

o/0907/24

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO. UK00003853673 AND UK00003853680

BY IN60 VENTURES LIMITED

TO REGISTER THE TRADE MARKS:



AND



IN CLASSES 25 AND 28

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 439609 AND 439610

BY ADIDAS AG

BACKGROUND AND PLEADINGS

1. On 28 November 2022, IN60 Ventures Limited (“the applicant”) applied to register the **673 Mark** and the **680 Mark** shown on the cover page of this decision in the UK. The applications were published for opposition purposes on 9 December 2022. The applicant seeks registration for the following goods for both marks:

Class 25 Clothing; footwear; headgear; visors; caps; hats; hooded tops; pullovers; tank tops; t-shirts; athletic footwear, namely outdoor shoes, indoor sports shoes, football shoes (indoor and outdoor), football boots, canvas shoes, urban sports shoes; sports apparel, namely fleece tops, jogging suits, knit sportswear, sport casual pants, polo-shirts, sweatshirts, sweatpants, soccer-style shirts, rugby-style shirts, socks, tights and leg warmers, tracksuits, functional underwear, singlets, wristbands, headbands, gloves, snow suits, snow jackets, snow pants; warm-up suits; sweatshirts; jackets; sports jackets; stadium jackets; blazers; rainwear; coats; uniforms; ties; wristbands; headbands; gloves; aprons; bibs (not of paper); toddler and infant playwear; belts; braces; sandals, thong sandals; parts and fittings for the foregoing.

Class 28 Sport balls; games and playthings; tables for table football; sporting toys; articles for sport; appliances for sport; soccer equipment, namely, soccer balls, gloves, knee pads, elbow pads, shoulder pads, shin guards, soccer goals; soccer goal walls; sporting bags and containers adapted for carrying sports articles; parts and fittings for the aforesaid.

2. The applications were both fully opposed by adidas AG on 8 March 2023. The oppositions are based upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). Under both sections, the opponent relies upon the following mark:

STREETBALL

UK registration no. UK00001502781

Filing date 5 June 1992.

Registration date 20 August 1993.

Relying upon all of the goods for which the earlier mark is registered, namely:

Class 25 Articles of outerclothing; sports clothing; footwear and parts and fittings therefor; all included in Class 25.

3. Under section 5(2)(b), the opponent only opposes the class 25 goods of both the applicant's marks, claiming a likelihood of confusion because the marks are similar to a high degree and the goods are identical or similar to a high degree.

4. Under section 5(3), the opponent only opposes the class 28 goods of both the applicant's marks, claiming that the applicant would take unfair advantage of the opponent's earlier mark by "free riding" on the reputation built up and enjoyed by the opponent over several years. The opponent also states that "the applicant would gain an un-earned "leg up" in the market place by benefitting from, inter alia, the marketing and promotional expenditure of the opponent without having paid towards it". Moreover, the opponent states that "in view of the nature of the specification terms claimed, if the quality provided by the applicant is poor, this could result in detriment to the repute of the opponent's earlier mark". Lastly, the opponent claims that "the earlier mark is uniquely distinctive of the opponent. Accordingly, use by the applicant of the opposed mark is liable to alter the economic behaviour of the relevant public such that they will cease to rely on the exclusivity of the earlier mark in order to identify the relevant goods", and that the distinctive character of the opponent's mark "will be blurred or eroded and, as a result, its power of attraction diluted".

5. The applicant filed a counterstatement in both proceedings, denying the claims made and putting the opponent to proof of use.

6. On 5 October 2024, the Tribunal wrote to the parties informing them of the consolidation of the opposition action no. 439609 and opposition action no. 439610. The opponent is represented by J A Kemp LLP and the applicant is represented by Cloch Solicitors. Neither party requested a hearing, however, both parties filed

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

RELEVANCE OF EU LAW

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 Sarah Talbot dated 29 September 2023. Ms Talbot is the VP of Global Trademarks for the opponent, a position she has held since 2019. Ms Talbot's statement is accompanied by 7 exhibits (ST1-ST7).

9. The applicant's evidence consists of the witness statement of Philip Hannay dated 4 December 2023. Mr Hannay is a lawyer at Cloch Solicitors, the representatives for the applicant. Mr Hannay's statement is accompanied by 3 exhibits (B-PH1-1 – B-PH1-3).

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

DECISION

Section 5(2)(b)

11. 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.”

12. The opponent’s mark qualifies as an earlier mark in accordance with section 6(1)(a) of the Act as its filing date is earlier than the filing dates of the applicants’ marks. As the opponent’s mark has completed its registration process more than five years before the filing dates of the marks in issue, it is subject to proof of use pursuant to section 6A of the Act.

