O/0946/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER UK00003868216
BY EVOKE COUNTRY & EQUESTRIAN LTD
TO REGISTER THE FOLLOWING TRADE MARK (AS A SERIES OF TWO):

Polaris
POLARIS

IN CLASSES 9, 18, 25, 28 AND 35

AND

AN OPPOSITION THERETO UNDER NUMBER 440541
BY POLARIS INDUSTRIES INC.

BACKGROUND AND PLEADINGS

1. On 13 January 2023, Evoke Country & Equestrian Ltd ("the Applicant") applied to register the trade mark shown on the cover page of this decision in the UK. The application was accepted and published for opposition purposes on 27 January 2023 in respect of goods and services in Classes 9, 18, 25, 28 and 35. Following a successful, partial opposition against the application in separate proceedings, the Applicant's specification is now as follows:[1]

Class 9: *Protective gloves;*[2] *protective helmets; riding helmets; safety helmets; all of the aforesaid being for equestrian use.*

Class 28: *Sporting articles for equestrian use; body protectors for equestrian use.*

Class 35: *Advertising, business management, business administration, office functions, provision of information to customers, provision of advice and assistance in the selection of goods, advertising services for others, all of the aforesaid services provided over the Internet, in a department store or over a computer network; all of the aforesaid services relating to equestrian activities.*

2. On 27 April 2023, Polaris Industries Inc. ("the Opponent") opposed the application based upon sections 5(2)(a), 5(2)(b) and 5(3) of the Trade Mark Act 1994 ("the Act").[3]

3. Under section 5(2)(a), the Opponent relies upon the following trade marks:[4]

[1] Opposition number 440185, issued on 29 November 2024 under BL number O/1148/24.
[2] This term was removed erroneously from the Applicant's specification when the register was amended following the previous opposition. This error will be rectified, depending on the outcome of these proceedings, when this decision is published.
[3] 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.
[4] I have removed reference to those goods which the Opponent has opposed but which have already been successfully opposed and removed from the Applicant's specification.

i. Trade mark number UK00901898196 ("the first earlier mark")

Representation: POLARIS

Filing date: 13 October 2000

Registration date: 20 February 2008

Specification relied upon:

Class 9: *Crash helmets; goggles; protective boots; armoured motorcycle clothing; protecting clothing for motorcyclists.*

Class 12: *Snow mobiles, all terrain vehicles and motorcycles; dune buggies; motorcycle parts and accessories; motorcycle panniers and saddlebags; luggage specifically adapted for motorcycle use; covers for motorcycles.*

Specification of the application being opposed:

Class 9: *Protective gloves; protective helmets; riding helmets; safety helmets; all of the aforesaid being for equestrian use.*

Class 28: *Sporting articles for equestrian use; body protectors for equestrian use.*

Class 35: *Advertising, business management, business administration, office functions, provision of information to customers, provision of advice and assistance in the selection of goods, advertising services for others, all of the aforesaid services provided over the Internet, in a department store or over a computer network; all of the aforesaid services relating to equestrian activities.*

ii. Trade mark number UK00912133625 ("the second earlier mark")

Representation: POLARIS

Filing date: 12 September 2013

Registration date: 4 February 2014

Specification relied upon:

Class 25: *Clothing, namely, shirts, jackets, pants, gloves, hats, bibs, and footwear.*

Specification of the application being opposed:

Class 9: *Protective gloves; protective helmets; riding helmets; safety helmets; all of the aforesaid being for equestrian use.*

Class 35: *Advertising, business management, business administration, office functions, provision of information to customers, provision of advice and assistance in the selection of goods, advertising services for others, all of the aforesaid services provided over the Internet, in a department*

store or over a computer network; all of the aforesaid services relating to equestrian activities.

iii. Trade mark number UK00917260472 ("the third earlier mark")

Representation: POLARIS

Filing date: 28 September 2017

Registration date: 2 March 2018

Specification relied upon:

Class 35: *Retail store and online retail store services in relation to recreational vehicles, parts and accessories for recreational vehicles, apparel, protecting riding gear, portable electric generators.*

Specification of the application being opposed:

Class 9: *Protective gloves; protective helmets; riding helmets; safety helmets; all of the aforesaid being for equestrian use.*

Class 28: *Sporting articles for equestrian use; body protectors for equestrian use.*

Class 35: *Advertising, business management, business administration, office functions, provision of information to customers, provision of advice and assistance in the selection of goods, advertising services for others, all of the aforesaid services provided over the Internet, in a department store or over a computer network; all of the aforesaid services relating to equestrian activities.*

4. Under section 5(2)(b), the Opponent relies upon the following trade mark:[5]

iv. Trade mark number UK00904437497 ("the fourth earlier mark")

Representation: 

Filing date: 12 May 2005

Registration date: 12 July 2006

Specification relied upon:

[5] I have removed reference to those goods which the Opponent has opposed but which have already been successfully opposed and removed from the Applicant's specification.

Class 9: *Crash helmets; goggles; protective boots; armoured motorcycle clothing; protective clothing for motorcyclist, riders of all terrain vehicles or water craft; mouse pads; cigarette lighters for vehicles.*

Class 12: *Apparatus for locomotion by land or air, snow mobiles, all terrain vehicles and motorcycles, apparatus for locomotion by water; watercrafts, water scooters, dune buggies, jet boats; parts and accessories for all the aforesaid goods; motorcycle parts and accessories; motorcycle panniers and saddlebags; luggage specifically*[6] *adapted for motorcycle use; covers for motorcycles.*

Specification of the application being opposed:

Class 9: *Protective gloves; protective helmets; riding helmets; safety helmets; all of the aforesaid being for equestrian use.*

Class 28: *Sporting articles for equestrian use; body protectors for equestrian use.*

Class 35: *Advertising, business management, business administration, office functions, provision of information to customers, provision of advice and assistance in the selection of goods, advertising services for others, all of the aforesaid services provided over the Internet, in a department store or over a computer network; all of the aforesaid services relating to equestrian activities.*

5. Under section 5(2)(a), the Opponent claims that the first to third earlier marks are identical to the Applicant's mark and that the respective goods/services, set out above, are similar, resulting in a likelihood of confusion.

