o/0780/24

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATON NO. 3813183
BY ORO ENTERPRISES LTD TO REGISTER AS A TRADE MARK:

Oro Gloves

IN CLASS 25.

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. OP000437619
BY ORRO BIKES LIMITED.

BACKGROUND AND PLEADINGS

1. On 25 July 2022, ORO ENTERPRISES LTD ("the applicant") applied to register the trade mark displayed on the cover page of this decision, under number 3813183 ("the application"). It was accepted and published in the Trade Marks Journal on 19 August 2022 in respect of the following goods:

> Class 25: Winter gloves; gloves; mittens; motorcycle gloves; driving gloves; cycling gloves; fingerless gloves; snowboard gloves; knitted gloves; riding gloves; ski gloves; gloves [clothing]; gloves for apparel; fingerless gloves as clothing; gloves including those made of skin, hide or fur, gloves with conductive fingertips that may be worn while using handheld electronic touch screen devices.

2. On 21 November 2022, the application was opposed by Orro Bikes Limited ("the opponent"). The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 ("the Act"), is directed against all of the goods specified in the application, and is reliant upon the following word only mark:

ORRO

UK Trade Mark registration number UK00003028422
Filing date: 29 October 2013
Registration date: 11 April 2014
Relying on the following goods only:

> Class 25: Clothing and headgear.

3. By virtue of its earlier filing date, the above registration constitutes an earlier mark within the meaning of section 6 of the Act. As the mark had completed its registration process more than five years before the filing date of the contested mark, it is subject to the proof of use provisions contained in section 6A of the Act.

4. In its notice of opposition, the opponent submits that the marks at issue are highly visually and phonetically similar, stating that the differences between the marks are minor. The opponent contends that the additional word ‘Gloves’ in the applied for mark is directly descriptive of the goods covered by the application, and that the inclusion of a single letter ‘r’ in the middle of the distinctive element of the contested mark is a negligible point of difference that is likely to go unnoticed by the relevant consumer. The opponent also argues that the applied for goods are all types of gloves which they consider are identical to ‘clothing’ for which the earlier mark is registered. In addition to this, the opponent submits that the applied for goods are similar to ‘headgear’ in their registered specification, as they be offered through the same trade channels.

5. The applicant filed a counterstatement denying that neither the marks, or the goods, are similar or identical as alleged by the opponent. They go on to state that the opponent’s goods are clothing and headgear, thus excluding gloves. Additionally, the applicant contends that the respective goods are neither competitive nor complementary, the uses are different, and the nature of the purchasing act is unalike. The applicant also submits that the applied for mark consists of two co-dominant words, namely, ‘Oro’ and ‘Gloves’, whereas the opponent’s mark is simply the single word ‘Orro’. They go on to state that an average consumer normally perceives a trade mark as a whole and would therefore notice the difference between the marks. The applicant also chose to put the opponent to proof of use in respect of its earlier mark.

6. The opponent is represented by Dehns and the applicant is unrepresented. Both parties filed evidence, however neither party requested a hearing and neither party filed written submissions in lieu. I make this decision having taken full account of all the papers, referring to them 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 applicant's evidence consists of the witness statement of Muhammad Ashfaq dated 14 September 2023, accompanied by 6 exhibits (MAW1 – MAW6). Mr Ashfaq is the Chief Executive Officer-cum-Director of Oro Enterprises Limited. The opponent's evidence consists of the witness statement of Ian Gordon Fox Wilson dated 13 July 2023 and is accompanied by 10 exhibits (IGFW1 – IGFW10). Ms. Wilson is the Chairman of Orro Bikes Limited. The purpose of the opponent's evidence is to demonstrate that the earlier mark has been put to genuine use for the goods on which the opponent relies.

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

DECISION

Proof of use

10. The applicant has requested proof of use in these proceedings in respect of the opponent's earlier mark. I will begin by assessing whether and to what

extent the evidence supports the opponent's statement that it has made genuine use of the mark in relation to the goods relied upon. The relevant period for this purpose is the five-year period ending with the date of the application in issue, namely 26 July 2017 to 25 July 2022.

11. The relevant statutory provisions are set out in Section 6A of the Act, which 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."

12. Section 100 is also relevant, which reads:

"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."

13. Consequently, the onus is upon the opponent to prove that genuine use of the earlier marks was made within the relevant territory in the relevant period, and in respect of the relevant goods as registered.