Proof of use

13. I will begin by assessing whether there has been genuine use of the earlier mark. The relevant statutory provisions are as follows:

14. 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.”

15. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is the five years ending on the filing date of the applicants’ marks, i.e. 29 November 2017 to 28 November 2022.

16. 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

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

- a) Ms Talbot states that under the STREETBALL brand, the opponent sells sports shoes and trainers, “of which there have been numerous iterations since the brand’s inception and first marketing of the Streetball II trainer in 1993”.
- b) In 2019, the opponent used a basketball tournament held in New York, called The Streetball Challenge, to promote its STREETBALL mark via its social media channels globally. The event was also reported in an article called “Behind the Design and Cultural Impact of adidas’ Streetball Line” in Hypebeast dated 13 August 2019. This is exhibited at **ST4**, and I note the following information from this article:

- i. The article reports that adidas' senior designer "Pradeepan Indrakumar" told the interviewer that "the German sportswear brand first got the idea to bring back the streetball in 2017".
 - ii. Pradeepan Indrakumar also says that "there aren't that many outdoor basketball shoes out there in the market that compare to indoor versions, so with a lot of people playing on asphalt using all sorts of sneaker, [adidas] felt that now is the time to dig into our archives and reinvent Streetball for this generation".
 - iii. Pradeepan Indrakumar stated that "the original 1992 Streetball helped *introduce* an entire continent to street basketball".
 - iv. Pradeepan Indrakumar stated that "Streetball 2 was an exceptional sneaker" which had a durable rubber sole and provided enough traction to perform well on concrete and it had a comfy fit, "all in all, it was the best outdoor basketball performer of its time". He also states that's that "the later iterations didn't perform as well on the retail shelves, eventually landing at outlet stores and subsequently discontinued".
 - v. The article comments that as of that Saturday, being in August 2019, streetwear dominates the industry, "along with the growing popularity of basketball, adidas felt now is a better time as any to relaunch the Streetball line".
 - vi. Pradeepan Indrakumar stated that "we wanted to make a shoe which balances finely between the world of style and function, whilst appealing to the consumer who plays outside and to the consumer who has little or no interest in the game but appreciates the attitude of this sneaker."
 - vii. Lastly, the article states that "the adidas Originals Streetball is currently available in three colourways – black, white and orange- at selected retailers around the globe for \$110 USD. A larger release is slated for September".
- c) The above is supported by **exhibit ST5** which contains the opponent's 2019 Streetball trainers press release on its website, dated 17 September 2019. I note that this article again makes reference to the opponent going into its basketball archive, where the Streetball model was born during the golden age of street basketball, and how its newer release pays homage to its original

design. It also states that its worldwide release was on September 26th (2019), available on its website adidas.com/streetball.

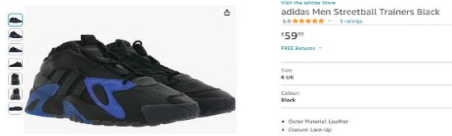

- d) The opponent has provided the following sales figures for the goods sold under their mark in the UK between 2019 to 2022:







| Year | Net Sales (GBP) |
|------|-----------------|
| 2019 | 89,021 |
| 2020 | 282,013 |
| 2021 | 79,881 |
| 2022 | 166,010 |

- e) I have also been provided with the following figures which reflects the number of products sold annually in the UK between 2019 to 2022:

| Year | Units Sold |
|------|------------|
| 2019 | 1,643 |
| 2020 | 6,898 |
| 2021 | 1,874 |
| 2022 | 2,938 |

- f) I note that the above figures are supported by **exhibit ST2** which contains screenshots of the opponent's goods for sale through different retailers. I note the following from this exhibit:

| Website | Date | Price | Photo and article code |
|--------------|--------------------------------------|--------|--|
| Amazon.co.uk | First available 12 May 2020 | £59.99 | EE5924  |
| Stock X | Release date 26 September 2019 | £71 | EF1908 adidas Streetball White Multi  |
| Stock X | -- | \$110 | EF6984 |

