O/0930/24

TRADE MARKS ACT 1994

IN THE MATTER OF

APPLICATION NO. 3801580

IN THE NAME OF LANGIS LLC

TO REGISTER

AS A TRADE MARK IN CLASSES 9, 11, 25, 35

AND

OPPOSITION THERETO UNDER NO. 438106

BY

ORRO BIKES LIMITED

Background and pleadings

1. On 21 June 2022, LANGIS LLC ("***the Applicant***") applied to register in the UK the trade mark shown on the cover page of this decision, under number 3801580 ("***the Contested Mark***"). Details of the application were published for opposition purposes on 16 September 2022. Registration is sought for the following goods and services:

   Class 9 "*Batteries, electric; chargers for batteries; power cables; battery cables; chargers; accumulators, electric; lithium ion batteries; rechargeable batteries; wireless battery chargers; USB cables.*"

   Class 11 "*Heat generating apparatus; heating cushions, electric, not for medical purposes; heating cushions [pads], non-electric, not for medical purposes; heating installations; heat pads; cushions [pads] (Heating -), electric, not for medical purposes; electrically heated clothing; heaters; heating apparatus for use in the treatment of metal; socks, electrically heated.*"

   Class 25 "*T-shirts; cardigans; wetsuits; sweaters; footwear; caps being headwear; jackets; underwear; socks; sports jerseys; pants.*"

   Class 35 "*Business administration; advertising services for the promotion of e-commerce; import-export agency services; promotional services; market studies; online advertising on a computer network; providing business directory information via a global computer network; business consulting services; business management services relating to electronic commerce; advertising on the Internet for others.*"

2. On 16 December 2022 Orro Bikes Limited ("***the Opponent***") opposed the application under section 5(2)(b) of the Trade Marks Act 1994 (***"the Act"***). The Opponent relies upon its UK trade mark number 3028422 'ORRO' ("***the Earlier Mark***"). The Earlier Mark was filed on 29 October 2013. It became registered on 11 April 2014. The Opponent relies upon some goods covered by its registration, namely:

   Class 25: "*Clothing and headgear.*"

3. The Earlier Mark qualifies as an earlier mark under section 6(1) of the Act by virtue of its earlier filing date. As the Earlier Mark completed its registration procedure more than five years before the filing date of the Contested Mark, it is subject to the use

provisions set out in section 6A of the Act. The Opponent has stated that it has used the mark for all the goods relied on and given that the Applicant requested proof of use, the Earlier Mark is subject to the proof of use requirements.

4. The opposition is directed against some of the Applicant's goods, namely:

   Class 25: "*T-shirts; cardigans; sweaters; footwear; caps being headwear; jackets; underwear; socks; sports jerseys; pants.*"

5. The Opponent contends that in case the relevant consumer will read the Contested Mark as 'orro', the competing marks will be perceived as visually highly similar and phonetically identical. In the event the relevant consumer will read the Contested Mark as 'oror' the Opponent argues that the respective marks are visually similar to at least a medium degree and phonetically highly similar. The Opponent also contends that the respective marks are conceptually neutral and that the Contested Mark's stylisation is insufficient to offset the visual and phonetic similarity between the marks. The Opponent also submits that that the parties' goods are identical or highly similar, giving rise to likelihood of confusion.

6. The Applicant filed a counterstatement, denying the grounds of opposition.

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 and submissions

8. The Opponent is represented by Dehns and the Applicant by Trademarkit LLP. The Opponent filed evidence of use in the form of the Witness Statement of Mr Ian Gordon Fox Wilson and Exhibits IGFW1 – IGFW9. Mr Wilson is the chairman at Orro Bikes Limited. He states that he has held his current position since 2013 and is, therefore, duly authorised to file evidence on behalf of his company.[1]

[1] As per Witness Statement dated 18 July 2023.

9. Neither party requested a hearing. The Applicant filed written submissions in lieu. I will not summarise the parties' submissions here, but I will refer to them as and where appropriate during this decision. This decision is taken following a careful perusal of the papers.

Decision

Proof of use

10. I will begin by assessing whether there has been genuine use of the Earlier Mark.

The law

11. 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."