14. 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 Bundervsvereinigung 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]."

15. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the marks, in the course of trade, sufficient to create or maintain a market for the goods at issue in the UK during the relevant five-year period. In making the assessment, I am required to consider all relevant factors, including:

i) The scale and frequency of the use shown.
ii) The nature of the use shown.
iii) The goods for which use has been shown.
iv) The nature of those goods and the market(s) for them.
v) The geographical extent of the use shown.

Form of the Mark

16. There are many examples of use of the earlier mark as registered (word only) in the evidence, such as on the applicant's and third-party websites, including specialist digital publications; in product descriptions and listings on ecommerce websites; on invoices; as well as on the packaging and swing tags of the goods themselves. The mark also appears within the opponent's Instagram and Facebook pages (albeit next to the descriptive word 'bikes'). However, there is also use in the following form, as well as different colour combinations:

It is considered that the variant shown above would not be an acceptable variant and therefore cannot be relied upon.[1] I say this because while I appreciate that a word-only mark registered in black and white is capable of being used in any standard typeface and in any colour, the above variant goes beyond this notional and fair use. In short, I do not consider that the use shown will continue to be read as the word 'ORRO' meaning that the stylisation present in the variation alters the distinctive character of the mark and is more than merely the word only mark presented in a different font or typeface. I must make it clear though, as explained above, the mark as registered is shown to be used throughout the opponent's evidence alongside the variation above. The opponent may, therefore, rely on such use.

Genuine Use

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

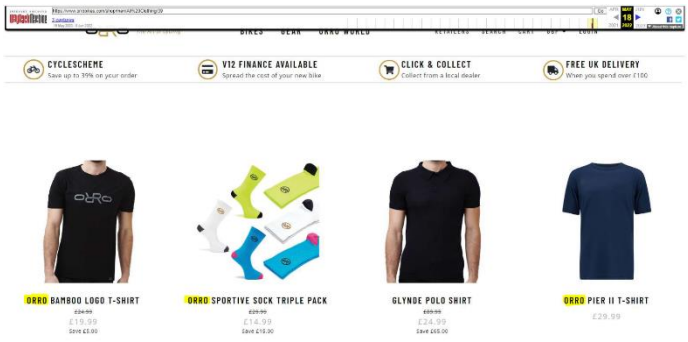
18. The opponent claims to have used its earlier mark 'ORRO' in relation to the following goods:

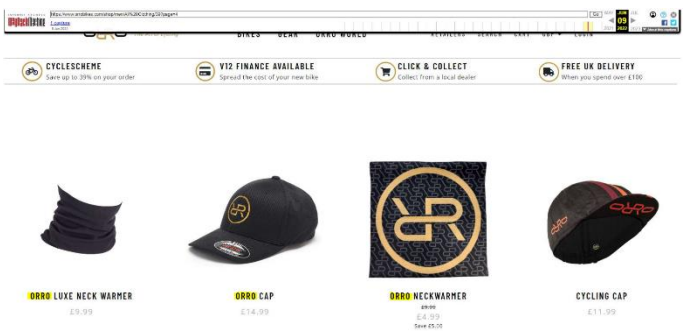
Class 25: Clothing and headgear.

[1] See the guidance of Phillip Johnson, sitting as the Appointed Person, in the case of *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22

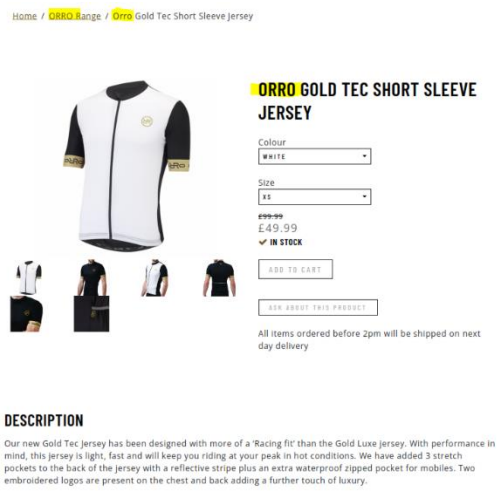
19. In his witness statement, Mr. Wilson states that his company has been doing business online, selling direct to customers via the website www.orrobikes.com since 2014, but that the company has held the domain name since 2013.[2] This is demonstrated in exhibit IGFW1 which is an extract from the domain lookup service provided by VeriSign, the official registry for .com domain names. Additionally, the witness statement displays a screenshot of the internet archive tool Wayback Machine that shows the website has been consistently available since 24 October 2013.