| | | | |
|-----------|------------------------------------|------------------------------|---|
| | | | <p>adidas Streetball Savannah</p>  |
| Fast Sole | Release date 31 October 2019 | £90 | <p>EE5925</p>  <p>adidas Streetball Red White EE5925</p> |
| Stock X | -- | \$110 | <p>FV4525</p> <p>adidas Streetball Grey Two Active Purple</p>  |
| Shoos | -- | £79.80 | <p>EF6989</p>  <p>ADIDAS STREETBALL £149.00 £ 79.80 £ Out of stock</p> |
| Amazon | -- | £234 | <p>EF1906</p>  <p>Brand: adidas adidas Streetball Mens Basketball Shoes EF1906 4.9 ★★★★★ 10 ratings £234⁰⁰ FREE Returns</p> <p>Size: 9.5 UK Colour: Core Black Solar Yellow Shock Pink</p> <p>Size chart</p> <ul style="list-style-type: none"> SKU: EF1906-10 Outer Material: Mesh, Leather Sole: Leather Closure: Lace-Up Heel Type: Flat Shoe Width: Medium |
| Goat | -- | Between £101 to £2,125 | <p>EE8303</p>  <p>Streetball J 'Cloud White' Adidas Sneakers Streetball</p> |

- g) The above is also supported by **exhibit ST6** which contains extracts of the opponent's sales records. This evidence reflects the data contained in paragraphs 17(d) and 17(e) above, and it also provides a breakdown using some of the above article codes. For example, from this exhibit I can determine that in 2019, 112 of the EE8303 were sold, amounting to £4,434.
- h) At **exhibit ST7** I have also been provided with a selection of adidas invoices from 2019 and 2020 showing the sale of the opponent's goods. Under the description/text" element of the invoices, the goods are listed as "STREETBALL". I note that the total quantity order of STREETBALL branded goods per invoice varies from as low as 6 to as high as 320 pairs, and that the invoices show that these goods have been distributed around the UK including in Devon, Aberdeen, Barnsley, Liverpool, London, Leicestershire, Bournemouth and Manchester.
- i) **Exhibit ST3** contains the following photo of the opponent's shoe (article code EF9598) where the word STREETBALL appears on the front face of the shoe tongue:



Assessment of genuine use and fair specification

18. As far as the form of the mark is concerned, I am satisfied that the mark has been used as registered. For the sake of completeness, I note that the word "STREETBALL" appears alongside the word "ADIDAS" in the retail evidence exhibited at **ST2**. However, although it is used in conjunction with another trade mark (i.e. ADIDAS), the

word “STREETBALL” is clearly visible and still continues to indicate origin.¹ I also note that the word “STREETBALL” appears in a stylised typeface on the shoe tongue exhibited at **ST3**. However, the stylisation is very minimal and does not alter the distinctive character of the mark.² Therefore both is acceptable variant use of the opponent’s mark.

19. As I have found the variant mark used in the evidence to be acceptable, I will now consider whether the evidence shows that the earlier mark has been genuinely used. 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.³ 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 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”.

20. I am satisfied that based on all of the above, including the UK sales and unit figures for 2019 to 2022, amounting to £616,925 from the sale of 13,353 trainers, which is supported by invoice, sales records and retailer evidence, that the opponent’s earlier mark has been put to genuine use in the UK in relation to trainers during the relevant period.

21. 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.⁴

22. It is clear from the evidence above that the opponent has sold trainers, otherwise known as sneakers (which is a US term). I therefore consider that the term “footwear” needs to be narrowed down to reflect the opponent’s trainers only (which I consider to be an appropriate sub-category). For the remaining class 25 terms; “articles of

¹ *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, paras 31-35

² *Dreamersclub Ltd v KTS Group Ltd*, BL O/091/19

³ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

⁴ *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch).

outerclothing”, “sports clothing” and “parts and fittings therefor; all included in Class 25”, the opponent has not shown any use.

23. I therefore consider a fair specification for the opponent’s earlier mark to be:

Class 25 Trainers.

Section 5(2)(b) - case law

24. 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

25. The parties' competing goods are as follows:

| Opponent's goods | Applicant's goods for both marks |
|---|--|
| <p data-bbox="204 253 336 286"><u>Class 25</u></p> <p data-bbox="204 309 336 342">Trainers.</p> | <p data-bbox="809 253 941 286"><u>Class 25</u></p> <p data-bbox="809 309 1391 1552">Clothing; footwear; headgear; visors; caps; hats; hooded tops; pullovers; tank tops; t-shirts; athletic footwear, namely outdoor shoes, indoor sports shoes, football shoes (indoor and outdoor), football boots, canvas shoes, urban sports shoes; sports apparel, namely fleece tops, jogging suits, knit sportswear, sport casual pants, polo-shirts, sweatshirts, sweatpants, soccer-style shirts, rugby-style shirts, socks, tights and leg warmers, tracksuits, functional underwear, singlets, wristbands, headbands, gloves, snow suits, snow jackets, snow pants; warm-up suits; sweatshirts; jackets; sports jackets; stadium jackets; blazers; rainwear; coats; uniforms; ties; wristbands; headbands; gloves; aprons; bibs (not of paper); toddler and infant playwear; belts; braces; sandals, thong sandals; parts and fittings for the foregoing.</p> |

26. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the 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.”