6. Under section 5(2)(b), the Opponent claims that the fourth earlier mark is similar to the Applicant's mark and that the respective goods/services, set out above, are similar, resulting in a likelihood of confusion.

7. Under section 5(3), the Opponent relies upon the fourth earlier mark to the following extent:[7]

[6] I have corrected the misspelling of this word ("specigfically") on the register for the purposes of this decision.

[7] I have removed reference to those goods which the Opponent has opposed but which have already been successfully opposed and removed from the Applicant's specification.

Specification relied upon:

Class 12: *Apparatus for locomotion by land or air, snow mobiles, all terrain vehicles and motorcycles, apparatus for locomotion by water; watercrafts, water scooters, dune buggies, jet boats; parts and accessories for all the aforesaid goods; motorcycle parts and accessories; motorcycle panniers and saddlebags; luggage specifically*[8] *adapted for motorcycle use; covers for motorcycles.*

Specification of the application being opposed:

Class 9: *Protective gloves; protective helmets; riding helmets; safety helmets; all of the aforesaid being for equestrian use.*

Class 28: *Sporting articles for equestrian use; body protectors for equestrian use.*

Class 35: *Advertising, business management, business administration, office functions, provision of information to customers, provision of advice and assistance in the selection of goods, advertising services for others, all of the aforesaid services provided over the Internet, in a department store or over a computer network; all of the aforesaid services relating to equestrian activities.*

8. Under section 5(3), the Opponent also relies upon the following trade mark:[9]

v. Trade mark number UK00900295352 ("the fifth earlier mark")

Representation: POLARIS

Filing date: 1 April 1996

Registration date: 21 December 2001

Specification relied upon:

Class 12: *Vehicles, including land vehicles, namely snowmobiles, all terrain vehicles and motorcycles; vehicles for locomotion by water, watercrafts, waterscooters, dune buggies, jet boats.*

Specification of the application being opposed:

[8] I have corrected the misspelling of this word ("specigfically") on the register for the purposes of this decision.

[9] I have removed reference to those goods which the Opponent has opposed but which have already been successfully opposed and removed from the Applicant's specification.

Class 9: *Protective gloves; protective helmets; riding helmets; safety helmets; all of the aforesaid being for equestrian use.*

Class 28: *Sporting articles for equestrian use; body protectors for equestrian use.*

Class 35: *Advertising, business management, business administration, office functions, provision of information to customers, provision of advice and assistance in the selection of goods, advertising services for others, all of the aforesaid services provided over the Internet, in a department store or over a computer network; all of the aforesaid services relating to equestrian activities.*

9. Under section 5(3), the Opponent claims to have a reputation in the UK in its fourth and fifth earlier marks for the goods set out above. The Opponent claims that use of the Applicant's mark, for all the goods/services in its specification, would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier marks.

10. In accordance with section 6A of the Act, the Opponent's first, second, fourth and fifth earlier marks are subject to the proof of use provisions set out therein, on the basis that they had been registered for at least 5 years at the date of application for the Applicant's mark. Conversely, the Opponent's third earlier mark is not subject to proof of use.

11. On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all rights holders with an existing EU trade mark ("EUTM"). As a result of the Opponent having EUTMs protected as at the end of the Implementation Period, comparable UK trade marks were automatically created. The Opponent's five earlier marks in these proceedings are comparable trade marks, which are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and retain their original filing dates.

12. The Applicant filed a defence and counterstatement denying the majority of the Opponent's claims but making some admissions, as follows:

i. Under section 5(2)(a), the Applicant admits that its mark is identical to the Opponent's first, second and third earlier marks.

ii. Under section 5(2)(b), the Applicant admits that its mark is aurally identical and visually similar (although not highly similar) to the Opponent's fourth earlier mark.

iii. Under section 5(3), the Applicant admits that its mark is identical to the Opponent's fifth earlier mark.

13. Pertinently, the Applicant puts the Opponent to proof of use of the first, second, fourth and fifth earlier marks for all the goods relied upon under the respective grounds of opposition. Further, the Applicant puts the Opponent to proof of its claimed reputation in the fourth and fifth earlier marks for all the goods relied upon under section 5(3).

14. During the evidence rounds, the Opponent filed evidence in chief alongside written submissions and the Applicant filed evidence in chief, but the Opponent did not file evidence in reply. A hearing took place before me on 10 October 2024. The Opponent was represented by Mr Guy Tritton of Hogarth Chambers, instructed by Alicante IP, S.L.; the Applicant was represented by Mr Jonathan Hill of 8 New Square chambers, instructed by Franklins Solicitors LLP.

EVIDENCE AND SUBMISSIONS

15. The Opponent filed evidence in chief in the form of the witness statement of Julie Melendez Reicis dated 22 November 2023 and its corresponding exhibits (labelled A1 – A37[10]). Ms Reicis is Director of Legal – Intellectual Property & Commercial at the Opponent. The accompanying submissions are dated 17 November 2023.

16. The Applicant filed evidence in chief in the form of the witness statement of David Lee Mitson dated 26 January 2024 and its corresponding one exhibit (labelled DLM1). Mr Mitson is the Managing Director of the Applicant.

[10] There is no exhibit A34.

17. I have taken the entirety of the evidence and submissions into account in reaching this decision and will refer to them below where necessary.

DECISION

Proof of use

Statutory provisions

18. Section 6A of the Act is as follows:

> "(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.”

19. As the earlier marks are comparable marks, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7. (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union."

20. Accordingly, for the purposes of assessing proof of use, the earlier marks will be treated as EUTMs for the part of the relevant period before IP completion day and, as such, use in the EU may be sufficient.

21. Section 100 of the Act is also relevant, which reads:

"100. 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."

Relevant case law

22. 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]."

23. In *Awareness Limited v Plymouth City Council,* Case BL O/236/13, Mr Daniel Alexander QC (as he then was) as the Appointed Person stated that:

"22. The burden lies on the registered proprietor to prove use. […] However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public."

24. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd,* Case BL 0/404/13*,* Mr Geoffrey Hobbs QC (as he then was) as the Appointed Person stated that:

"21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed

in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

> '[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.'

> 22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not *'show'* (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use."