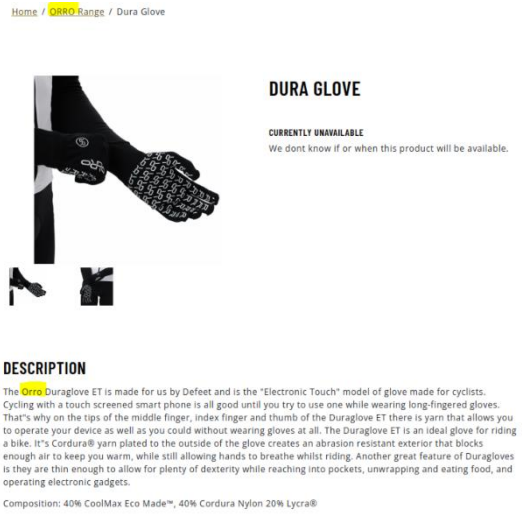
20. Exhibits IGFW2 and IGFW3 display internet extracts obtained from Wayback Machine, dated within the relevant period, that show the mark as registered in use on the opponent's website, as well as on the packaging of the goods themselves. Exhibit IGFW4 consists of screenshots of the opponent's website from 2020 displaying the 'new' ORRO clothing for that particular year. Exhibits IGFW5 and IGFW6 demonstrate use of the sign on an authorised third-party retailer website www.winstanleysbikes.co.uk and sister company website www.i-ride.co.uk respectively. The mark is shown on various types of clothing and headgear and the below screenshots merely serve to demonstrate this as an example.





[2] IGFW1





21. Exhibit IGFW7 consists of a selection of invoices bearing the mark as filed. These invoices demonstrate that the opponent has sold their goods throughout various parts of the UK including Glasgow, Wigan, Hereford, Leicester, Swansea to name a few. There are 36 separate invoices included in this exhibit and whilst no breakdown has been provided, I note that the snapshot of invoices show the shipment of over 250 items of clothing. Additionally, it is clear from the invoices that various different items of clothing have been sold by the opponent, including t-shirts, cycling gloves, arm warmers, neck warmers, caps, socks, cycling bibshorts, gilets and jerseys.

22. Exhibit IGFW8 displays screenshots from various printed and/or digital publications that serve to advertise the mark by way of reviews and comment pieces. Exhibit IGFW9 shows the opponent's goods being advertised on their Instagram and Facebook social media pages. However, there is no further information in the evidence as to the reach of these materials such as information as to how many copies were issued and to who, for example.

23. The opponent has provided sales information relating to sales of the relevant goods throughout the relevant period as shown below:

Year	Sales Revenue (GBP)
2017	1,209
2018	6,274
2019	8,741
2020	21,859
2021	52,402
2022	35,810
TOTAL	**126,295**

24. Given that the relevant period runs from July 2017 to July 2022, it is likely that some of the 2017 and 2022 figures provided in the above table fall outside of that. Such figures would not be relevant to the present assessment I must make. While there is no way for me to accurately breakdown what figures from 2017 and 2022 fall within the relevant period, this is a point I will bear in mind in making my assessment.

25. In considering the evidence as whole it appears to be lacking in respect of advertising spend, as well as reach of the promotional materials provided. Additionally, while assessing the evidence I bear in mind the size of the market at issue, namely the clothing industry. Whilst I have no evidence supplied by either party on the size of the market, it is considered that the clothing industry in the UK is huge, with a vast number of companies providing clothing goods. In this regard the above turnover figures are very low. However, I remain mindful of what was said in *easyGroup* that use of the mark need not always be quantitatively significant for it to be deemed genuine. Having considered the

evidence as a whole it is my view that the opponent has successfully provided sufficient evidence to justify genuine use during the relevant period for the purpose of creating or preserving market share for a proportion of the relevant goods.