27. 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.

28. In *Gérard Meric v OHIM*, 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 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.”

29. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that “complementary” means:

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

30. In making my assessment, I note that the Tribunal Section of the Trade Marks Manual⁵ states that specifications which include the wording ‘namely’ should be interpreted as covering only the named goods within that specification.

Class 25

Footwear; athletic footwear, namely outdoor shoes, indoor sports shoes, [...] urban sports shoes.

31. The opponent’s “trainers” falls within the applicant’s above broader categories. The goods are identical on the principle set out in *Meric*.

Athletic footwear, namely [...] football shoes (indoor and outdoor), football boots, canvas shoes, [...]; sandals, thong sandals.

32. I consider that the applicant’s above goods are similar to the opponent’s “trainers”. All of the goods are footwear which are worn on the user’s feet for protection. Therefore, the goods overlap in user, nature, method of use and purpose. I consider that there would be an overlap in distribution channels because all of the goods would be sold by the same footwear retail stores. Furthermore, I consider that these goods would be sold in the same aisle (or at least in close proximity) of general retail stores. However, I also appreciate that there will be some undertakings which specialise in trainers, or specific sports shoes such as football boots. The goods are not

⁵ <https://www.gov.uk/guidance/trade-marks-manual/tribunal-section>

complementary; however, I consider that canvas shoes and trainers could be in competition as the user could choose either to wear on a day-to-day basis. Therefore, taking all of the above into account, I consider that the goods are similar to between a medium and high degree.

Sports apparel, namely fleece tops, jogging suits, knit sportswear, sport casual pants, polo-shirts, sweatshirts, sweatpants, soccer-style shirts, rugby-style shirts, socks, tights and leg warmers, tracksuits, functional underwear, singlets, wristbands, headbands, gloves, snow suits, snow jackets, snow pants; sports jackets; stadium jackets.

33. The applicant's above goods are similar to the opponent's "trainers". Whilst the goods are all worn when performing sporting activities, they are also worn on the user's body to provide protection, and thus overlap to some extent in purpose. However, I appreciate that the parties' goods are worn on different parts of the body. The goods will also overlap in user and trade channels, being sold by the same sporting apparel and footwear undertakings and located in close proximity within the same retail stores. Consequently, the goods are similar to between a low and medium degree.

Clothing; hooded tops; pullovers; tank tops; t-shirts; warm-up suits; sweatshirts; jackets; rainwear; coats; gloves.

32. The applicant's above goods would encompass sporting variants of those articles of clothing. Therefore, the same comparison applies in paragraph 33 above. The goods are similar to between a low and medium degree.

Headgear; visors; caps; hats; wristbands; headbands.

33. I consider that the applicant's above goods are similar to the opponent's "trainers". Whilst the goods can all be worn when performing sporting activities, they are also worn on the user's body to provide protection. The goods, therefore, overlap to some extent in purpose. However, I appreciate that the goods are worn on different parts of the body, with the applicant's goods protecting the user's head and wrists and the opponent's goods protecting the user's feet. The goods will be sold by the same

sporting apparel and footwear undertakings and located in close proximity within the same retail stores. The goods also clearly overlap in user. Therefore, taking all of the above into account, I consider that the goods are similar to between a low and medium degree.

Blazers; uniforms; ties; belts; braces.

34. I consider that the applicant's above goods are not similar to the opponent's "trainers". I note that the applicant's goods are formal wear clothing and accessories, which are worn on the user's body, whereas the opponent's trainers are worn on the user's feet, predominantly for sporting purposes. Therefore the goods do not overlap in nature, method of use and purpose. The goods are neither in competition nor complementary. Whilst I appreciate that all of the goods may be sold in general retail stores, (not in the same aisle or in close proximity), this is not enough on its own to establish similarity. I consider that the goods are dissimilar.

Aprons.

35. The applicant's above goods are worn to protect the user's clothing when cooking, whereas the opponent's "trainers" are to be worn on the user's feet to protect them when walking or participating in a sporting activity. Therefore the goods do not overlap in nature, method of use or purpose. They are also neither in competition nor complementary. Whilst I appreciate that all of the goods may be sold in general retail stores (not in the same aisle or in close proximity), this is not enough on its own to establish similarity. The parties' goods are dissimilar.