25. What I take from this case law is that there is no requirement to produce any specific form of evidence, but that I must consider what the evidence as a whole shows me and whether on this basis I can reasonably be satisfied on the balance of probabilities that there has been genuine use of the marks.

26. Whether the use shown is sufficient will depend on whether there has been real commercial exploitation of the marks, in the course of trade, sufficient to create or

maintain a market for the goods at issue during the relevant five-year period. In making the assessment, I am required to consider all relevant factors, including:

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

Relevant period

27. For the purposes of these proceedings, the relevant period in which the Opponent must demonstrate genuine use of its first, second, fourth and fifth earlier marks is the five-year period ending with the date of application for the Applicant's mark, i.e., 14 January 2018 to 13 January 2023 ("the relevant period"). For the purposes of this section of my decision, the first, second and fifth earlier marks will be referred to as "the word mark", and the fourth earlier mark as "the figurative mark".

Assessment of the evidence

Challenges to the evidence

28. The Opponent filed evidence of use of its earlier marks during the evidence rounds of these proceedings, comprising Ms Reicis' witness statement and associated exhibits. Whilst the Applicant chose to file some limited evidence in chief, such evidence – save for reference to one of the Opponent's exhibits (printouts from Amazon) – included no challenges to the Opponent's evidence. No written submissions were filed by the Applicant. The Opponent subsequently elected not to file evidence in reply.

29. Despite the absence of evidence/submissions contradicting or criticising Ms Reicis' narrative or documentary evidence, the Applicant's skeleton argument for the hearing included numerous attacks on the accuracy and reliability of her evidence, including:

(i) no evidence relates to any part of the EU, despite EU use being relevant for part of the relevant period;

(ii) no UK sales figures are provided in relation to any goods;

(iii) various criticisms of the invoices, including:

(a) the low quantities on the invoices;

(b) it not being possible to tell what the goods are from the descriptions;

(c) a suggestion that these are not a sample but are all invoices of relevant sales;

(c) it not being possible to tell whether the earlier marks are used on the goods themselves;

(d) the invoices including goods not relied upon;

(e) the invoices not including any sales of boots or motorcycle clothing;

(f) two invoices being Polaris Britain Limited invoicing itself;

(g) the total relevant sales being less than 250 items with a value significantly below £4,662; and

(h) there being no record of commercial sales to dealers, rather the invoices record trivial numbers of goods in tiny consignments with substantial discounts;

the effect being that the sales recorded on the invoices do not appear aimed at establishing a market in the relevant goods;

(iv) no evidence of the catalogues being distributed in the UK;

(v) the Amazon screenshots post-date the relevant period;

(vi) the online retail pages are mostly from US websites and post-date the relevant period;

(vii) no sales figures for any of the goods in Class 12 have been provided;

(viii) of the evidence that does relate to Class 12 goods, it relates broadly to ORVs (off-road vehicles), which include ATVs (all-terrain vehicles) and side-by-side vehicles, rather than any of the specific vehicle types in the Opponent's specifications; and

(ix) screenshots of the Polaris Britain website and dealer websites do not include any pages relating to clothing.

30. I was invited at the hearing to find that the Opponent's evidence is insufficiently solid to establish genuine use of the first, second, fourth and fifth earlier marks, the result being that the Opponent may rely only on the third earlier mark.

31. Mr Tritton, appearing for the Opponent at the hearing, raised the issue of the timing of the Applicant's challenges and referred me to *Vapes Bars Ltd v Diamond Mist Ltd*,[11] a first instance decision of this Tribunal, and to *TUI v Griffiths*,[12] a judgment of the Supreme Court.

32. The bottom line of Mr Tritton's argument was that Ms Reicis' evidence was unchallenged during the evidence rounds and that I must draw a line between challenges to the sufficiency of the evidence, i.e. the Applicant asking me to recognise the omission of UK sales figures, and last-minute challenges to the veracity or truthfulness of a witness statement, i.e. the Applicant suggesting that the invoices are not a sample, despite that being precisely what Ms Reicis says in her witness statement.

[11] BL O/0501/24.
[12] [2023] UKSC 48.

33. Appearing for the Applicant at the hearing, Mr Hill's position was that he was not submitting that the evidence is untrue, but that it does not show what needs to be shown in line with the evidential requirements of showing genuine use.

34. Whilst I agree that a line is to be drawn when considering any criticisms of the Opponent's evidence, my view is that the vast majority of the Applicant's criticisms fall on the right side of that line, it merely highlighting the Opponent's omissions. Having well in mind the Supreme Court's judgment, there is no procedural unfairness in pointing out, even at the hearing, key components of evidence of use that have not been provided. Those are conclusions I was bound to come to myself when considering the requirements for genuine use, in line with *easyGroup Ltd* and *Awareness Limited.*

35. The criticisms that do give me pause for thought are: (i) the suggestion that the invoices are not a sample but are all invoices of relevant sales; and (ii) the submission that paragraph 13 of Ms Reicis' witness statement, in particular, constitutes a general remark from which I cannot draw any real conclusions. I will deal with these separately.

36. Whether the invoices are a sample is not in question; Ms Reicis describes them as such in her witness statement at paragraph 17: this was not challenged at the appropriate time and so it is not open to the Applicant, at the hearing (nor in Mr Hill's skeleton argument), to call into question the accuracy of Ms Reicis' statement with no opportunity to respond. However, the criticism of how Ms Reicis describes the invoices was expanded upon by Mr Hill at the hearing: is the sample a small sample of a huge trade, or is it a sample set which is nearly complete? He went on to submit that the Registry is able to conclude that the samples are quite close to the total. In my view, Mr Hill's submission is speculation; there is no contradictory evidence to show what percentage of the total invoices the sample represents. I reject the submission that the invoices represent all or the majority of the total invoices. Further, Mr Hill suggested Ms Reicis' explanation of the invoices extended to simply "there are some invoices which are samples, and that is it, essentially, in relation to the clothing". On the contrary, Ms Reicis' paragraph 17 sets out what goods are included in the invoices and explains that all of those goods are sold under, and have borne at all relevant

times, the word mark or the figurative mark. I will return to assessing the sufficiency of this evidence in due course.