Fair Specification

26. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. (with whom Underhill L.J. agreed) set out the correct approach for devising a fair specification where the mark has not been used for all the goods/services for which it is registered. He said:

> "64. [….] The court must identify the goods or services in relation to which the mark has been used in the relevant period and consider how the average consumer would fairly describe them. In carrying out that exercise the court must have regard to the categories of goods or services for which the mark is registered and the extent to which those categories are described in general terms. If those categories are described in terms which are sufficiently broad so as to allow the identification within them of various sub-categories which are capable of being viewed independently then proof of use in relation to only one or more of those sub-categories will not constitute use of the mark in relation to all the other sub-categories."

27. I also bear in mind the law summed up by Mr Geoffrey Hobbs Q.C (as he then was) as Appointed Person in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10:

> "In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with

the perceptions of the average consumer of the goods or services concerned.

28. I must now consider the fair description of the opponent's goods in Class 25, namely:

> Class 25: Clothing and headgear

29. Clothing and headgear are both broad terms and encompass a variety of clothing items, including gloves. On this point, the applicant's position in respect of gloves is that they are not items of clothing. While noted, I am of the view that gloves are indeed items of clothing and are defined as such in Collins Dictionary which describes them as *pieces of clothing which cover your hands and wrists and have individual sections for each finger.*[3] In my view, the evidence demonstrates that the genuine use has been shown in respect of some items that would be contained within these broad terms only, and therefore does not entitle the opponent to retain the broad terms 'clothing' and 'headgear'. In that regard I find that a fair specification of goods in Class 25 to be the following:

> T-shirts; cycling gloves; cycling clothing; sports socks; caps; neck warmers.

Section 5(2)(b): legislation and case law

30. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

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

[3] https://www.collinsdictionary.com/dictionary/english/glove

(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"

31. Section 5A of the Act states as follows:

"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."

32. 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.

The principles:

(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

33. Section 60A of the Act provides:

"(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the "Nice Classification" means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979."

34. 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 of its judgment 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."

35. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 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.

36. For the purposes of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Albingia SA v Axis Bank Limited,* BL O/253/18, a decision of the Appointed Person, Professor Phillip Johnson, at paragraph 42).

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

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

38. The goods to be compared are:

The opponent's goods	The applicant's goods
Class 25: T-shirts; cycling gloves; cycling clothing; sports socks; caps; neck warmers.	**Class 25:** Winter gloves; gloves; mittens; motorcycle gloves; driving gloves; cycling gloves; fingerless gloves; snowboard gloves; knitted gloves; riding gloves; ski gloves; gloves [clothing]; gloves for apparel; fingerless gloves as clothing; gloves including those made of skin, hide or fur, gloves with conductive fingertips that may be worn while using handheld electronic touch screen devices.

39. The opponent, in their notice of opposition contend that there is both identity and similarity in the respective class 25 goods. They go on to state that the applicant's goods are all types of glove, which are identical to the opponent's 'clothing'. Additionally, they argue that gloves are similar to their 'headgear' as they may be offered through the same trade channels.

40. The applicant, on the other hand, denies that there is any similarity between the goods concerned. They state that *'The Opponent's products are related to clothing and headgear to the exclusion of any business in selling gloves and therefore, the Applicant's and Opponent's products sold under the respective marks are neither identical nor similar. […] Moreover, the respective products*

associated with the two marks are neither competitive nor complementary. The use of the products as well as the average consumer of the products under the two trademarks is different; the nature of purchasing act is different.'

Cycling gloves.

41. This term appears in both the applicant's specification and the opponent's specification. It is therefore, self-evidently, identical.

Winter gloves; gloves; fingerless gloves; knitted gloves; gloves [clothing]; gloves for apparel; riding gloves; fingerless gloves as clothing; gloves including those made of skin [or] hide; gloves with conductive fingertips that may be worn while using handheld electronic touch screen devices.

42. In my view I consider the terms above in the applicant's specification broad enough to encompass many different types of gloves, including cycling gloves. There is nothing suggesting that the above terms of the applicant cannot be used for cycling and it is considered that cycling gloves may be made of leather or may be knitted. Further it is likely that when cycling, a user may wish to operate a mobile device such as a sat nav which will require the use of gloves with conductive fingertips so that the user doesn't need to take off their gloves to operate it. Therefore, as per the principals set out in *Meric,* these goods are considered identical.