Bibs (not of paper); toddler and infant playwear.

36. The applicant's above playwear goods are comfy clothing which is worn by toddlers and infants, and bibs are worn by children to keep its clothing clean and protected when eating food. I therefore consider that these goods do not overlap in nature, purpose or method of use with the opponent's "trainers". They are also neither in competition nor complementary. The goods may all be sold in the same general retail stores (not in the same aisle or in close proximity); however, this is not enough

on its own to establish similarity. Taking all of the above into account, I consider that the parties' goods are dissimilar.

Parts and fittings for the foregoing.

37. As set out in *Les Éditions Albert René v OHIM*,⁶ it is clear that just because a particular good is used as a part, element or component of another, it should not result in a finding of identity/similarity between those goods. However, it does not mean that there can never be similarity between such goods where there is overlap in the factors identified in *Treat*.

38. In this instance, I consider that the applicants' parts and fittings for clothing, footwear, and headwear do not overlap with the opponent's "trainers". I do not find that the use, user or nature of the goods overlap. I also consider that there wouldn't be an overlap in trade channels as the applicants' parts of clothing, footwear and headwear would be purchased wholesale to be used in the production of the finished article, which would then go on sale to the general public. I do not consider that the goods are in competition nor complementary. Taking the above into account, I consider that the goods are dissimilar.

39. It is a prerequisite of section 5(2)(b) that the goods be identical or at least similar. The opposition will, therefore, fail in respect of the goods that I have found to be dissimilar.⁷

40. The opposition under section 5(2)(b), for both the 673 and 680 marks, against the class 25 goods only, fails for the following goods:

Class 25 Blazers; uniforms; ties; aprons; bibs (not of paper); toddler and infant playwear; belts; braces; parts and fittings for the foregoing; parts and fittings for clothing, footwear, headgear, visors, caps, hats, hooded tops, pullovers, tank tops, t-shirts, athletic footwear, namely outdoor shoes,

⁶ Case T-336/03

⁷ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

indoor sports shoes, football shoes (indoor and outdoor), football boots, canvas shoes, urban sports shoes, sports apparel, namely fleece tops, jogging suits, knit sportswear, sport casual pants, polo-shirts, sweatshirts, sweatpants, soccer-style shirts, rugby-style shirts, socks, tights and leg warmers, tracksuits, functional underwear, singlets, wristbands, headbands, gloves, snow suits, snow jackets, snow pants, warm-up suits, sweatshirts, jackets, sports jackets, stadium jackets, rainwear, coats, wristbands, headbands, gloves, sandals, thong sandals.

The average consumer and the nature of the purchasing act

41. 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 (as he then was) 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.”

42. 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 goods.

43. 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; *New Look Limited v OHIM*, Joined cases T-117/03 to T-119/03 and T-171/03, paragraph 50.

44. 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

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

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

46. 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.

47. The respective trade marks are shown below:

| Opponent's trade mark | Applicant's trade marks |
|--|--|
| <p style="text-align: center;">STREETBALL</p> | <div style="text-align: center;">  <p>("673 Mark")</p>  <p>("680 Mark")</p> </div> |

Overall Impression

48. The opponent's mark consists of the word "STREETBALL". There are no other elements to contribute to the overall impression which lies in the word itself.

49. The 673 Mark consists of the words "STREET" and "BALL" presented on top of each other, in a minimally stylised orange typeface, presented in a slanted manner. Underneath this is the word "SOCCER" presented in a significantly smaller, and minimally stylised orange typeface. On the left-hand side of the writing is a ball device which consists of loads of coloured lines. I bear in mind that the eye is naturally drawn to the element of the mark that can be read, and therefore I consider that the biggest words "STREET BALL", will play a greater role in the overall impression of the mark, with the smaller word "SOCCER", stylisation and the colourful ball device playing a lesser role.

50. The 680 Mark also consists of the words "STREET" and "BALL" presented on top of each other, in a minimally stylised orange typeface, presented in a slanted manner.

Underneath, in a smaller, handwritten black typeface, is the wording “Jaun de Lascurain”.⁸ However, I consider that due to the significantly smaller size and the handwritten nature of the typeface, that this wording would not be deciphered by the average consumer, and that a significant proportion would simply see it as a scribbled piece of text. Therefore, the biggest words “STREET BALL”, will play a greater role in the overall impression of the mark, with the scribbled text and stylisation playing a lesser role.