37. Paragraph 13 of Ms Reicis' witness statement reads as follows:

> "13. Polaris' [word mark and figurative mark] have been used, and are currently used, in the UK, in relation to, among others, the following goods:
>
> (a) Crash helmets; goggles; protective boots; armoured motorcycle clothing; protective clothing for motorcyclists.
>
> (b) Snow mobiles, all-terrain vehicles and motorcycles; dune buggies; motorcycle parts and accessories; motorcycle panniers and saddlebags; luggage specifically adapted for motorcycle use; covers for motorcycles.
>
> (c) Clothing, namely, shirts, jackets, pants, gloves, hats, bibs, and footwear."

38. Mr Tritton submitted that paragraph 13 represents what the Opponent has demonstrated genuine use of, but also recognised it may constitute bare assertion. Whether a statement is considered bare assertion is important given it is one of the exceptions recognised in *TUI v Griffiths* where notice is not essential.[13] Mr Tritton relied on *Vapes Bars Ltd* on this point and how the Hearing Officer, Mr James, determined whether a particular statement (regarding sales volumes) constituted evidence or mere assertion. Mr James cited various cases[14] and found the statement at issue to be sufficient on the basis that (1) the witness was in a position to give first hand evidence about the matter, (2) the statement was sufficiently clear and detailed, and (3) it was consistent with documents that were exhibited to the statement. Applying the same three points to the case before me, I am satisfied that the first two points can be said in relation to Ms Reicis' paragraph 13. The third point, however, is what I will come to consider when assessing the documentary evidence.

[13] Paragraphs 61 to 67 identify the circumstances where previously unchallenged and uncontroverted evidence can properly be rejected, despite the absence of cross-examination or prior notice.
[14] *TUI v Griffiths*; *Awareness Limited*; and *EXTREME Trade Mark* [2008] RPC 2.

39. In the *PILLOW TALK* case,[15] Thomas Mitcheson KC, sitting as the Appointed Person, upheld the Hearing Officer's decision to reject as evidence of use of a trade mark the statement: "average annual turnover of the goods in Class 28, using the 'Pillow Talk' mark, during the relevant period, was £45,000" on the basis that additional material in support of this statement was non-existent. Applying this to the case before me, whilst Ms Reicis' paragraph 13 provides some level of detail beyond bare assertion, if the exhibits do not support this statement, I am entitled to be sceptical and reject it as insufficiently solid.

40. Having set out my thoughts on the validity of the Applicant's criticisms of the Opponent's evidence, I will proceed to assess the sufficiency of what has been provided.

Assessment

41. Ms Reicis' witness statement explains that the Opponent, described as a company in the powersports industry, was founded in 1954 and is headquartered in Minnesota.[16] The Opponent sells its products online and through dealers, distributors and retail stores principally located in the United States, Canada, Europe (including the UK), Australia and Mexico, and has historically operated six business segments: off-road vehicles; snowmobiles; motorcycles; global adjacent markets; aftermarket; and boats.[17]

42. Ms Reicis has provided the following global revenue figures for the Opponent, though these are not separated by country or category of goods:[18]

Year	**USD (in millions)**
2016	4,516.6
2017	5,428.0

[15] BL O/1160/23.
[16] See [2].
[17] Ms Reicis' witness statement at [3]-[4].
[18] Ms Reicis' witness statement at [6].

2018	6,078.5
2019	6,782.5
2020	7,025.0
2021	8,198.2
2022	8,589.0

43. Whilst the revenue is significant, this evidence is mainly irrelevant for demonstrating genuine use in these proceedings. With no breakdown I cannot conclude with any certainty what proportion of these figures relates firstly, to the UK and the EU and secondly, to which goods and whether those are the goods relied upon. These are not findings I can make based solely on assumptions.

44. To support the revenue, Ms Reicis has provided some additional sales figures for snowmobiles (135,000, 125,000 and 135,000 units worldwide for the seasons ending 31 March 2019, 2020 and 2021, respectively). Ms Reicis states that snowmobiles are mainly sold in the United States, Canada, Russia and Northern Europe (Sweden and Finland) and so I attribute none of these sales to the UK. Whilst I acknowledge use in the EU is relevant for a proportion of the time these figures relate to, once again the figures are not broken down for me to determine how many sales were made in the EU.

45. Returning to the narrative evidence, the Opponent conducts its business in the UK through its subsidiary, Polaris Britain Ltd (hereafter "Polaris Britain") which, in turn, conducts its business via 63 authorised dealers.[19] Exhibit A2 contains screenshots of the Polaris Britain website, taken from the internet archive site 'Wayback Machine'. The screenshots reflect the website as at 1 January 2018 and depict a variant of the figurative mark[20] in the top banner and, below, a list of 60 dealers across the UK. Taking this evidence together, it is reasonable to conclude that Polaris Britain used 60 authorised dealers at 1 January 2018 (two weeks prior to the start of the relevant period) and 63 authorised dealers at the date of Ms Reicis' witness statement, 22

[19] Ms Reicis' witness statement at [8] and A1.
[20] I will address the mark variants, if necessary, later in my decision.

November 2023 (10 months after the end of the relevant period). It is unlikely the position was significantly different during the relevant period.

46. The websites of 24 of the UK dealers referred to in the previous paragraph are shown, as screenshots, at exhibit A3. Four screenshots have been included per one page of evidence and so, even when zoomed in, some of the content is illegible. A variant of the figurative mark is visible in the top banner of each of the websites, but of the content that is legible, the only dates I can decipher are in reference to the 2023 Polaris vehicle lineup, as well as a promotion valid between 1 October and 31 December 2023, and another valid until 31 December 2023. Given the relevant period ends 13 January 2023, it is likely this evidence all falls afterwards.