11. Section 100 of the Act 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."

12. Consequently, the onus is upon the Opponent to prove that genuine use of the registered trade mark was made in the relevant period (i.e., **22 June 2017 to 21 June 2022**).

Case law

13. 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]."

14. Proven use of a mark which fails to establish that "the commercial exploitation of the mark is real" because the use would not be "viewed 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" is, therefore, not genuine use.

Form of the mark

15. Before I move on to assess if the Opponent has shown genuine use, I must first consider if I find the use of the mark as shown in the evidence to be use of the mark as registered. As outlined in *Lactalis McLelland Limited v Arla Foods AMBA*, Case O/265/22,[2] the use of the mark in a different form may also constitute use of the mark as registered. While the Earlier Mark is registered as a word-only mark, I note that the evidence also shows some use of the two stylised logos represented below:

16. The Applicant submits that:[3]

> "*The use of the word mark ORRO appears to be very limited. Most of the use refers to the above-mentioned figurative marks which are not relied on in this opposition.*"

17. Whilst the Applicant's argument is noted, it is my view that the Opponent's use of the word mark 'ORRO' is not "very limited". Looking at the Opponent's evidence one can notice that when the Opponent uses the stylised logos (either directly on the goods or on tags), these are, in most cases, used in conjunction with the word mark 'ORRO'. I provide here some examples:

[2] At [13 – 15]. See also *Hyphen GmbH v EUIPO,* Case T-146/15, at [28-32].
[3] As per submissions in lieu dated 1 November 2023.

ORRO BAMBOO LOGO T-SHIRT

~~£24.99~~

£19.99

Save £5.00

ORRO SPORTIVE SOCK TRIPLE PACK

~~£29.99~~

£14.99

Save £15.00

Exhibit IGFW1 (page 1)

ORRO LUXE NECK WARMER

£9.99

ORRO CAP

£14.99

ORRO NECKWARMER

~~£9.99~~

£4.99

Save £5.00

CYCLING CAP

£11.99

Exhibit IGFW1 (page 6)