Visual Comparison

The opponent’s mark and the 673 Mark

51. The marks coincide in the presence of the word, or words, STREETBALL/STREET BALL. This acts as a visual point of similarity. However, I appreciate that there is a space between the words STREET and BALL in the 673 Mark whereas there is no space between them in the opponent’s mark. Registration of a word mark covers use in any standard typeface or colour and therefore these elements present in the 673 Mark do not contribute as visual points of difference.

52. However, the position of the words above each other, the small word “SOCCER” and colourful ball device in the 673 Mark do act as visual points of difference (albeit they play a lesser role in the overall impression). I therefore consider that the marks are visually similar to between a medium and high degree.

The opponent’s mark and the 680 Mark

53. The same considerations apply in paragraph 51 above. However, the 680 Mark includes the smaller scribbled piece of text element, which albeit plays a lesser role in the overall impression, it acts as a visual point of difference. Consequently, the marks are visually similar to a high degree.

⁸ This is the name of the designer of the applicant’s marks, as stated in Mr Hannay’s witness statement. I also note that **exhibit B-PH1-03** contains an article about him.

Aural Comparison

The opponent's mark and the 673 Mark

54. The opponent's mark will likely be pronounced as STREET-BALL. The colourful ball device in the 673 Mark will not be articulated, and therefore the mark will likely be pronounced as STREET-BALL SOCK-ER. The beginning of the marks are aurally identical. I therefore consider that the marks as a whole are aurally similar to between a medium and high degree.

The opponent's mark and the 680 Mark

55. The scribbled text at the bottom of the 680 Mark will not be pronounced by the average consumer, especially as a significant proportion will not be able to decipher what it says. Therefore the mark will likely be pronounced as STREET-BALL. On this basis, it is aurally identical to the opponent's mark.

Conceptual Comparison

The opponent's mark and the 673 Mark

56. In Mr Hannay's witness statement, I note that he has provided **exhibit B-PH1-01** which contains printouts from Wikipedia, RedBull and Urban Dictionary to demonstrate that "STREETBALL is wholly descriptive of a type of sport, namely basketball played outdoors".

57. Firstly, Wikipedia and Urban Dictionary are platforms that allows entries to be updated by the public. Therefore I consider that the information from both should be approached with a certain degree of caution. Secondly, whilst I note that the Red Bull article is dated 15 July 2022, and therefore falls within the relevant date, I note that it is from a .com website which therefore can be accessed all over the world, and not just in the UK. I also have not been provided with any supporting evidence of how many UK consumers have accessed or read this article. Nonetheless, the article mentions that the sport originates from "the parks and the streets of New York", and

that Red Bull has hosted streetball tournaments, but there is no reference to them being held in the UK.

58. Mr Hannay submits that traders include the word STREETBALL on their clothing when selling sporting goods or merchandise. **Exhibit B-PH1-2** contains printouts from “Religion Clothing”, “StreetballExtreme”, “SNS” and “Zazzle” to demonstrate this. However, the printouts are dated 4 December 2023 which falls after the relevant date.

59. Therefore, taking the above into account, I do not consider that the above evidence is enough to establish that the word “STREETBALL” would be known to at least a significant proportion of average consumers in the UK. However, the word “STREETBALL” is clearly combined of the ordinary dictionary word’s street and ball, and therefore, together, I consider that the concept conveyed by the opponent’s mark is a ball, or ball game, that is played on the streets.

60. The 673 Mark consists of the words “STREET BALL SOCCER”. I consider that this as a whole conveys the concept of a soccer ball being played on the streets. I also consider that the colourful ball device reinforces the meaning of “BALL”. Therefore, as both marks share the concept of street ball, I consider that they are conceptually similar to between a medium and high degree.

The opponent’s mark and the 680 Mark

61. The 680 Mark consists of the words “STREET BALL” which will convey the concept of a ball, or ball game, that is played on the streets. As noted above, the scribbled text at the bottom of the mark will not be deciphered, and therefore does not convey any conceptual meaning. Therefore, the opponent’s mark and the applicant’s 680 Mark are conceptually identical.

Distinctive character of the earlier trade mark

62. 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).”

63. 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.

64. I will begin with the inherent distinctiveness of the opponent’s “STREETBALL” mark. It consists of the two ordinary dictionary words “STREET” and “BALL”, which conveys the meaning of a ball, or ball game, that is played on the streets. This is not directly descriptive of the opponent’s footwear goods; however, it may be somewhat allusive as to when the goods may be worn, aka. whilst playing with a ball on the streets. On this basis, I consider that it is inherently distinctive to no more than a medium degree.