Gloves including those made of […] fur

43. In general, the primary purpose of the contested goods is to be worn or to cover the hand for protection against cold or dirt. There is therefore a degree of similarity in purpose between the above contested goods and the opponent's 'cycling gloves.' I acknowledge that there may be a difference in what the user would wear fur gloves for however the nature of the goods is the same i.e., they are still gloves. The goods share the same end user, namely members of the general public, however, I do not consider the goods to share the same trade channels. The applicant's goods are likely to be sold via fashion retailers,

whereas the opponent's goods are likely to be sold via sporting goods retailers. I do not believe the goods to be in competition with one another, nor do they possess a complementary relationship. Bearing all of the above in mind, I find that the goods are similar but only to between a low and medium degree.

Snowboard gloves; ski gloves.

44. In general, the primary purpose of the contested goods is to be worn or to cover the hand for protection against cold or dirt. There is therefore a degree of similarity in purpose between the above contested goods and the opponent's 'cycling gloves.' I acknowledge that there is a difference in intended sport or activity that the goods will be used for, however the nature of the goods is the same i.e., they are all gloves. The goods share the same end user, namely members of the general public, however, I do not consider the goods to share the same trade channels. That being said, the goods are sold through the same distribution channels such as physical or online sporting goods retailers. I do not believe the goods to be in competition with one another nor do they possess a complementary relationship. Bearing all of the above in mind, I find that the goods are similar but only to a medium degree.

Motorcycle gloves; driving gloves

45. Again, it is considered that in general, the primary purpose of the contested goods is to be worn or to cover the hand for protection whilst riding a motorcycle or driving. There is therefore a degree of similarity in purpose between the above contested goods and the opponent's 'cycling gloves,' (more so for motorcycle gloves). I acknowledge that there is a difference in the activity that the goods will be used for, however the nature of the goods is the same i.e., they are all gloves. The goods share the same end user, namely members of the general public, however I do not consider the goods to share the same trade channels. The applicant's goods are likely to be sold via specialist motoring retailers, whereas the opponent's goods are likely to be sold via sporting goods retailers. I do not believe the goods to be in competition with one another, nor

do they possess a complementary relationship. Bearing the above in mind, I find that the goods are similar but only to between a low and medium degree.

Mittens

46. It is considered that in general, the primary purpose of the contested goods is to be worn or to cover the hand for protection against the cold. There is therefore a degree of similarity in purpose between the above contested goods and the opponent's 'cycling gloves.' Whilst that may be the case, the actual nature of the goods is slightly different because mittens are designed to be worn on the hands, however they traditionally do not contain finger inserts, like gloves. That being said, their natures still overlap to a degree on the basis that both goods are clothing items worn on the hand. In my view the users of the contested goods are the same in that both the applicant's and opponent's goods will be used by members of the general public. It is also considered that the goods do not share the same trade channels. The applicant's goods are likely to be sold via physical or online clothing retailers, whereas the opponent's goods are likely to be sold via sporting goods retailers. I do not believe the goods to be in competition with one another nor do they possess a complementary relationship. Bearing the above in mind, I find that the goods are similar but to a medium degree.

The average consumer and the nature of the purchasing act

47. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question (see *Lloyd Schuhfabrik Meyer,* Case C-342/97).

48. 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."

49. I have limited submissions from either party relating to the average consumer and nature of the purchasing act. The goods at issue are ordinary consumer goods that will be selected by members of the general public at large. The goods will likely be sold through a range of retailers and their online equivalents. In physical retailers, the goods at issue will be displayed on shelves or racks, where they will be viewed and self-selected by the consumer. A similar process will apply to online sales, where the consumer will select the goods having viewed an image displayed on a webpage. The selection of the goods at issue will, therefore, be primarily visual. That being said, I do not discount aural considerations in the form of advice sought from sales assistants or word of mouth recommendations.

50. The goods will be selected relatively frequently and will vary in cost. This is because goods such as gloves for apparel can be relatively low cost, however goods such as ski gloves may be more expensive. Regardless of the price of the goods, the average consumer will still give consideration to various factors such as size, current fashion trends, materials used, suitability and durability. These are relatively ordinary considerations and, as a result, I find that the average consumer will select the goods at issue whilst paying a medium degree of attention.

Comparison of trade marks

51. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union ("CJEU") stated at paragraph 34 of its judgement 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".