47. A sample of 66 invoices has been provided at exhibit A4, spanning 9 January 2018 to 31 January 2023 and showing a wide geographical spread across the UK. Each invoice depicts a variant of the figurative mark at the top-left and "Polaris Britain Ltd" at the top-right. Discounting the first invoice and the last five, which fall outside the relevant period, the total value of the sales invoiced is approximately £12,700. The invoices are described by Ms Reicis as showing distribution of 'crash helmets, goggles; protective boots, armoured motorcycle clothing, protective clothing for motorcyclists, shirts, jackets, pants, gloves, hats, bibs, and footwear'.[21] Such goods would refer to those relied upon in Classes 9 and 25. There are, however, several item descriptions which appear to relate to parts or accessories for vehicles, i.e. "washer clutch retainer", "disc-brake rear", "drive fluid", "cable-throttle", "kit-brake pad", "throttle pedal", "sparkplug wire" and "fuel filter", for example. Although it is unclear what the goods are and what vehicles they are for, it is clear that these would more likely refer to the goods relied upon in Class 12. Accordingly, I consider the total sales value of £12,700 to relate to Class 9, 12 and 25 goods. For a five-year period, this equates to an average sales value of £2,500 per year. When considering the relevant goods and their markets, these figures are negligible. Further, £2,500 per year compared to an annual global revenue of £6bn (in 2018) equates to just 0.00004% of the Opponent's sales being in the UK. Whilst these calculations may appear overly scrutinous, and even bearing in mind these invoices are described as a sample, with no sales figures

[21] Ms Reicis' witness statement at [17].

for the relevant territories, nor broken down by categories, it has been necessary to attempt to build a picture of what happened during the relevant period.

48. Aside from the sales value of the invoices, the quantities also need addressing. Whilst there are item descriptions which demonstrate sales of various garments including beanies, bibs, jackets, helmets, gloves, riding boots, shirts, pants and goggles, the items appearing most frequently are gloves (16 times) and jackets (13 times). All other items appear fewer than 10 times. Sales of 16 pairs of gloves in five years is minute in the relevant market. Further, it is not apparent from the descriptions on the invoices whether some of the goods are protective or not, which dictates whether they are proper to Class 9 or 25, both of which are relied upon in these proceedings.

49. This leads me onto the catalogues provided at exhibits A5 to A17. These are described (and labelled) as the apparel sections of both International and EMEA (Europe, Middle East & Africa) Polaris catalogues in 2018, 2020, 2021 and 2022. The extent of Ms Reicis' explanation of the catalogues is that they demonstrate how the marks are applied to the goods and that the item numbers in the catalogues correspond to item numbers in the invoices. However, with 66 invoices and 13 catalogues, an indication of where the item numbers correspond would have been helpful. I do not propose to cross reference every item number on the invoices with each page of the catalogues. However, I can see that items in the catalogues clearly display the word mark and the stylised mark and so even if I accept that the goods in the catalogues are the same as those in the invoices, all that demonstrates is that the mark has been applied to the goods. This does not make up for the minimal quantities and sales value evidenced by the invoices. Further, I have separate concerns about the catalogues: there is no explanation of how many were distributed and where, and so I cannot determine the identity or size of the audience.

50. Exhibit A18 contains Amazon UK webpages, which are only dated insofar as the date on which the evidence was compiled for these proceedings. There are, however, visible dates on which the items were first available on Amazon: these vary from October 2017 to December 2022. Despite these being UK webpages, the delivery option for each item is shown as Germany, save for one item (a helmet) with a UK

address which is listed as “currently unavailable”. This suggests to me that the only delivery option is Germany. I asked Mr Tritton at the hearing if there was anything in the evidence to explain why this was the case: there was not, but Mr Tritton did point out that there is nothing in the evidence to suggest UK delivery is not an option. I accept on the face of it the evidence does not prove UK delivery is not an option, but neither does it prove that it is. Given that these pages of evidence were compiled in 2023 (considerably beyond when use in the EU would be sufficient) and that they are Amazon UK pages, it is likely the purpose of this evidence is to demonstrate the availability of POLARIS goods in the UK. On the basis that the only delivery option shown is to Germany, and the only page with a UK address shows an unavailable item, this evidence is too ambiguous for me to conclude that these goods were actually available for purchase by, and delivery to, UK consumers.

51. Similar criticisms apply to exhibit A19, which contains Polaris webpages and those of third parties. The pages are all undated, mostly show products in US dollars and shows one item unavailable. It is not clear whether these items were available in either of the relevant territories or in the relevant period.

52. Exhibit A20 contains Polaris Britain webpages showing images and prices of various off-road vehicle models. The pages are only dated to the extent they include the date the pages were printed (21 November 2023); this and paragraph 23 of Ms Reicis’ witness statement (dated 22 November 2023) describing the exhibit as “current excerpts” tells me the pages were accurate at the time of collating the evidence. This does not demonstrate sales, or even the availability, of these products during the relevant period, which ends 13 January 2023. This is somewhat compensated for by exhibit A21 which contains four Polaris Britain webpages taken from ‘Wayback Machine’ dated 10 February 2018, 28 February 2019, 2 May 2020 and 20 January 2021. The four pages contain images of off-road vehicles, though there are no prices or purchase options. Though I cannot be certain whether the goods were being advertised for future availability or were available at the time, it is reasonable to conclude, given the same images appeared in four consecutive years, that the vehicles were on the market for at least part of the relevant period. What is not shown in evidence are sales of any of these vehicles either in the UK or the EU.

53. Ms Reicis refers at paragraph 25 of her witness statement to the Opponent's global advertising spend, which totalled 3bn US dollars between 2016 and 2021. Advertising is said to include webpages, social media, TV commercials and videos, customer loyalty programmes, events, magazines and newsletters, and other promotional activities.

54. Social media presence, including Facebook and YouTube, is demonstrated in exhibits A22 to A30. The exhibits support Ms Reicis' narrative at paragraphs 27 to 36 in terms of the dates the pages were created and the significant follower and viewing figures (millions of YouTube views and over one million Facebook followers, for example). The Opponent clearly has a strong online and social media presence. However, as with the revenue and advertising figures, the social media following and YouTube video views represent the global picture, with no attempt to explain what proportion of the Opponent's following is in the EU or the UK. I remind myself that the only UK sales figures in evidence (taken from the sample invoices) represent just 0.00004% of the Opponent's global revenue in the relevant period. If that is representative also of the advertising spend and the Opponent's online following, it would amount to a minimal advertising spend in the UK in five years and next to no followers in the UK of its most popular Facebook page. This is self-evidently not an accurate way of estimating the Opponent's UK market, but is simply an example of what little weight I can place on much of the Opponent's evidence without filling in the gaps myself using supposition, which is not appropriate.