65. Although the opponent has not specifically pleaded enhanced distinctiveness, for the sake of completeness, I will make a finding as to whether I consider the evidence sufficient to demonstrate enhanced distinctiveness. The relevant market for assessing this is the UK market.

66. I have been provided UK invoice evidence, which is geographically spread across the UK (Devon, Aberdeen, Barnsley, Liverpool, London, Leicestershire, Bournemouth and Manchester). I have also been provided with UK sales figures for 2019 to 2022, which amounts to £616,925, which was made from the sale of 13,353 trainers (therefore averaging in price at £46.20 each). However, I consider that over a period of 4 years, the amount is not particularly high in relation to the goods. I also note that I have not been provided with UK market share figures, but based on the sales above, I consider that it would only amount to a small proportion of the market. Lastly, I note that I have not been provided with any advertising figures, or examples of this. I have only been provided with one third-party article which describes the “comeback” of the adidas STREETBALL line. Therefore, taking all of the above into account, I do not consider the evidence sufficient to establish enhanced distinctiveness.

Likelihood of confusion

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

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

673 Mark

- I have found the marks to be visually, aurally and conceptually similar to between a medium and high degree.
- I have found the earlier mark to be inherently distinctive to no more than a medium 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 range from being identical to similar to a between a low and medium degree.

69. Therefore, taking all of the above into account, considering the principle of imperfect recollection, and bearing in mind that both marks consist of, or include the words "STREETBALL"/"STREET BALL", (which play a greater role in the overall impression of the marks), I consider that there is a likelihood of direct confusion. Whilst these words are separated by a space in the 673 Mark, this would be easily overlooked or misremembered. I also consider that the colourful ball device in the 673 Mark would be easily overlooked by the average consumer, especially as it plays a lesser role in the overall impression. Moreover, the word SOCCER, which is presented at the end of the mark, and in a significantly smaller typeface size, would also be easily overlooked (again, especially as it plays a lesser role in the overall impression). Furthermore, given that the average consumer rarely has the opportunity to compare marks side-by-side and will instead encounter them in different settings at different times, to my mind, the between a medium and high degree of visual similarity between the marks will lead the average consumer to mistake one mark for the other, especially as the purchasing process is predominantly visual. Even where aural considerations apply, the between a medium and high degree of aural similarity between the marks

will have the same result. I therefore find that there is a likelihood of direct confusion, even on the goods that are similar to between a low and medium degree, due to the effect of the interdependency principle.

70. I will also assess if there is a likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C. sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

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

71. 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.

72. I consider that the shared common use of STREETBALL/STREET BALL in the parties’ marks will lead the average consumer to conclude that they originate from the same or economically linked undertakings. Whilst there is a space between the words “STREET” and “BALL” in the 673 Mark, I consider that the average consumer could still imperfectly recall them without a space. However, if the consumer did remember

a space between these words, they may perceive this as an updated presentation/stylisation of the opponent's mark alongside the use of the minimally stylised orange typeface and the coloured ball device. Moreover, the addition of the word "SOCCER" in the 673 Mark could be indicative of a sub-brand mark (STREETBALL being the house brand and STREET BALL SOCCER being the sub-brand focused on soccer-based goods). Taking the above into account, I find there to be a likelihood of indirect confusion, even on the goods that are similar to between a low and medium degree, due to the effect of the interdependency principle.

680 Mark

- I have found the marks to be visually similar to a high degree.
- I have found the marks to be aurally and conceptually identical.
- I have found the earlier mark to be inherently distinctive to no more than a medium 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 range from being identical to similar to between a low and medium degree.

73. Therefore, taking all of the above into account, considering the principle of imperfect recollection, and bearing in mind that both marks consist of, or include the words "STREETBALL"/"STREET BALL", (which play a greater role in the overall impression of the marks), I consider that there is a likelihood of direct confusion. Whilst these words are separated by a space in 680 Mark, this would be easily overlooked or misremembered. I also consider that the scribbled text element at the bottom of the mark, which is presented significantly smaller in size, and plays a lesser role in the overall impression of the mark, will be easily overlooked, especially as the consumer will not be able to decipher it. Furthermore, given that the average consumer rarely has the opportunity to compare marks side-by-side and will instead encounter them in

different settings at different times, to my mind, the high degree of visual similarity between the marks will lead the average consumer to mistake one mark for the other, especially as the purchasing process is predominantly visual. Even where aural considerations apply, the aural identity between the marks will have the same result. I also note that the marks are conceptually identical which means there is no conceptual hook to assist in differentiating between them. Consequently, taking all of the above into account, I consider that there is a likelihood of direct confusion, even on the goods that are similar to between a low and medium degree, due to the effect of the interdependency principle.