52. 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 trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

53. The trade marks to be compared are as follows:

Earlier trade mark	Contested trade mark
ORRO	**Oro Gloves**

54. The opponent submits that the marks at issue are highly visually and phonetically similar, stating that the differences between the marks are minor. They contend that the inclusion of only a single ‘r’ in the middle of the distinctive element of the contested mark is a negligible point of difference that is likely to go unnoticed by the relevant consumer. Further they argue that this is especially the case given that ‘Oro’ and ‘ORRO’ are phonetically identical. Finally, the opponent states that the marks are fanciful, and a conceptual comparison cannot be made, resulting in them being conceptually neutral.

55. The applicant submits that applied for mark consists of two co-dominant words, namely, ‘Oro’ and ‘Gloves’, whereas the opponent’s mark is simply the single word ‘Orro’. They state that the additional letter ‘R’ in the opponent’s mark renders the two marks vastly dissimilar from a visual perspective. Additionally, they argue that marks are not phonetically similar because the contested mark consists of two words, whereas the opponent’s is made up of one single word. Finally, the applicant denied that the conceptual comparison between the contested mark and opponent's mark cannot be made, stating that it, can be concluded from such conceptual comparison that the applicant's mark and opponent's mark are conceptually dissimilar.

Overall Impression

56. The opponent’s mark consists of the single word ‘ORRO’. There are no other elements in the mark to contribute to its overall impression, which lies in the word itself.

57. The applicant’s mark consists of two words, namely, ‘Oro Gloves’. There are no other elements in the mark to contribute to its overall impression, which lies in the words themselves. However, it is considered that the word “Gloves” is entirely descriptive of the goods concerned and thus makes a lesser contribution.

Visual Comparison

58. The opponent's mark consists of the single, four-letter word 'ORRO', whereas the applicant's mark consists of two words, the first being made up of the three letters 'O' 'R' 'O', and the second being the word 'Gloves'. The first word in the applicant's mark contains three of the letters that are present in the opponent's mark however, the missing letter 'R' and the additional word 'Gloves' in the applicant's mark creates a visual point of difference between the marks. Taking all of this into account and bearing in mind the overall impressions of the marks, I consider the marks to be visually similar to between a medium to high degree.

Aural Comparison

59. Aurally, the opponent's mark will be articulated as O-Row, as in the ending of the word 'tomorrow'. I also consider the same to be true for the first word in the applicant's mark despite there being one less letter 'R'. For some consumers, the descriptive nature of the word 'Gloves' will mean that they will not articulate it. In this case, both marks are aurally identical. However, I also consider that some consumers may articulate the word "Gloves", which would result in the marks being aurally similar to a medium degree.

Conceptual Comparison

60. The word 'ORRO' in the opponent's mark does not convey a concept. I consider that the relevant average UK consumer will ascribe no meaning to the word and instead conclude that 'ORRO' is an invented word or a word in a foreign language. Again, the same is true of the first word in the applicant's mark (Oro). To this extent, the marks will be conceptually neutral. The word element 'Gloves' (appearing in the applicant's mark only) will be perceived as a description of the goods by the average UK consumer. Given the descriptive nature of the word 'Gloves', it will not be perceived as a point of sufficient conceptual different that takes away from the conceptual neutrality created by the words 'ORRO' and 'Oro'. Therefore, it is considered that the marks, as wholes, are conceptually neutral.

Distinctive character of the opponent's mark

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

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see Windsurfing Chiemsee, paragraph 51)."

62. 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, to those with high inherent distinctive character, such as invented words which have no allusive qualities. Regardless of the fact it wasn't specifically pleaded, the opponent has filed evidence of use that is capable of being considered in the context of an assessment of enhanced distinctive character. Such a practice is common in proceedings before the

Tribunal. So, while I will consider the position in respect of enhanced distinctiveness, I will begin with assessing the inherent position.

63. The earlier mark consists of the plain word 'ORRO' without any additional stylisation or figurative elements. As such, the inherent distinctive character rests solely in the word itself. Given that the mark consists of a word that is likely to be perceived as invented, or a word in a foreign language, which will be attributed no particular meaning, I consider it to be inherently distinctive to a high degree.