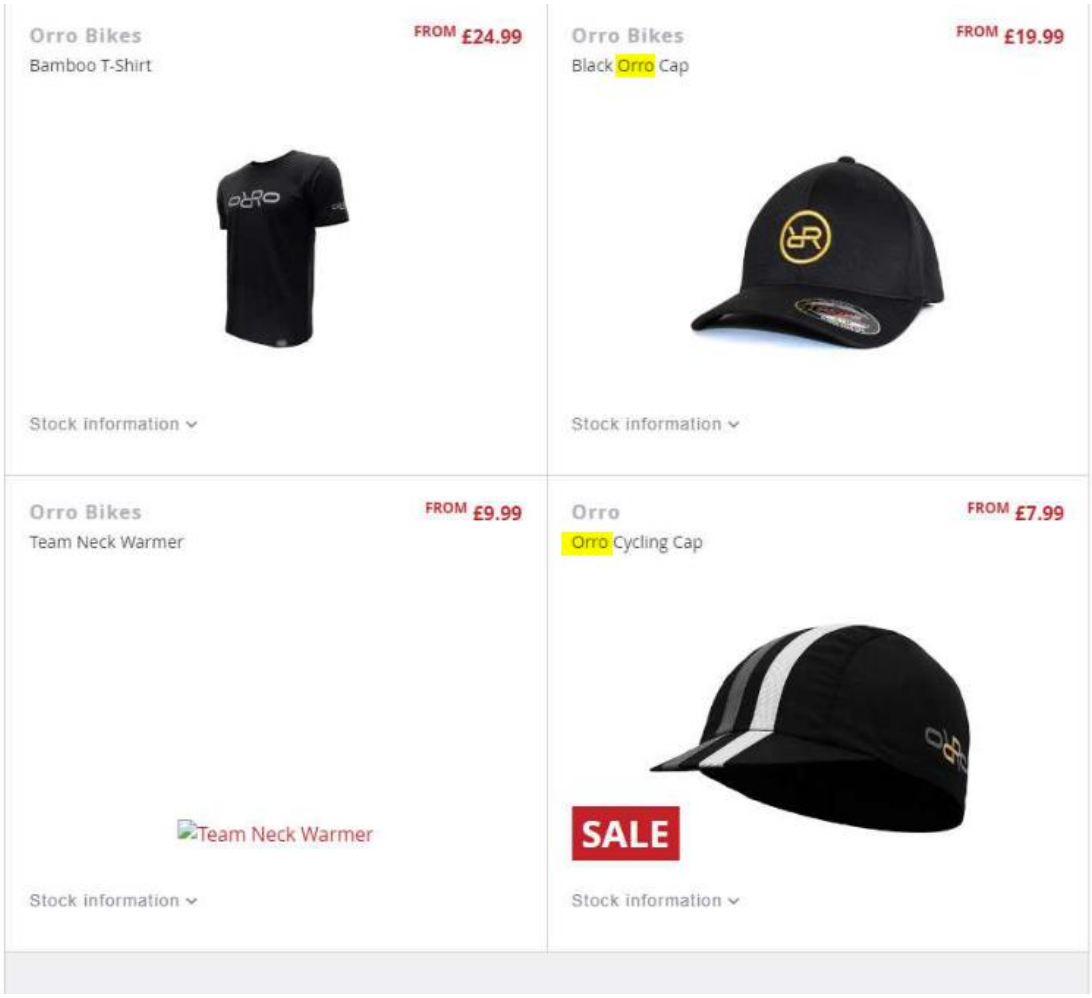

Exhibit IGFW6 (page 4)

Exhibit IGFW3 (page 24)

18. Additionally, the Opponent's evidence (**Exhibit IGFW8**) shows that third-party online reviews refer to the Opponent's relevant goods using the word mark 'ORRO'.

19. Having found that most of the evidence shows the Earlier Mark being used as a word only, I will not assess whether the (limited) use of the Earlier Mark in its stylised versions amounts to use of the mark as registered.

Evidence of use

20. The Opponent has claimed that genuine use has been made in relation to all the goods on which it relies under the Earlier Mark for the opposition purposes. I must consider whether, or the extent to which, the evidence shows genuine use of the Earlier Mark in relation to the goods covered under class 25, being:

    Class 25: '*Clothing and headgear'*

21. The Opponent's evidence shows the date of registration of its domain name and the website's activity throughout the relevant period, various extracts from its website (and third-party sellers of the Opponent's goods) showing the online retail of the relevant goods, invoices issued between 2017 and 2022, third-party reviews of the Opponent's goods, social media advertising, and annual sale figures throughout the relevant period.

22. I note the following from the Opponent's evidence:

- **Exhibit IGFW1** shows an extract from the domain lookup service provided by VeriSign, showing the Opponent's website (i.e. domain name) date of registration and its operativity since 2013.[4]
- **Exhibit IGFW2** comprises 'Wayback Machine' prints of pages of the 'ORRO' website (dated 18 May 2022, 9 June 2022, and 5 July 2022) showing examples of clothing available for purchase (i.e., t-shirts, socks, caps, leg and arm warmers, neck warmers, jerseys, jackets, gilets, bibtights, and jumpers).
- **Exhibit IGFW3** comprises 'Wayback Machine' prints of pages of the 'ORRO' website (dated 5 July 2022) showing details of products available on the Opponent's website to purchase (i.e., T-shirts, sleeveless baselayers, gilets, socks, caps, jerseys, bibshorts, neck warmers).
- **Exhibit IGFW4** features extracts from the Opponent's website showing images of clothing (i.e., jerseys, bibshorts, t-shirts, socks, bibtights, gloves, jumpers, jackets, gilets) on sale and details of the retailed products. The website page refers to the collection for spring 2020.
- **Exhibit IGFW5** contains Internet extracts (dated August/ September 2021) from the 'Wayback Machine' platform showing use of 'ORRO' for some of the Earlier Mark's goods (baseball cap, T-shirts, bibshorts, and a jacket) on the website 'Winstanleys Bikes' as an authorised third-party retailer.
- **Exhibit IGFW6** comprises 'Wayback Machine' prints of extracts of the website 'i-ride.co.uk' showing the Opponent's goods on sale. The Martlet Group Ltd is the Opponent's sister company that has common directorship with the Opponent's company and operates the website 'i-ride.co.uk'. The extracts are dated August/September 2020 and 20 April 2021.
- **Exhibit IGFW7** comprises a selection of invoices issued by Orro Bikes Limited and The Martlet Group Ltd ('i-ride.co.uk') to UK clients during the relevant period. The invoices' descriptions contain the mark 'ORRO' to identify the Opponent's goods.

