon his submission contained in paragraph 91 above (that the consumer would read INVICTUS as INVICTA). However, for the same reasons as set out when considering direct confusion above, I am of the view that the differences between the elements “INVICTA” and “INVICTUS” would not be overlooked. Moreover, Mr Malynicz did not provide any further explanation of his reasoning as to why the average consumer would see the word “GAMES” at the end of the applicant’s mark as being indicative of a sports line of goods. Whilst the word “games” can be linked to sports, its link to sporting bags and clothing is tenuous at best, especially as the word “games” is neither directly descriptive nor allusive of the goods. As noted above, no singular element of the applicant’s mark plays a greater role in the overall impression, it lies in the combination of all these elements. I also remind myself that the average consumer does not dissect a mark. On this basis, I consider that when seeing the mark INVICTUS GAMES, which due to its get-up contains the secondary yellow words “I AM”, the average consumer would not expect this to be a logical sub-brand, brand extension or natural variant of the opponent’s “INVICTA” word mark, let alone a logical indication that the goods are a sporting range of clothing and bags. Consequently, I find there is not likelihood of indirect confusion.

## CONCLUSION

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

## COSTS

96. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of **£2,100** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Considering the Notice of opposition and preparing a Counterstatement	£200
Preparing and filing written submissions	£300
Preparing and filling evidence, and considering the other sides evidence	£800
Preparation for and attendance at hearing	£800
<b>Total</b>	<b>£2,100</b>

97. I therefore order Invicta S.p.A. to pay Invictus Games Foundation the sum of £2,100. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 18<sup>th</sup> day of July 2024**

**L FAYTER**

**For the Registrar**

## ANNEX 1

### **First Earlier Mark**

#### Class 18

Leather and imitations of leather, and goods made of these materials and not included in other classes; trunks and travelling bags; attaché cases; beach bags; briefcases; card cases [notecases]; chain mesh purses, not of precious metal; handbags; haversacks; pocket wallets; purses; purses, not of precious metal; shopping bags; sling bags for carrying infants; vanity cases [not fitted]; wheeled shopping bags; schoolbags; school satchels; rucksacks; backpacks.

### **Second Earlier mark**

#### Class 25

Articles of clothing, footwear, headgear; active wear, sportswear, namely trousers, sport suits, shorts; swimwear, bathing suits, bikinis, slips, swimsuit shorts, swimming caps; pareos, bras, ponchos; underwear, namely bodies, boxers, T-shirts, tank tops, bras, culottes, leotards, shorts, slips, thongs; leather wear and lounge bathrobes, nightdresses, pajamas; apparel of any design and nature made from fabrics of any nature, namely, pants, trousers, work clothing and work overalls, jeans, shorts, jackets, coats, waistcoats, overcoats, raincoats, hosiery, knitwear, sweaters, cardigans, fleece tops and bottoms, jumpers, twin sets, woven shirts; dresses, training and track suits, bodies, shirts, plush shirts, polo shirts, nightshirts for men, T-shirts, undershirts, cut and sew tops, dresses, skirts, trousers-skirts, gowns; socks; dressing gowns; bands; balaclavas, scarves, silk scarves, neck and face masks (bands); gloves and mittens, ski gloves; headwear, namely hats, caps, bandanas, basques, visors, wrist bands; belts and ties; footwear, shoes, dress shoes, sneakers, boots, chaps, sandals, slippers, sport and athletic shoes, studded shoes, mountaineering shoes; ski boots and trekking boots, gaiters, heeled shoes, bands for protecting face and ear from cold.