64. In considering the position in respect of an enhanced distinctive character, I remind myself that I have assessed the opponent's evidence above when considering the issue of genuine use. While the evidence filed was sufficient to prove genuine use, I remind myself that the requirement for a finding of an enhanced distinctive character is considerably more onerous than that of genuine use. I say this on the basis that use need not be quantitatively significant in order for it to be genuine. On the contrary, a finding of an enhanced degree of distinctive character requires use at such a level that is capable of pointing to the fact that a proportion of consumers would identify the goods as originating from a particular undertaking. In light of this and the fact that the inherent position is already high, I find that there is no degree of enhanced distinctive character.

Likelihood of confusion

65. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related.

66. 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 (see *Sabel*, C-251/95, para 22). 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 services and vice versa (see *Canon*, C-39/97, para 17). It is necessary for me to keep in mind the distinctive character of the earlier marks, 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.

67. Whilst conducting a global assessment of the likelihood of confusion I must be aware of the fact that not all aspects of the respective marks will necessarily have the same impact. For example, the importance of the respective visual, aural and conceptual aspects will be dependent on factors such as the way the goods at issue are marketed, and in which type of store/platform they are made available.

68. Throughout the course of this decision, I have determined that:

- The respective goods range from being similar to a low/medium degree to identical, depending on the goods.

- The average consumer is members of the general public at large. They will demonstrate a medium level of attention during the purchasing process.

- The purchasing process for the goods and services will be primarily visual in nature, though aural considerations have not been excluded.

- The opponent's mark possesses a high degree of inherent distinctive character.

- The marks at issue are visually similar to between a medium and high degree. The marks are aurally identical if the descriptive word ‘Gloves’ is not articulated, or aurally similar to a medium degree if it is. The marks are conceptually neutral.

69. The opponent’s mark consists exclusively of the word ‘ORRO’, with no additional stylisation or figurative elements. The applicant’s mark contains the dominant distinctive element ‘Oro’. As indicated in *Kurt Geiger v A-List Corporate Limited* BL O-075-13, the likelihood of confusion is increased if the distinctive character resides in the element of the marks that are identical or similar. Thus, considering the overall levels of visual and aural similarity between the competing marks, I am of the view that the differences created by the descriptive word ‘Gloves’ as well as the minor visual difference where the additional letter is subsumed into the body of an otherwise identical word are likely to be overlooked by average consumers. Such differences are likely to be insufficient to distinguish the applicant’s goods from those of the opponent. Considering the principle of imperfect recollection, it is entirely foreseeable that the average consumer, even when demonstrating a medium level of attention during the purchasing process, will not recall the respective marks with sufficient accuracy in order to differentiate between them. Consequently, I find that there is a likelihood of direct confusion. Given the distinctive character of the opponent’s mark (being high) and the fact that consumers will overlook the differences between ‘ORRO’ and ‘Oro’, I consider that this finding applies even in circumstances where the marks are viewed on goods that are only similar to between a low and medium degree.

70. I turn now to consider a likelihood of indirect confusion. In respect of such, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

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)”.

71. Indirect confusion does not require an assessment on the basis that all differences are noticed. In the present case, I am of the view that regardless of whether the average consumer is able to recall the additional word element of the applicant's mark, there is at least a significant proportion of them who are still likely to overlook the difference between 'Oro' and 'ORRO'. As such, I am of the view that the differences that will be noticed are those that are likely to be considered logical indicators of sub-brand or brand extensions. For example, when considering the applicant's mark, the average consumer may consider it a brand extension of the opponent's mark on the basis that it is logical for a clothing company to create an extension that focuses on producing gloves. Consequently, I consider that there is a likelihood of indirect confusion. For the same reasons discussed when considering direct confusion above, I find that this applies even in circumstances where consumers view the marks on goods that are only similar to between a low and medium degree.

Conclusion

72. The opposition under section 5(2)(b) of the Act is successful in its entirety. Therefore, subject to any successful appeal, the application is refused registration for all goods.

Costs

73. As the opponent has been successful, it is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice ("TPN") 2/2016.[4] In the circumstances, I award the opponent the sum of £800. The sum is calculated as follows:

Filing a Notice of Opposition and considering the Counterstatement:	£200

[4] As the proceedings were commenced before 01 February 2023

Preparing evidence and considering the other side's evidence:	£500
Official fees:	£100
Total	**£800**

74. I therefore order **ORO ENTERPRISES LTD** to pay **Orro Bikes Limited** the sum of £800. 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 15th day of August 2024

Oliver Rose'Meyer
For the Registrar