[4] The Opponent's website first year of operativity is shown in the *Screenshot 1* of the WS (page 3).

- **Exhibit IGFW8** contains examples of advertising material in the form of online reviews from third parties commenting on the Opponent's goods.
- **Exhibit IGFW9** contains screenshots from the Opponent's Instagram and Facebook social media accounts showing the online promotion of the Earlier Mark throughout the relevant period.

23. In his Witness Statement Mr Wilson submits that the annual sales for the Opponent's goods in the UK amounted to the following:

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. In addition to the figures above, the Opponent also submits its annual sales for the 'Fox Wilson' collection:

Year	Sales Revenue (GBP)
2017	6,834
2018	6,160
2019	10,742
2020	1,698
2021	2,876
2022	10,522
TOTAL	38,832

25. I find these last sales figures to be relevant since in **Exhibit IGFW 2** (pages 8 – 11), with regard to the 'Fox Wilson' collection, evidence shows the use of the mark 'ORRO' for some of the relevant goods.

Assessment on genuine use

26. **Exhibit IGFW1** shows the registration date for the website 'orrobikes.com' on May 2013 and *Screenshot 1* in the WS shows some activity for the Opponent's website

already in 2013. I find this evidence irrelevant as it falls four years prior to the relevant period. In any case, the registration of a domain name does not, in itself, evidence use of a trade mark. **Exhibit IGFW2** contains extracts from the 'Wayback Machine' showing the website 'orrobikes.com' where the Opponent's has advertised its goods for sale using the 'ORRO' mark. Whilst some of the website extracts are within the relevant period (i.e. May and June 2022), other screenshots are dated just after the end of the relevant period (i.e. 5 July 2022). Overall, I find that **Exhibit IGFW2** provides some evidence that the Opponent has offered for sale its goods online using the Earlier Mark in the end part of the relevant period as I disregard the screenshots not pertaining to the relevant period.

27. **Exhibit IGFW3** contains two prints of the 'Wayback Machine' showing extracts from the Opponent's website with details of the relevant goods along with the Earlier Mark. These pages are dated outside the relevant period (5 July 2022). The remaining pages of the exhibit do not carry a date. Therefore, I will disregard this exhibit in its entirety.

28. **Exhibit IGFW4** (pages 1 to 3) shows some of the Opponent's goods (i.e., jerseys and bibshorts) being advertised as part of the 2020 collection along with their product pages showing the products' specifics (pages 4 and 5). Albeit pages 4 and 5 are undated, it is likely that these pages were available to consult in relation to the 2020 collection. The remaining pages of the exhibit are undated extracts of the Opponent's website with pieces of clothing (i.e., t-shirts, jackets, bibtights, socks, gloves, bibshorts, jumpers, neck warmers, caps, and gilets) being offered for sale. Although the pages are undated, the Opponent states that these pages were available in the relevant period (May and June 2022) or immediately after it (5 July 2022), analogously to the evidence provided in **Exhibit IGFW2**.

29. **Exhibit IGFW5** shows examples of the relevant goods (i.e., t-shirts, jumpers, bibshorts, and jackets) being offered for sale on a third-party authorised website (winstanleysbikes.co.uk) in September/August 2021. The Opponent's goods are displayed along with the Earlier Mark showing some use of the Earlier Mark in relation to 2021.

30. **Exhibit IGFW6** features extracts from the Opponent's sister website ('I-ride.co.uk') showing the relevant goods (i.e., t-shirts, caps, bibshorts, bibtights, jerseys, gilets, and

jackets) being advertised in dates contained within the relevant period (August/September 2020 and April 2021). This piece of evidence also contributes to show the use of the opponent's mark during part of the relevant period.

31. **Exhibit IGFW7** contains a selection of the Opponent's invoices spanning throughout the whole relevant period showing sales the Opponent made of its goods, such as t-shirts, caps, jerseys, gloves, bibshorts, gilets, bibtights, arm warmers (directly from its website or through the 'i-ride.co.uk' website) using the mark 'ORRO'. I find this evidence shows a continued use of the mark 'ORRO', covering the Opponent's goods (almost exclusively sportswear), within the relevant period and directed at consumers located in different parts of the UK.