55. Ms Reicis also refers to a UK customer loyalty programme called Club Polaris which provides members with access to a members-only social media group, a welcome gift pack, access to events and discounts on vehicle inspections, amongst other perks.[22] Ms Reicis states that this loyalty programme is available to owners of Polaris vehicles. Exhibit A31 contains webpages from the Club Polaris website, dated April, June and December 2021. There is no evidence of the number of Club Polaris members, nor any details to identify where they are located. Neither are there any sales figures for the relevant goods for me to determine how many potential members there are. This evidence therefore has limited value for demonstrating genuine use:

[22] Ms Reicis' witness statement at [37].

knowing a loyalty programme exists without knowing how many members it has tells me little about the Opponent's market presence in the UK.

56. A similar assessment applies to the evidence of the Polaris app.[23] These apps are available worldwide and so the 500,000 downloads from Google Play and 1,300 ratings on the Apple App Store do not demonstrate an EU or UK market, nor do they demonstrate use of the marks on any particular goods.

57. One of the high points for the Opponent is the evidence relating to UK events. Ms Reicis discusses these at paragraphs 38 and 39 of her witness statement: in April 2019 an event took place in Lake District, UK, to launch a new Polaris vehicle model (Polaris Ranger Diesel). Ms Reicis refers to 27 journalists from 10 different countries having attended to test the vehicle and take photographs and videos for their articles.[24] Exhibit A33 contains several examples of press coverage in the UK, though most are mainly illegible due to their size. However, one is dated April 2019 and one July 2019, and it is clear all the articles relate to the Polaris Ranger Diesel vehicle. It appears that this event was not attended by members of the public or previous/prospective customers of Polaris, but solely by journalists.

58. 'Polaris Camps', where participants are able to take off-road driving courses and hiking routes, test vehicle models and purchase accessories and apparel at "preferential prices", first took place in the UK in North Wales in 2021, and the 2022 edition took place in Scotland. Exhibit A32 contains Polaris' press releases for each event, which confirm that tickets were available to purchase for the events from the website polariscamp.co.uk. The press release for the 2022 event states that over 100 riders attended the 2021 event. It is not clear whether the attendees had already purchased their own Polaris vehicle and brought it to the event, or whether any sales (of vehicles, clothing or otherwise) resulted from either event.

59. Based on these events, Polaris having at least some degree of presence in the UK in relation to off-road vehicles is undeniable. However, a market presence alone is not

[23] Ms Reicis' witness statement at [40] and exhibit A35.
[24] Ms Reicis' witness statement at [39].

sufficient for a finding of genuine use. I must be satisfied that the use is warranted to maintain or create a share in the market. With only limited details about the events, and no details of exactly who attended, whether they were customers of Polaris (either existing or prospective), whether any particular goods were marketed at the events, or whether the events resulted in any sales of any particular goods, it is difficult to draw any conclusions on their relevance.

60. The penultimate exhibit in evidence is of no assistance. It contains a press release dated 28 September 2020 of a partnership between Polaris and Zero Motorcycles to develop electric vehicles. The press release contains a paragraph relating to the data sources of the information contained within the article, the final sentence reading "Retail sales references to total Company retail sales includes only ORV, snowmobiles and motorcycles in North America unless otherwise noted"; there seems to be no relevance to the EU or the UK.

61. The final exhibit, A37, contains a domain name decision of the World Intellectual Property Office (WIPO) in a case involving the Opponent and a third party. It is provided with the intention of confirming the alleged reputation of the Polaris marks, though the facts of the WIPO proceedings and any evidence filed in relation thereto may differ to those before me. Accordingly, this decision is not persuasive in these proceedings.

Conclusions on genuine use

62. In my view, the high points of the Opponent's evidence are the sample invoices in the UK during the relevant period, Polaris Britain webpages showing off-road vehicle models during the relevant period, and Polaris events relating to off-road vehicles taking place in the UK in 2019, 2021 and 2022. I have dealt with my criticisms of these pieces of evidence above. The sales figures and advertising spend are significant, but represent the global picture, with nothing to explain the proportions relevant to the EU or the UK.

63. The Opponent clearly has a business, but what is unclear from the evidence provided is the presence of that business in the EU or the UK and whether the

Opponent already has an established market presence in either of those territories or is attempting to create a market. To my mind, the evidence leaves me with more questions than answers when considering whether there has been genuine use.

64. Relying on the Opponent's presence worldwide, i.e. global revenue, global advertising spend and worldwide social media followers, for example, without breaking these figures down, is an inadequate way of demonstrating genuine use in a particular territory or for particular categories of goods.

65. Even if I were satisfied, piecing together the high points of the Opponent's evidence, that the Opponent was attempting to create a market during the relevant period, there is nothing sufficiently solid which allows me to determine for which goods the Opponent is seeking to do this. Using the goods relied upon in their respective classes as a guide, the only conclusions I can draw are that between one and 16 individual Polaris-branded clothing items were sold in the UK over a five-year period and that off-road vehicles were most likely available (or at least advertised) on the Polaris Britain website between 2018 and 2021.

66. As confirmed recently by Iain Purvis KC,[25] it is not the role of the Tribunal to fill in obvious gaps in the evidence and, in my view, that is what would be required to make a finding of genuine use in relation to any particular goods. The evidence that has been provided is inconclusive and requires too much inference and speculation.

67. As a result of my findings on genuine use, the Opponent may rely only upon its third earlier mark, under section 5(2)(a).

Section 5(2)(a)

68. Section 5(2)(a) of the Act states that:

> "A trade mark shall not be registered if because –

[25] Sitting as the Appointed Person in BL O/0725/25. See [37]. I note this decision was published after the main hearing in the present case, however, the message is the same as that communicated in *Awareness Limited v Plymouth City Council*, cited earlier in my decision.

(a) it is identical to an earlier trade mark and is to be registered for goods or services 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."

69. Section 5A of the Act is as follows:

"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."

Relevant law

70. The following principles are gleaned from the decisions of the Court of Justice of the European Union ("CJEU") 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.

<u>The principles</u>

(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 marks

71. Under section 5(2)(a), it is self-evident that the third earlier mark is identical to the Applicant's mark, both being "POLARIS/Polaris". This is agreed by the parties.