74. I also consider that, again, the shared common use of STREETBALL/STREET BALL will cause there to be a likelihood of indirect confusion. Whilst there is a space between the words "STREET" and "BALL" in the 680 Mark, I consider that the average consumer could still imperfectly recall them without a space. However, if the consumer did remember a space between these words, they may perceive this as an updated version of the opponent's mark, alongside the use of the minimally stylised orange typeface and the scribbled text element at the bottom of the mark, being indicative of re-branding. Taking all of the above into account, I find there be a likelihood of indirect confusion, even on the goods that are similar to between a low and medium degree, due to the effect of the interdependency principle.

Section 5(3)

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

"5(3) A trade mark which –

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

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

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

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

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

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

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

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

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

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

78. Whilst I note that the section 5(3) ground is aimed at a different set of goods to the 5(2)(b) ground, that being class 28, I can still deal with this ground relatively swiftly.

79. Earlier in my decision, I found that the distinctive character of the opponent's mark had not been enhanced through use. I recognise that reputation is not the same as enhanced distinctive character, but the same factors are to be taken into account in both assessments. Therefore, the evidence is, for the reasons set out above in relation to enhanced distinctiveness, insufficient to establish a reputation in the UK. Consequently, the opposition based upon section 5(3) falls at the first hurdle.

80. The opposition based upon section 5(3) of the Act is dismissed.

CONCLUSION

81. The opposition is partially successful under section 5(2)(b) in respect of the following goods, for which the applications are refused:

Class 25 Clothing; footwear; headgear; visors; caps; hats; hooded tops; pullovers; tank tops; t-shirts; athletic footwear, namely outdoor shoes, indoor sports shoes, football shoes (indoor and outdoor), football boots, canvas shoes, urban sports shoes; sports apparel, namely fleece tops, jogging suits, knit sportswear, sport casual pants, polo-shirts, sweatshirts, sweatpants, soccer-style shirts, rugby-style shirts, socks, tights and leg warmers, tracksuits, functional underwear, singlets, wristbands, headbands, gloves, snow suits, snow jackets, snow pants; warm-up suits; sweatshirts; jackets; sports jackets; stadium jackets; rainwear; coats; wristbands; headbands; gloves; sandals, thong sandals.

82. Both of the applications can proceed to registration in respect of the following goods, for which the opposition has been unsuccessful under sections 5(2)(b) and 5(3):

Class 25 Blazers; uniforms; ties; aprons; bibs (not of paper); toddler and infant playwear; belts; braces; parts and fittings for the foregoing; parts and fittings for clothing, footwear, headgear, visors, caps, hats, hooded tops, pullovers, tank tops, t-shirts, athletic footwear, namely outdoor shoes,

indoor sports shoes, football shoes (indoor and outdoor), football boots, canvas shoes, urban sports shoes, sports apparel, namely fleece tops, jogging suits, knit sportswear, sport casual pants, polo-shirts, sweatshirts, sweatpants, soccer-style shirts, rugby-style shirts, socks, tights and leg warmers, tracksuits, functional underwear, singlets, wristbands, headbands, gloves, snow suits, snow jackets, snow pants, warm-up suits, sweatshirts, jackets, sports jackets, stadium jackets, rainwear, coats, wristbands, headbands, gloves, sandals, thong sandals.

Class 28 Sport balls; games and playthings; tables for table football; sporting toys; articles for sport; appliances for sport; soccer equipment, namely, soccer balls, gloves, knee pads, elbow pads, shoulder pads, shin guards, soccer goals; soccer goal walls; sporting bags and containers adapted for carrying sports articles; parts and fittings for the aforesaid.

COSTS

83. In these consolidated proceedings, the applicant has enjoyed a greater degree of success and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023.

84. As noted at paragraphs 56 and 57 above, the applicant’s evidence did not assist the applicant. On this basis, I shall not be awarding any costs in relation to it. Consequently, I award the applicant the sum of **£550** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

| | |
|--|-------------|
| Considering the Notice of opposition and preparing a Counterstatement (x2) | £300 |
| Preparing and filing written submissions in lieu | £250 |
| Total | £550 |

85. I therefore order adidas AG to pay IN60 Ventures Limited the sum of £550. 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 17th day of September 2024

L FAYTER

For the Registrar