32. **Exhibit IGFW8** provides a selection of third-party reviews of the Opponent's cycling clothing (i.e., jerseys, gilets, bibshorts, bibtights, and cycling shorts) issued within the relevant period. I notice that the reviewers refer to the relevant goods using the 'ORRO' mark as well as identifying the Opponent's company as the 'ORRO' brand.

33. **Exhibit IGFW9** features screenshots from the Opponent's social media platforms (Instagram and Facebook). The Instagram posts are dated throughout the relevant period, whilst the Facebook posts are undated. For the purposes of this opposition, I will take into consideration exclusively the examples provided of the Instagram posts that, in my view, contribute to show genuine use of the Earlier Mark. In the Instagram posts the Opponent uses the mark 'ORRO' to identify its goods. For example, one post states "don't forget your Orro Christmas wares" (referring to headwear and gloves),[5] another post advertises the 'Orro dura glove',[6] and another post refers to the Opponent's goods as their 'selection of Orro clothing'.[7] All the Instagram posts carry the 'orro' hashtag. Additionally, the consumers recognise 'ORRO' and use it to identify the relevant goods (e.g., in one Instagram post a consumer refers to his baseball cap as a "Orro baseball cap").[8]

34. In his Witness Statement the Opponent provides figures of his sales revenues broken down per year between 2017 and 2022. I notice that the sales figures are not large (especially in the first years of the relevant period). To this regard, I remind myself

[5] Exhibit IGFW9, page 5.
[6] Exhibit IGFW9, page 6.
[7] Exhibit IGFW9, page 10.
[8] Exhibit IGFW, page 4.

that the test is not whether a mark has been commercially successful but whether there has been real commercial exploitation of the mark intended to create and preserve an outlet for the goods/services which are sold under or in relation to that mark. Nonetheless, use which is neither token nor sham use, i.e., use simply to preserve a trade mark registration, may still be insufficient to constitute genuine use.[9] I also remind myself that the assessment of genuine use is not simply about sales figures. Limited evidence of sales may also, when considered alongside other evidence of use, be sufficient when all of the evidence is taken in the round.[10] This requires looking at the evidential picture as a whole, and not whether each individual piece of evidence shows use by itself[11]. Overall, although the sales figures are not particularly large, the Opponent successfully showed a consistent use of the Earlier Mark online to provide the sale of t-shirts, caps, socks, bibshorts, bibtights, jerseys, gilets, jackets, jumpers along with their purchase and distribution in the UK as per the invoices provided. The Opponent has also promoted its mark on social media and the Earlier Mark appears in third-party reviews. Therefore, it is my view that the Opponent has successfully demonstrated use of the Earlier Mark for sportswear.

Fair specification

35. Having reached the above conclusion, I must determine a fair specification upon which the opponent is entitled to rely, bearing in mind the use that has been demonstrated.

36. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. (as he then was) as the Appointed Person summed up the law as being (my underlying and emphasis):

> "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

[9] See the judgment of the General Court in Case T-250/13, *Naazneen Investments Ltd v OHIM*, EU:T:2015:160 and of the Appointed Persons in *Intermar Simanto v Nike Innovate CV* (Jumpman TM), BL O/222/16 and *SDS Investcorp AG v Memory Opticians Limited* (Strada del Sole TM), BL O/528/15.
[10] Case T-467/20 *Industria de Diseño Textil, SA (Inditex) v EUIPO*, EU:T:2021:842.
[11] *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09.

specification should accord with the perceptions of the average consumer of the goods or services concerned."

37. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]) (my underlining):

"iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd [2014]* EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; Thomas Pink at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in Pan World Brands v Tripp Ltd (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; Thomas Pink at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. Maier v Asos Plc [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as

those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

38. The Applicant argues that "*the goods covered by class 25 of the Opponent's mark are pieces of clothing for a particular sport, namely for cycling, and are addressed to professional cyclists*".[12]

39. Furthermore, the Applicant submits that:[13]

> "*According to the evidence filed, the above marks are used on items of clothing, namely T-shirts, socks, caps, neck warmers, jackets, vests, "bibtights", short-sleeved jerseys, gloves, and "bibshorts". The goods all appear to be items of "sports clothing" directed specifically to cyclists. The goods appear to be specialist items rather than ordinary clothing for day-to-day wear."*

40. And

> "*Even if sufficient use has been shown, a fair specification would be* ***"clothing for cyclists"****, which are aimed at professional cyclists"*.