Comparison of goods and services

72. I will deal first with the limitations added to the Applicant's specification, namely "…*all of the aforesaid being for equestrian use*", "…*for equestrian use*" and "…*all of the aforesaid services relating to equestrian activities*" in Classes 9, 28 and 35, respectively. Detailed submissions were given at the hearing, foreshadowed by the skeleton arguments and corresponding authorities. I have considered all of these in coming to the conclusions that I have.

73. The position is different for the goods to the services. The decision in *Quartz*[26] set out that attempting to limit widely applicable terms via reference to their use in a particular setting and/or by a particular customer base is likely to be artificial. In the present circumstances, the Applicant is attempting to limit the goods to the way in which the consumer uses the goods. As Mr Tritton said at the hearing, the interpretation of a specification should not depend upon the reasons why a consumer has purchased the goods. There is nothing in the Applicant's specification that would in theory preclude a consumer using the goods for purposes other than horse riding. Accordingly, I do not consider it appropriate to allow for the limitations in the Applicant's Classes 9 and 28 when comparing the respective specifications.

74. Even if the limitation were valid, the Opponent's services are unlimited and therefore could include retail of the goods for the same use as the Applicant's goods. The retail and online retail store services in relation to apparel and protecting riding

[26] The decision of Professor Ruth Annand in BL O/090/04.

gear, for example, could include apparel for equestrian use and protecting riding gear for equestrian use.

75. For the services in Class 35, the position is different. The Applicant's limitation intends to limit the services by the recipient, i.e. the services are targeted at a particular sector. The decision in *Omega*[27] confirmed that services can more readily be defined by their recipient, and I consider that to be the case here. In my view, the restriction identifies a sub-category of the Class 35 services, i.e. services relating to equestrian activities. I consider this to be an acceptable limitation, which will be taken into account in the services comparison.

76. The competing goods and services are shown in the table below:

The Applicant's specification	**The Opponent's third earlier mark's specification**
Class 9: *Protective gloves; protective helmets; riding helmets; safety helmets.* Class 28: *Sporting articles; body protectors.* Class 35: *Advertising, business management, business administration, office functions, provision of information to customers, provision of advice and assistance in the selection of goods, advertising services for others, all of the aforesaid services provided over the Internet, in a department store or over a computer network; all of the aforesaid services relating to equestrian activities.*	Class 35: *Retail store and online retail store services in relation to recreational vehicles, parts and accessories for recreational vehicles, apparel, protecting riding gear, portable electric generators.*

[27] *Omega Engineering Inc v Omega SA* [2012] EWHC 3440 (Ch).

77. It is settled case law that I must make my comparison of the goods and services on the basis of all relevant factors. These include the nature of the goods and services, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary: see *Canon,* paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281. As the General Court ("GC") said in *Boston Scientific Ltd v OHIM*,[28] goods and services are complementary when:

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

78. The judgment of Jacob J (as he then was) in *Avnet Incorporated v Isoact Limited* is also relevant:[29]

> "In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

79. I also bear in mind the judgment in *Oakley, Inc v OHIM*. The GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

80. In *Tony Van Gulck v Wasabi Frog Ltd,* BL O/391/14, Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, reviewed the law concerning the comparison of retail services and goods. As well as *Oakley*, this included *Sanco SA v OHIM,* Case C-411/13P and *Assembled Investments (Proprietary) Ltd v OHIM,* Case

[28] Case T-325/06.
[29] [1998] F.S.R. 16.

T-105/05, which was upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd* Case C-398/07P. Mr Hobbs concluded that:

> i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;
>
> ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;
>
> iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;
>
> iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

81. I consider *Retail store and online retail store services in relation to […] apparel, protecting riding gear […]* to be the relevant part of the Opponent's specification and, unless stated otherwise, will use this term when considering the similarity with the Applicant's goods and services.

82. In making my comparison, I shall group the Applicant's goods and services together where they are "sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons": see *SEPARODE Trade Mark*.[30]

[30] BL O/399/10.

Protective gloves; protective helmets; riding helmets; safety helmets; sporting articles; body protectors.[31]

83. I consider that all these goods are sufficiently similar to *apparel* and *protecting riding gear* in the Opponent's specification for the average consumer to assume that the same undertaking is responsible for the Opponent's retail store services and the Applicant's goods: they share trade channels and are complementary. I find that the goods are similar to the services to a medium degree.

84. For the avoidance of doubt, I would have made the same finding even if I had found the Applicant's limitations to be acceptable, by virtue of the same goods being for equestrian use not preventing a complementary nature between the goods and the retail services.

Advertising, business management, business administration, office functions, provision of information to customers, advertising services for others, all of the aforesaid services provided over the Internet, in a department store or over a computer network; all of the aforesaid services relating to equestrian activities.

85. When bearing in mind *Avnet,* the core purpose of these services is entirely different to the Opponent's. The fact that a business (one in a department store, for example) may provide retail services as well as advertising, provision of information and business administration, for example, does not render all of those services similar: it simply means those differing activities are incidental to the core business. The services are not indispensable for each other, neither would consumers believe them to be provided by the same undertaking. The nature, purpose and method of use of these services do not overlap, neither are they in competition with one another. Overall, I find there to be no similarity between the parties' respective services.

Provision of advice and assistance in the selection of goods; all of the aforesaid services provided over the Internet, in a department store or over a computer network; all of the aforesaid services relating to equestrian activities.

[31] This represents both the Class 9 and 28 goods.

86. The position with respect to these services differs to my assessment in the previous paragraph on the basis that these specifically relate to the selection of goods relating to equestrian activities. Goods relating to equestrian activities are likely to include apparel and protecting riding gear and so I consider there to be sufficient overlap between the subject of both parties' services. Whilst the nature of providing advice and assistance is different to providing retail services, they are important to one another to the extent the average consumer would assume a connection between the undertakings providing such services. Overall, I find the parties' services to be similar to a low degree.