41. To my mind, the Opponent's "*Clothing and headgear*" (upon which the opposition relies) is a very broad term. It covers all different types of wears, from formal attires to sportswear; they could be used for a vast range of different purposes. I note the Applicant's suggested limitation of the Opponent's specification to reflect its actual use of the goods. Whilst I bear in mind that the Opponent's use should not be described in the narrowest possible terms, it is my view that this is a broad category of goods which encompasses a number of subcategories capable of being viewed independently by consumers.

42. The evidence[14] shows the Opponent defines the relevant goods as "cycling clothes". For example, in relation to goods such as gloves (that could have different uses), evidence shows that the ones the Opponent provides are intended for cyclists.[15] The Opponent's invoices describe most goods as 'cycling' wear (e.g, cycling caps, cycling

[12] Notice of defence and counterstatement (page 4) dated 14 March 2023.
[13] As per submissions in lieu dated 1 November 2023.
[14] Exhibit IGFW4.
[15] Exhibit IGFW4, page 11 the Opponent states that "The Orro Duraglove ET is made for us by Defeet and is the "Electronic Touch" model of glove made for cyclists."

bibtights, cycling gilet, cycling jersey).[16] The third-party reviews provided in **Exhibit IGFW8** refer to the Opponent's goods as being cycling clothing.

43. Nonetheless I also note that the Opponent markets t-shirts at large[17] which can be used for various purposes and not exclusively for cycling.

44. I therefore consider that the term "*Clothing and headgear*" needs to be narrowed down to reflect, at the very least, that the Opponent's goods are sportswear. Consequently, I consider that a fair specification for the Earlier Mark to be:

Class 25: "*Clothing and headgear**, all being sportswear***".

Section 5(2)(b)

45. Sections 5(2)(b) and 5A of the Act read 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."
>
> "5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

Case law

The leading authorities which guide me are from the Court of Justice of the European Union (***"CJEU"***): *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*

[16] Exhibit IGFW7.
[17] Exhibit IGWF2 page 1 and 8.

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

46. When making the comparison, all relevant factors relating to the goods in the specification should be taken into account. In *Canon*, the CJEU stated at paragraph 23 of its judgment:

> "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".

47. Guidance on this issue has also 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 users of the respective goods or services;

b) The physical nature of the goods or acts of services;

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

d) 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;

e) 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.

48. The General Court ("GC") confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

> "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 fur 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."

49. The competing goods are as follows:

Opponent's goods	Applicant's goods
Class 25	**Class 25**
Clothing and headgear, all being sportswear.	T-shirts; cardigans; sweaters; footwear; caps being headwear; jackets; underwear; socks; sports jerseys; pants.

50. The Applicant concedes that the competing goods are identical or similar.[18] I agree with the Applicant and find that the competing goods are self-evidently identical. I appreciate that the Applicant's submission referred to the Opponent's wider specification "*clothing and headgear*" that would have been identical to the Applicant's specification in line with *Meric*. In light of the opponent's fair specification "*Clothing and headgear, all being sportswear*", I maintain that the competing goods are identical. If I am wrong in my assessment, I find the competing goods to be highly similar. Accordingly, the respective goods share the same nature (clothing), intended purpose (dress the wearer and keep it warm), and method of use. Additionally, the respective goods are normally sold through the same trade channels and can be in competition.

The average consumer and the nature of the purchasing act

[18] Submissions in lieu (paragraph 8) dated 1 November 2023.

51. It is necessary to determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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".

52. For the purposes 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 in question.[19]

53. The average consumer for the goods in Class 25 (clothing and sportswear) will be members of the general public. The cost of purchase is likely to vary but not to be excessively high, 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, wearability, durability, and suitability for purpose. Consequently, I consider that a medium degree of attention will be paid by the average consumer when selecting the goods.