87. In accordance with *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, if there is no similarity between goods/services, there is no likelihood of confusion to be considered. Consequently, the 5(2)(a) ground of opposition has failed in relation to the following services:

Class 35: *Advertising, business management, business administration, office functions, provision of information to customers, advertising services for others, all of the aforesaid services provided over the Internet, in a department store or over a computer network; all of the aforesaid services relating to equestrian activities.*

The average consumer and the purchasing act

88. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods/services. I must then determine the manner in which the goods/services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited,* [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively

by the court from the point of view of that constructed person. The word "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

89. The relevant goods and services are those for which I have found similarity, the average consumer of which will comprise members of the general public. For the goods, consumers will consider the cost, aesthetic preferences, product specifications and suitability for their needs, particularly for goods that have a protective function. For the services, the parties' respective specifications indicate that they are provided both in physical premises and online. They are services that are accessed regularly, with users considering the reliability of the advice and assistance and the range of goods offered by the retail services, amongst other factors. Overall, I consider that a medium degree of attention will be paid to the selection of the goods and services.

90. Consumers will most likely select the goods visually, by choosing them from the shelves of physical retail stores or from their catalogue or online equivalents. However, I do not ignore the potential for an aural aspect to the purchase, owing to conversations with retails assistants. The services also will be selected visually, with consumers seeing the services on signage of physical premises and the advertising of the services online. Again, aural considerations cannot be ignored on the basis of word of mouth recommendations, for example.

Distinctive character of the earlier mark

91. In *Lloyd Schuhfabrik Meyer*, the CJEU stated that:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an 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)."

92. 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/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.

93. I will begin by assessing the inherent distinctive character of the earlier mark, which comprises the one word POLARIS. Throughout the proceedings, the Applicant has maintained that POLARIS is a common word either referring to a type of missile or being the scientific name of a star. The Opponent accepts that POLARIS is a scientific name for a star but submits that the average consumer would be aware neither of this meaning nor any other meaning. The Opponent further attests to a high degree of distinctive character in POLARIS by virtue of it being neither descriptive nor allusive for the goods and services for which it is registered.

94. Whilst I agree with the Applicant that POLARIS is the name of a star (there is nothing before me to support its reference to a type of missile), I agree with the Opponent that a significant proportion of the average consumers will not be aware of this. If the average consumer attributes the word no meaning, I consider it appropriate that it is afforded a level of distinctive character similar to that of an invented word, and find POLARIS inherently distinctive to a medium to high degree.

95. Whilst the Opponent has provided evidence of use, I found it insufficient for a finding of genuine use. The same criticisms of the evidence I identified earlier in this decision apply equally here. The relevant territory for an assessment for an enhanced distinctive character is the UK and I have not been provided with sales figures (save for minimal amounts on sample invoices), market share or advertising spend for the mark in the UK. As such, I find there to be no enhanced distinctive character, though the mark's medium to high degree of inherent distinctiveness remains.

Likelihood of confusion

96. 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/services 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/services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the Opponent's trade mark, the average consumer for the goods/services 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.

97. I have found the marks to be identical. I have found the earlier mark to have a medium to high degree of inherent distinctive character. I have identified the average consumer to be a member of the general public who, paying a medium degree of attention, selects the goods predominantly by visual means, though I have not discounted an aural element to the purchase. I have found the goods/services to be similar to either a low or medium degree.

98. Given the identity between the competing marks, it is my view that the average consumer will be directly confused, even for services that are similar to a low degree due to the interdependency principle. There is a likelihood of direct confusion.

Section 5(2)(a) conclusion

99. The opposition has succeeded under this ground in relation to the following goods and services, which are refused registration:

Class 9: *Protective gloves; protective helmets; riding helmets; safety helmets.*

Class 28: *Sporting articles; body protectors.*

Class 35: *Provision of advice and assistance in the selection of goods, all of the aforesaid services provided over the Internet, in a department store or over a computer network; all of the aforesaid services relating to equestrian activities.*

Section 5(2)(b)

100. The Opponent relied only upon its fourth earlier mark under this ground. On the basis that it has not demonstrated genuine use of this mark, the section 5(2)(b) ground fails.

Section 5(3)

101. The Opponent relied upon its fourth and fifth earlier marks under this ground. On the basis that it has not demonstrated genuine use of these marks, the section 5(3) ground fails. Even if I am wrong in my assessment of genuine use, the evidence is not sufficient to demonstrate a reputation in the UK. Similarly to my assessment of enhanced distinctive character, the Opponent filed no evidence of sales figures (save for minimal amounts on sample invoices), marketing spend or market share specific to the UK. Therefore, even in the event of a finding of genuine use, the Opponent

would have failed at the first hurdle under this ground for failure to prove the required reputation.

FINAL REMARKS

102. Even if I am wrong on my finding of genuine use for the first, second, fourth and fifth earlier marks, there are no goods in those marks' specifications that would have put the Opponent in a better position in relation to the Class 35 services of the application that are proceeding to registration. Based on the relevant factors according to the case law, I would have found no similarity between the Opponent's goods in Classes 9, 12 and 25 and the Applicant's remaining services in Class 35.

OVERALL CONCLUSION

103. The Opponent has been partially successful under section 5(2)(a). The application is refused in respect of the following goods and services:[32]

Class 9: *Protective gloves;*[33] *protective helmets; riding helmets; safety helmets; all of the aforesaid being for equestrian use.*

Class 28: *Sporting articles for equestrian use; body protectors for equestrian use.*

Class 35: *Provision of advice and assistance in the selection of goods, all of the aforesaid services provided over the Internet, in a department store or over a computer network; all of the aforesaid services relating to equestrian activities.*

104. The application may proceed to registration in relation to the following services:

[32] Whilst I found the limitations in respect of the goods to be unacceptable and disregarded them in the goods and services comparison, they form part of the Applicant's specification that is refused.
[33] As a reminder, this term was erroneously removed from the specification following previous proceedings. The term will remain absent from the Applicant's specification.

Class 35: *Advertising, business management, business administration, office functions, provision of information to customers, advertising services for others, all of the aforesaid services provided over the Internet, in a department store or over a computer network; all of the aforesaid services relating to equestrian activities.*

COSTS

105. Whilst the Opponent has been mainly successful under section 5(2)(a), the Applicant has been the successful party under sections 5(2)(b) and 5(3). In the circumstances, I do not consider it appropriate to make an award and I order the parties to bear their own costs.

Dated this 8th day of October 2025

MRS E FISHER
For the Registrar