54. The goods are likely to be obtained by self-selection from the shelves of a clothing retail outlet, online or catalogue equivalent. This means that the mark will be seen and so the visual element of the mark will be the most significant (see *New Look Limited v OHIM*, Joined cases T-117/03 to T-119/03 and T-171/03, paragraph 50). Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there will also be an aural component to the purchase, as advice may be sought from a sales assistant or representative.

[19] *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV,* (Case C-342/97, para 26).

Comparison of trade marks

55. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the CJEU held that:

> "54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer."

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

Earlier trade mark	Contested trade mark
ORRO	

Overall impression

57. The Contested Mark consists of the lower-case letters "o" and "r", reproduced twice alternatively, and placed in the gaps of an "X" symbol inscribed into a bold-edged circle. I find on balance that the letters and the figurative elements (i.e., the "X" separating the letters and the circle) equally impact the overall impression of the mark. The mark's stylisation does not prevent the relevant consumer from reading the letters contained in the mark (in whichever combination), but I believe that such stylisation still plays an important role in the mark's overall impression.

58. The Earlier Mark's overall impression resides in the single word of which it is composed.

Visual similarity

59. Both marks have in common the letters ‘o’, ‘r’, ‘o, and ‘r’. The Earlier Mark is verbal whereas the Contested Mark is figurative consisting of two separate lines crossing each other equally in the middle and each of the letters ‘o’, ‘r’, ‘o, and ‘r’ placed in the angles of the intersections of the crossing lines. The letters and crossing lines are inscribed into a circle. The manner in which the letters are disposed in the Contested Mark does not clearly form any readily understandable word.

60. Visually overall, I find the marks to be similar to a low degree.

Aural similarity

61. The Earlier Mark will be pronounced as the two-syllable word ‘OR – RO’.

62. In its notice of opposition, the Opponent argues that the relevant consumer is liable to perceive the Earlier Mark’s verbal element either as ‘orro’ or as ‘oror’, submitting that, in the first instance, the respective marks would be phonetically identical, whilst, in the second instance, the marks would be highly similar.

63. The Applicant argues that:

“*13. […] The overall graphic get-up and placement of the verbal elements of the sign make it instantly evident to consumers that the sign is composed of four verbal elements, which are independent and do not form a word.*

14. Even if consumers were to perceive the letters of the contested sign as forming a particular word, they would be likely to read the letters composing that sign in a clockwise manner, namely, in the following order: ‘O-R-O-R’, due to the fact that they are separated in this particular graphic arrangement by the ‘X’ symbol, as described above.”[20]

64. I agree with the Applicant’s argument. It is my view that the relevant consumers are likely to perceive the Contested Mark’s verbal element as a series of independent letters. This is because, first, given their unusual graphic disposition in the mark (being clearly separated by the ‘X’ symbol) and, second, because the consumers would not be able to derive from such letters any well-known dictionary word. In this instance I find the marks to be aurally different.

[20] As per submissions in lieu dated 1 November 2023.

65. In the unlikely eventuality the relevant consumers will derive a word from the Contested Mark, I find that, following basic reading rules (i.e., the top to bottom and left to right (clockwise) approach), they might perceive the letters ‘o’, ‘r’, ‘o, and ‘r’ to form the word ‘ORORʼ. In this circumstance the respective marks would both be two-syllable words and would share the first two letters ‘ORʼ. Therefore, I would find the marks to be aurally similar to a medium degree.

Conceptual similarity

66. The Earlier Mark consists of an invented word to which would be attributed no particular meaning. Regarding the Contested Mark, no combination of the letters contained in the mark forms a word with a specific meaning. The parties have not indicated any particular meaning for their respective marks. Therefore, I find that the competing marks to be conceptually neutral.

Distinctive character of the Earlier Mark

67. 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)."

68. Dealing first with the inherent distinctiveness of the Earlier Mark, the Opponent's mark 'ORRO' does not seem to have any English dictionary meaning (or in any other foreign language) and the Opponent did not indicate any potential meaning for this word. The Earlier Mark does not seem to describe or allude in any way to the goods for which it has been registered. Since the Earlier Mark is likely to be perceived as an invented word, without any semantic link to the goods in question, I believe it possesses a high degree of inherent distinctive character.

69. Turning to the question of whether the inherent distinctiveness of the Earlier Mark has been enhanced through use, the Opponent provided evidence that the Earlier Mark has been used in relation to clothing and sportswear in the UK at least since 2013. The Opponent provided evidence of distribution of its goods in various parts of the UK, consumer engagement given by multiple product reviews online and its social media platforms, and an average revenue of 33 thousand pounds per year between 2017 and 2022. Albeit the Opponent did not provide evidence showing the market share it occupies, or the investments made in promoting the mark, I can assume the sportswear market is worth millions (if not billions) of pounds. Therefore, although I find that the Opponent sufficiently proved use of the Earlier Mark, I do not believe that the evidence provided shows that the Earlier Mark has acquired enhanced distinctiveness through use.

Likelihood of confusion

70. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]). I must make a global assessment of the competing factors (*Sabel* at [22]), considering the various factors from the perspective of the average consumer and deciding whether the average consumer is likely to be confused.

71. The goods at issue are identical or highly similar, the members of the general public are likely to pay an average level of attention for the contested goods. The distinctiveness of the Earlier Mark is high. The marks have a visually low degree of similarity, aurally they are either different or similar to a medium degree (according to how the Contested Mark's verbal element is perceived) and are conceptually neutral.

72. The purchase of the contested goods is considered to be mainly visual but the potential for aural use is borne in mind.

73. I found that the marks could have a medium aural similarity, the goods are identical or highly similar, and the Earlier Mark is highly distinctive; these findings seem to weigh in the Opponent's favour. However, there is one factor, in particular, which weighs strongly against the Opponent, namely, my finding that the marks are visually similar to a low degree. This is of particular importance in the global assessment of the likelihood of confusion given that the purchasing act is likely to be primarily visual for all of the goods at issue.

74. Accordingly, in *New Look Ltd v OHIM* Joined cases T-117/03 to T-119/03 and T-171/03, the GC stated:

> "49 However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (BUDMEN, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs."

75. Weighing all of these factors I find that the average consumer, paying an average degree of attention, is not likely to mistake one mark for the other. Therefore, I do not consider there to be a likelihood of direct confusion.

76. Having found that there is no likelihood of direct confusion between the marks, I must now consider the possibility of indirect confusion. It should be borne in mind 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.[21] Further, there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.[22]

77. The marks at issue share the same letters “o”, “r”, “o”, and “o”. Whilst the Earlier Mark consists of the word ‘ORRO’, the Contested Mark contains the letters above, but they could not be perceived as a word at all being separated by intersecting lines. It is my view that the relevant consumers are unlikely to perceive the Contested Mark as being a different stylised rearrangement of the Earlier Mark.

78. In my opinion, a finding of indirect confusion on the basis that the Contested Mark contains the same alphabetical letters that compose the mark ‘ORRO’ (although arranged differently from the Earlier Mark), would be unfairly extending the protection of the Earlier Mark.

79. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as he then was, as the Appointed Person stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This would be mere association rather than indirect confusion. The fact that the Contested Mark contains the same letters of the Earlier Mark without considering the letter’s arrangement in the Contested Mark, is not reason enough, in and of itself, to find indirect confusion.

80. I therefore find there to be no likelihood of indirect confusion.

Conclusion

81. The Section 5(2)(b) opposition fails, and the application may proceed to registration.

Costs

82. The Applicant has been successful and is entitled to a contribution towards its costs. In approaching the award, I bear in mind that the counterstatement presented various

[21] In *Liverpool Gin Distillery Limited v Sazerac Brands LLC* [2021] EWCA Civ 1207, paragraph 13, Arnold LJ approved this “consolation prize statement” as made by James Mellor QC’s (sitting as the Appointed Person) statement in *Cheeky Italian Ltd v Sutaria* (O/219/16) paragraph 16.
[22] *Ibid*, Arnold LJ’s words at paragraph 13.

arguments about the marks; thus, I make an award higher than the scale minimum. Bearing in mind the relevant scale set out in the TPN 2/2016 I award costs as follows:

Considering the notice of opposition and filing a counterstatement	£250
Considering and commenting on the Opponent's evidence	£500
Preparing written submissions in lieu of a hearing	£300
Total:	**£1,050**

83. I order Orro Bikes Limited to pay LANGIS LLC the sum of **£1,050**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 24th day of September 2024

Andrea Rossi

For the Registrar